# Supreme Court of the United States

OCTOBER TERM, 1903.

EX PARTE HERMAN TRASCH, Petitioner.

Petition for Writ of Habeas Corpus.

Press of Byron S. Adams, Washington, D. C.

# Supreme Court of the United States

## OCTOBER TERM, 1902.

*EX PARTE* HERMAN FRASCH, PETITIONER.

## Application for Leave to File Petition for Writ of Mandamus.

And now, to wit, this 23d day of March, 1903, comes the above-named petitioner, by his attorney, and applies to the Supreme Court of the United States for leave to file the petition, hereto accompanying as part hereof, for a writ of mandamus, directed to the Chief Justice and associate justices of the Court of Appeals of the District of Columbia and commanding them to hear and determine this petitioner's appeal to said court from the decision of the Commissioner of Patents rendered January 23, 1902, and to revise said decision on the points involved in the reasons assigned to the Commissioner.

HERMAN FRASCH,
By CHAS. J. HEDRICK,
*His Attorney.*

IN THE SUPREME COURT OF THE UNITED STATES, OCTOBER TERM, 1902.

*Ex Parte* HERMAN FRASCH, *Petitioner.*

## Petition for Writ of Mandamus.

*To the Chief Justice and Associate Justices of the Supreme Court of the United States:*

Your petitioner, Herman Frasch, respectfully represents as follows:

1. Prior to November 13, 1899, he had invented or discovered a new and useful improvement in the art of making salt by evaporation of brine, which said improvement consists of certain new and useful means for removing incrustation of calcium sulphate from brine-heating surfaces, and was originally and first invented by him, and was not known or used by others in this country before his invention or discovery thereof, and was not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof or more than two years prior to the filing on November 13, 1899, of his under-mentioned application, and was not in public use or sale in this country for more than two years prior to his said application, and was not abandoned, and was not the subject of an application for a foreign patent in any country by or in behalf of your petitioner or his legal representatives or assigns at any time prior to the filing of the application aforesaid in this country, and for which said improvement he was and is justly entitled to a patent under the law (sections 4886 and 4887, Revised Statutes, as amended March 3, 1897).

2. On or before November 13, 1899, in order that he might receive a patent for his said invention or discovery, he made application therefor, in writing, to the Commissioner

of Patents, and did file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it appertains to make, construct, compound, and use the same, and did explain the principle of his said invention or discovery and the best mode in which he contemplated applying that principle, so as to distinguish it from other inventions, and he did particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery, and did sign such specification and claim as inventor and caused the same to be attested by two witnesses, and did furnish and file in the Patent Office one copy of two sheets of drawing whereof each sheet was signed by his attorney-in-fact and attested by two witnesses, and did make oath before a person within the United States authorized by law to administer oaths that your petitioner does verily believe himself to be the original and first inventor or discoverer of the improvement for which he solicits a patent, and that he does not know and does not believe that the same was ever before known or used, and did state that he is a citizen of the United States, and your petitioner did file such application complete, ready for examination, on said November 13, 1899, and did at the same time pay the fee required by law on filing an original application for a patent, and did generally comply with all and singular the provisions of law touching the making and filing of applications for patents (sections 4888, 4889, 4892, 4934, Revised Statutes).

3. On November 13, 1899, the Commissioner of Patents informed your petitioner that the papers were duly filed and that the application for a patent would be taken up for examination in its order (section 4893, Revised Statutes).

4. On December 16, 1899, the Commissioner notified your petitioner of the examiner's action, the effect of which was to

reject his claim for a patent for reasons given briefly in the official communication (section 4903, Revised Statutes).

5. After receiving such notice, your petitioner persisted in his claim for a patent without altering his specifications, and so informed the Commissioner, to wit, on December 13, 1900; whereupon it became the duty of the Commissioner to order a re-examination of the case (section 4903, Revised Statutes).

6. On December 31, 1900, the Commissioner notified your petitioner of the examiner's further action, whereby the examiner repeated and insisted upon his former objection.

7. On October 5, 1901, your petitioner requested a reconsideration.

8. On October 21, 1901, the Commissioner notified your petitioner of the "final" decision of the examiner, the effect of which was that your petitioner's claims became twice rejected (section 4909, Revised Statutes).

9. On December 13, 1901, your petitioner appealed in due form of law from the decision of the primary examiner to the board of examiners-in-chief, and paid the fee for such appeal (sections 482, 4909, and 4934).

10. The examiner refused to allow the appeal, and, upon your petitioner's request for reconsideration of such refusal, did repeat the same.

11. On December 19, 1901, your petitioner filed a written petition to the Commissioner in person and prayed him:

First. To make such order or action as that the appeal to the examiners-in-chief might be heard by them.

Second. Personally to entertain the appeal in the event of his refusing the first prayer.

Third. To make such order or action as might protect your petitioner's legal rights.

Fourth. To advise the examiner that his objection be not insisted upon and to direct him to proceed with the application.

Fifth. To administer such other or further relief as might be proper in the premises (section 481, Revised Statutes).

12. On January 23, 1902, the Commissioner rendered his decision, the effect of which was and is to reject your petitioner's claims or claim for a patent and to refuse to him a patent on application (sections 4911 and 4915, Revised Statutes).

13. On March 4, 1902, your petitioner appealed to the Court of Appeals of the District of Columbia, and gave notice thereof to the Commissioner, and did file in the Patent Office, within the time appointed by the Commissioner, your petitioner's reasons of appeal specifically set forth in writing (sections 4911 and 4912, Revised Statutes; section 780, Revised Statutes District of Columbia; section 9, act of February 9, 1893).

14. Your petitioner, in furtherance of his appeal, in due season laid before the court certified copies of all the original papers and evidence in the case by filing said copies with the clerk of said court and making the requisite deposit for costs and expenses of the appeal, and did file in the case a petition addressed to the court, and praying that his appeal might be heard upon and for the reasons assigned therefor to the Commissioner, and that said appeal might be determined and the decision of the Commissioner be revised and reversed, that justice may be done in the premises, and did cause the record to be printed and otherwise did

duly and in all respects perfect his said appeal in accordance with law (section 4913, Revised Statutes; Rules of Court of Appeals, D. C.).

15. The Commissioner gave notice to your petitioner of the time and place for hearing said appeal (section 4913, Revised Statutes).

16. At the time noticed the Commissioner moved the court to dismiss the appeal for lack of jurisdiction in the court to hear the same.

17. The court, by its opinion rendered June 23, 1902 (100 O. G., 1977), refused to hear and determine your petitioner's appeal to it and to revise the decision appealed from (section 4914, Revised Statutes).

18. On January 21, 1903, your petitioner moved the court:

(1.) To reinstate his appeal.

(2.) To hear and determine his appeal.

(3.) To revise the decision appealed from upon all and several the points set forth in the reasons of appeal.

(4.) To remand the case with directions if further proceedings in the Patent Office should be deemed necessary or desirable.

(5.) To make such other or further order and to grant such other or further relief as may be proper in the premises.

19. Subsequently the court denied said motion.

20. Annexed hereto as exhibits forming part hereof are copies of (*a*) the printed record prepared and indexed under the supervision of the clerk of the court; (*b*) the Commis-

sioner's return; (*c*) the opinion of the Court of Appeals refusing to hear and determine the appeal; (*d*) brief in support of the motion to reinstate and for other relief.

On pages 13 and 14 of the last-mentioned brief extracts from some decisions are given, to which it may not be amiss to add the following references:

(*f.*) To Merrill *vs.* Yeomans and the Telephone Cases, in which the Supreme Court of the United States said:

> "If all which is described as new in these specifications is really so, the inventor has a right to a patent for three inventions:
>
> "1. For a modification or improvement in the distilling apparatus.
>
> "2. For a new process or mode of distilling heavy hydrocarbon oils, by which they can be deprived of their offensive odors.
>
> "3. For the product of this new process of distillation, namely, the deodorized heavy hydrocarbon oils fitted for use in the arts" (Merrill *vs.* Yeomans, 94 U. S., 568).
>
> "The law has given the discoverer and inventor the right to a patent—as discoverer for the useful art, process or method of doing a thing he has found and as inventor for the means he has devised to make his discovery one of actual value" (the Telephone Cases, 126 U. S., 1).

21. The refusal of the Court of Appeals to hear and determine the aforesaid appeal and to revise the decision appealed from deprives your petitioner of a legal right vested in him by the laws of the United States; and for such deprivation he has no remedy, certainly no adequate remedy, unless the Supreme Court of the United States shall interfere by writ of mandamus.

Wherefore your petitioner prays that a writ of mandamus may be issued by said Supreme Court to the chief justice and

associate justices of the Court of Appeals of the District of Columbia, commanding them to hear and determine your petitioner's said appeal and to revise the decision appealed from in accordance with law.

HERMAN FRASCH,
By CHAS. J. HEDRICK,
*His Attorney.*

DISTRICT OF COLUMBIA, *ss:*

Personally appeared Charles J. Hedrick, of Washington, D. C., who, being duly sworn, deposes and says that he has read the foregoing petition and knows the contents thereof, and the same is true to the best of his knowledge, information, and belief.

That he has been solicitor and of counsel for the said Herman Frasch from the time of filing the latter's application for letters patent of the United States up to and including the present time; that he has conducted and managed all matters relating to such application for patent and is fully conversant with all said matters.

CHAS. J. HEDRICK.

Sworn to and subscribed before me this 14th day of March, 1903.

CORNELIUS ECKHARDT,
*Notary Public.*

Seal

# COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

## APRIL TERM, 1902.

## PATENT APPEAL DOCKET.

No. 201.

IN THE MATTER OF THE APPLICATION OF HERMAN FRASCH.

APPEAL FROM THE COMMISSIONER OF PATENTS.

(SERIAL No., 736,843.)

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# In the Court of Appeals of the District of Columbia

In the Matter of the Application of HERMAN FRASCH. No. 201, Patent Appeal Docket.

1 In the Court of Appeals of the District of Columbia.

*In re* Application for Patent of HERMAN FRASCH, Serial No. 736,843, Filed November 13, 1899. No. 201, Patent Appeal Docket.

*Improvements in Means for Removing Incrustation of Calcium Sulphate from Brine-heating Surfaces.*

To the Court of Appeals of the District of Columbia:

Your petitioner, Herman Frasch, formerly of Cleveland, in the county of Cuyahoga and State of Ohio, respectfully represents:

That he is the original and first inventor of certain new and useful improvements in means for removing incrustation of calcium sulphate from brine-heating surfaces.

That on the 13th day of November, 1899, in the manner prescribed by law, he presented his application to the Patent Office, praying that a patent be issued to him for said invention.

That such proceedings were had in said office upon said application as that on the 23d day of January, 1902, it was rejected by the Commissioner of Patents and a patent for said invention was refused him.

That on the 4th day of March, 1902, your petitioner, pursuant to sections 4912 and 4913, Revised Statutes of the United States, gave notice to the Commissioner of Patents of his appeal to this honorable court from his refusal to issue a patent to him for his said invention upon said application, as aforesaid, and filed with

2 him, in writing, the following reasons of appeal:

First. The authority exercised by the Commissioner of Patents, with the approval of the Secretary of the Interior, in establishing or attempting to establish rule 41 is invalid, because unconstitutional. Among the many grounds of unconstitutionality the following few are here set forth by way of example, namely:

A. The rule is in contravention of section I of article I, which section vests all the legislative powers of the Constitution in Congress and not in any executive officer or officers.

B. The rule is in contravention of that paragraph of section VIII of article I, which paragraph grants the power to secure to inventors the exclusive right to their respective discoveries, but said rule operates to deprive inventors whose discoveries cover new processes, re-

quiring new apparatus to make the same practically useful, of the exclusive right to either their said new processes or their said new apparatus, although said processes and said apparatus must both be disclosed by such inventors in order to obtain any exclusive right whatsoever.

C. The rule is in contravention of the clause of article V of the amendments to the Constitution, which forbids any person to be deprived of property without due process of law, inasmuch as by the mere will of an executive officer or officers it deprives the inventors mentioned in paragraph B above of their property in a part of their said discoveries.

Second. The authority exercised by the Commissioner of Patents, with the approval of the Secretary of the Interior, in establishing or attempting to establish rule 41 is invalid, because without warrant of law. Among the many grounds upon which such absence
3 of legal warrant can be urged, the following few are set forth by way of example, namely:

A. The Revised Statutes distinguish clearly between (1) the lawful subject-matter of a patent, (2) the statutory proceedings for obtaining a patent, and (3) the conduct of the said statutory proceedings; the only authority given by any act of Congress is to regulate the *conduct* of the statutory proceedings, but rule 41 is directed toward ascertaining and prescribing what shall be the lawful subject-matter of a patent.

B. Congress has not delegated to the Commissioner of Patents, nor to any executive officer or officers, the making of such a rule as is rule 41.

C. In fact, under the Constitution, Congress could not make such a delegation of power, as the enactment of the said rule would be an exercise of the legislative power.

Third. The authority exercised by the Commissioner of Patents, with the approval of the Secretary of the Interior, in establishing, or attempting to establish, rule 41, is invalid, because the said rule is unreasonable. Among the many grounds of unreasonableness the following few are here set forth by way of example, namely:

A. The inventor *must* invent and *must* disclose matter which the said rule will not allow him to claim in the very patent wherein such disclosure *must* be made, and as a condition precedent to which the said matter *must* be invented.

B. The rule forbids the claiming in one patent of matters which repeated decisions of the Supreme Court U. S. have held to be the proper subjects of distinct claims in the same patent, which that tribunal has never recognized as proper subject-matter for
4 separate patents, and which seem by the pronouncements of the same tribunal to be forbidden to be claimed in separate patents.

C. The rule contemplates two patents identical in the subject-matter invented and disclosed and differing only in the claim.

Fourth. The authority exercised by the Commissioner of Patents, with the approval of the Secretary of the Interior, in establishing or

attempting to establish rule 41 is invalid, because said rule is inconsistent with law. Some of the many grounds of its inconsistency with law are hereinabove set forth and need not be repeated. In addition, the following are here set forth, likewise by way of example, namely:

A. Congress having legislated with respect to the subject-matter of a patent, any alteration, by enlargement or restriction or otherwise, of the statutory provisions is inconsistent therewith.

B. Congress having set forth certain fees and proceedings by which an exclusive right may be secured to one or more specified inventions or discoveries or inventions and discoveries, a rule demanding two or more sets of fees and two or more proceedings is inconsistent with the congressional enactments.

C. The rule forbids what Congress has authorized, namely, one patent for both a new process and the new apparatus by which such process is made of practical usefulness.

D. The rule enjoins what the law forbids, to wit, the establishment of mutually exclusive monopolies.

E. The rule enjoins what the law forbids, to wit, the limitation of the vested and inchoate rights under one patent by a patent
5 subsequent thereto, both in order of issue and in legal effect.

F. The rule contemplates what the law forbids, to wit, the limitation of the inchoate rights of the public under a patent by a second patent subsequent thereto, both in date of issue and in legal effect.

G. The rule contemplates the exercise (in the issue of a second patent) of authority previously exhausted (in the issue of patent earlier in order of issue).

H. The rule denies the right which the law gives to an applicant of formulating his own claim.

I. The rule denies the right which — law gives to an applicant of claiming in a patent whatsoever patentable subject-matter he *must* disclose therein.

K. The rule denies the right which the law gives for such discoveries and inventions as Bell's telephone, Merrill's production of hydrocarbon oils, Neilson's hot blast, and this appellant's incrustation-removing means, namely, the right to one patent "as discoverer for the useful art, process, or method of doing a thing he has found and as inventor for the means he has devised to make his discovery one of actual value."

L. The rule enjoins what the law forbids, to wit, the inclusion "in a subsequent patent" to an inventor of an "invention embraced or described in a prior patent granted to himself."

Fifth. The authority is invalid which the Commissioner exercises in refusing patents to applicants in general and a patent to the present applicant (appellant) in particular unless and until his process claims or else his claims to the new apparatus used in the performance of said process shall be canceled.

6 Said authority is invalid for the following reasons, severally and *collecting:*

(*a*.) It is invalid because unconstitutional.
(*b*.) It is without warrant of law.
(*c*.) It is unreasonable.
(*d*.) It is inconsistent with law.

As some of the many grounds upon which (*a*) unconstitutionality, (*b*) absence of legal warrant, (*c*) unreasonableness, (*d*) inconsistency with law, can and will be urged, those hereinbefore set forth in the paragraphs marked by capital letters under the first, second, third, and fourth reasons of appeal are to be taken as here set forth by way of example.

Sixth. The authority exercised in this case, of requiring applicants in general, and the present applicant in particular, to cancel a part of his claim (or any one or more of his claims) to patentable subject-matter, is invalid, especially when two patents issued—one on the part required to be canceled and the other on the remaining part—would bear to each other the following relationship severally or any two or more or all of them collectively—that is to say:

1. That of two mutually exclusive patents.

2. That of two patents with the same essential specification, neither more nor less, only the *claim* being divided between the two patents.

3. That of two patents for different reflexes or embodiment of the same conception.

4. That of two patents for the process and the apparatus respectively, which process and apparatus were both claimed in Bell's
7 first patent in suit in Dolbear *v.* American Bell Telephone Co., 126 U. S., 1; C. D. 1888, page 322; 43 O. G., 377.

5. That of two patents for the process and the apparatus respectively, which process and apparatus were both claimed in the one patent in suit in Merrill *v.* Yeomans, 94 U. S., 568; C. D. 1877, page 279; 11 O. G., 970.

6. That of two patents for respecting Neilson's apparatus and Neilson's method, referred to in O'Reilly *v.* Morse, 15 How., 62.

7. That of two patents for respecting the process and the apparatus of appellant's above-entitled application.

Seventh. The authority is invalid, which was and is exercised by the Commissioner of Patents in this case, of forbidding applicants in general, and this applicant in particular, to claim all and several the new and useful matters of invention required to be disclosed by him or by them respectively in order to the obtainment of any patent whatsoever, and of refusing the application unless and until a part of his or their claim shall be canceled. This authority is invalid for the following reasons, severally and collectively:

(*a*.) It is invalid because unconstitutional.
(*b*.) It is without warrant of law.
(*c*.) It is unreasonable.
(*d*.) It is inconsistent with law.

As some of the many grounds upon which (*a*) unconstitutionality, (*b*) absence of legal warrant, (*c*) unreasonableness, (*d*) inconsistency with law, can and will be urged, those hereinbefore set

forth in the paragraphs marked by capital letters under the first, second, third, and fourth reasons of appeal are to be
8 taken as here set forth by way of example.

Eighth. The authority exercised by the Commissioner of Patents in this case of refusing or holding up applications for patents in general, and the above-entitled application in particular, upon the mere ground that the application contains both process claims and apparatus claims, is invalid, because:

(*a.*) It is unconstitutional.

(*b.*) It is without warrant of law.

(*c.*) It is unreasonable.

(*d.*) It is inconsistent with law, and upon grounds hereinbefore sufficiently set forth, the same to be taken as here repeated.

Ninth. The authority exercised by the Commissioner of Patents in this case, of refusing the above-entitled application upon any ground apparent in the record and proceedings in this case, is invalid, because:

(*a.*) It is unconstitutional.

(*b.*) It is without warrant of law.

(*c.*) It is unreasonable.

(*d.*) It is inconsistent with law, and upon grounds hereinbefore sufficiently set forth, the same to be taken as here repeated.

Tenth. The authority exercised by the Commissioner of Patents in refusing to forward appellant's appeal of December 13, 1901, to the board of examiners-in-chief, or to direct that it be forwarded, is invalid, because:

(*a.*) It is without warrant of law.

(*b.*) It is inconsistent with the statute in such case made and provided.

9 Some of the grounds which can and will be urged in support of these reasons are as follows:

(A). One or more or all of the points set forth in the said appeal *in* the said board were proper to be considered and passed upon by the examiners-in-chief.

(B). It is and was the duty of the said board to determine their own jurisdiction in the first instance, and not the prerogative of the examiner or of the Commissioner of Patents in person.

Eleventh. The Commissioner of Patents erred in holding that applicant (appellant) was not and is not justly entitled under the law to the patent prayed for, because the above-entitled application includes claims to a process and claims to an apparatus, or upon any ground apparent in the record and proceedings in this case.

Twelfth. The Commissioner of Patents erred in holding that because the above-entitled "application includes claims to a process and claims to an apparatus," "therefore the examiner properly required division." If the law authorizes (as it does authorize) one patent including claims to a process and claims to an apparatus, and if it gives (as it does give) to appellant a right to such a patent, it was the duty of the examiner and Commissioner to speed the progress of the application. If, on the other hand, the present applicant

(appellant) had been found claiming (as he is not claiming) more or other than the law authorizes to be secured in the patent to be issued on the above-entitled application, it would have been the duty of the examiner to reject the applicant (or, as the statute puts it, the claim for a patent) on that ground. In any case, if he
10 would not allow the application, it was his duty on the coming in of an appeal to the examiners-in-chief to forward the same to them for their determination of the points involved in the appeal. In no case can the Commissioner of Patents compel an applicant to file a divisional or, in fact, any application whatsoever.

Thirteenth. The Commissioner of Patents erred in holding that a "requirement for division is not an action upon the merits of the application, but is a mere matter of form." So far is it from being a mere matter of form that to secure a patent without the claims to process or to apparatus might be held by the courts to be an absolute abandonment and waiver of those claims, notwithstanding the issue of another patent containing the omitted claims.

In any event, the action is one of the merits.

(*a.*) Because the law gives inventors the right, on payment of one set of fees and the conduct of one proceeding, to secure protection for whatever matters may be authorized by law to be secured in one patent.

(*b.*) Because a patent with both process claims and apparatus claims is manifestly a different grant, as well from one whose claims are solely to process as from one whose claims are solely to apparatus.

(*c.*) Because the courts have repeatedly held claims void by reason of their having been granted in two patents instead of in one.

(*d.*) Because the legal effect of two patents is not the same as that of one patent.

(*e.*) Upon the analogy of the inclusion of two or more inventions in one patent to the inclusion of two or more patents in one
11 bill in equity, an improper inclusion in such bill making it demurrable for multifariousness, and the decision on such demurrer being appealable, when it is against the inclusion, as a final decision on the merits of the bill.

(*f.*) Because submission to the so-called "requirement of division" involving an alteration in the specification in its very essence—that is to say, in the substance of the claim.

Fourteenth. The Commissioner of Patents erred in holding that "a party has no right of appeal to the examiners-in-chief from such a requirement" as the so-called "requirement of division." The statute gives such a party the same right of appeal which it gives to any applicant whose "claim to a patent" may be "rejected."

Fifteenth. The Commissioner of Patents erred in holding that the action in the above-entitled application "is not a refusal of a patent or patents upon the alleged invention or inventions," since obviously he did and does refuse applicant a patent covering as well the new process as the new apparatus.

Sixteenth. The Commissioner of Patents is in error as to the

action on the above-entitled application being in effect "a ruling that the application has not been made in proper form," an "objection to the way in which the matter is presented, and not to the matter itself;" for in point of fact the matter in issue is neither a patent for the process divorced from the apparatus nor a patent for the apparatus divorced from the process, but a patent for the process and apparatus as one patentable discovery and invention, and no suggestion has been made of any change in the form or manner of
12 presenting said matter which would render the present application more acceptable to the Commissioner of Patents. What he demands is that the applicant (appellant) accept a patent essentially different from that which he asks as his legal right.

Seventeenth. The Commissioner of Patents erred in rejecting above-entitled application for patent.

Eighteenth. The Commissioner of Patents erred in refusing the patent applied for.

That the Commissioner of Patents has furnished him a certified transcript of the record and proceedings relating to said application for patent, which transcript is filed herewith and is to be deemed and taken as a part hereof.

Wherefore your petitioner prays that his said appeal may be heard upon and for the reasons assigned therefor to the Commissioner, as aforesaid, and that said appeal may be determined and the decision of the Commissioner be revised and reversed, that justice may be done in the premises.

HERMAN FRASCH,
By CHAS. J. HEDRICK,
*His Attorney.*

CHAS. J. HEDRICK,
*Solicitor & of Counsel.*

13 & 14

3735.

2-389.

UNITED STATES OF AMERICA,

[Vignette.]

DEPARTMENT OF THE INTERIOR, PATENT OFFICE.

To all persons to whom these presents shall come, Greeting:

This is to certify that the annexed is a true copy from the records of this office of the record for the court in the matter of the application of Herman Frasch, filed November 13, 1899—serial number, 736,843—for improvement in means for removing incrustation of calcium sulphate from brine-heating surfaces.

Cost of this copy is $20.25 and has been paid.

Seal Patent Office, United States of America.

In testimony whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed, at the city of Washington, this 31st day of March, in the year of our Lord one thousand nine hundred and two, and of the

Independence of the United States of America the one hundred and twenty-sixth.

F. I. ALLEN.
*Commissioner of Patents.*

* * * * * * *

*Specification.*

To all whom it may concern:

Be it known, that I, Herman Frasch, a citizen of the United States, residing at Cleveland, in the county of Cuyahoga, and State of Ohio, have invented certain new and useful improvements in means for removing incrustation of calcium sulphate from brine-heating surfaces and I do hereby declare the following to be a full, clear, and exact description of the invention, [such as will enable others skilled in the art to which it appertains to make and use the same].*

16 This invention relates to the removal of the incrustations of calcium sulphate from the heating surfaces of the vessels in which brine or other liquid containing calcium sulphate is heated in order to evaporate the said brine for the recovery of salt therefrom or in order to accomplish some other purpose. This incrustation or scale is very troublesome to the salt-maker, as its presence interferes with the transmission of heat to the brine and its removal is hard. In the evaporation of brine for salt in closed pans (such as vacuum pans for example) it has been customary (in my experience) to draw off the brine twice a day and after filling the pans with water to boil the latter in order to dissolve the common salt in the incrustation and then to scrape the flue walls in order to remove the calcium sulphate. In open pans, it has been the practice to clean the surfaces of the heating pipes once a week by means of hammers. The removal of the incrustation in either of these ways stops the evaporation while it is going on, thus diminishing by so much the output of a given plant, besides being a direct source of expense. The removal by hammering tends moreover to shorten the life of the heating pipes; for even when made extra heavy for the purpose of withstanding the hammering, the repeated blows necessary to remove the coatings are apt in time to split the pipes, so that they leak and have to be replaced.

In addition to the evaporation of brine in pans (open or closed) provided with heating surfaces (usually steam pipes or brine tubes), it has been proposed to heat the brine in one vessel under such

C. J. H. Before execution.

or tension of vapor

pressure A as to prevent evaporation therein and to transfer the so-heated brine to another vessel

C. J. H. Before execution.

or tension of vapor

in which the pressure A is removed to a

17 greater or less extent, and evaporation permitted in consequence; but here too there is apt to be formed a trouble- coating of calcium sulphate; for this

[* Words and figures enclosed in brackets erased in copy.]

substance is most soluble in water at about 100° F. (according to authorities the temperature of maximum solubility in water is between 32° C. and 41° C. which correspond respectively with $89\frac{6}{10}$° F. and $105\frac{8}{10}$° F.) and is precipitated by the mere heating of brine containing the same. In fact any heating above the very moderate temperature of maximum solubility of calcium sulphate, whether such heating be with or without evaporation, is apt to result in the incrustation of the heating surfaces with a highly objectionable coating of calcium sulphate.

In accordance with the present inventions, the incrustation of calcium sulphate is removed from the heating surfaces by condensing steam in contact with so-encrusted surfaces; and as an additional improvement, the condensation is effected, and the heat liberated in such condensation is absorbed, by a body of brine on the opposite side of the heat-conducting walls. The heat liberated by the condensation, therefore, need not be wasted but can be utilized in the heating of the brine with or without vaporizing the same. It is found that the incrustation formed in a given time, can be removed by the condensing steam in an equal (if not in a less) time; the removal of the incrustation consequently need not diminish the output of a given plant; for the brine-heating operation can be carried on with practical continuity; although the brine which is undergoing the heating operation occupies the chambers on opposite sides of the heat-conducting walls alternately. The removal can, moreover, be effected without any direct expense and without injury to the apparatus.

18 To carry the invention into effect practically, the chambers on opposite sides of the heat-conducting walls are each provided with inlets for respectively the steam to be condensed and the brine to be heated (with or without evaporation) and with means for withdrawing the water of condensation and the product or products of the brine-heating operation (that is the heated brine if there be no evaporation or the water vapor and the heated brine if evaporation take place without bringing the brine to saturation so as to precipitate salt or the water vapor and the precipitated salt if evaporation of saturated brine be carried on). When, however, the heating of brine (with or without evaporation) in only one of the chambers may be desired, it suffices to provide the other chamber with an inlet and outlet for any cooling medium in addition to the steam-supply pipe and the outlet for the condensed water, which latter outlet may however, if desired, be the same opening which serves for the withdrawal of the cooling medium.

In the accompanying drawings—

Fig. 1 is a vertical section of an apparatus in accordance with the invention, for heating brine with evaporation in the brine-holding chamber;

Fig. 2 is a section of the same apparatus on line A A of Fig. 1 looking in the direction of the arrow; and

Fig. 3 is an elevation of an apparatus, in accordance with the in-

vention, for heating brine without evaporation in the brine-holding chamber.

In both forms of the new or improved brine-heating apparatus, there are two chambers which are separated from each other by the heat-conducting walls, which (latter) are most advantageously constituted by the walls of suitable pipes. As shown these pipes *a* extend between perforated tube sheets *b* after the manner common in tubular condensers, in the heating belts of vacuum pans, in tubular boilers and other like apparatus; and the chambers are formed by the spaces inside and outside of said pipes *a* respectively. The spaces inside said pipes communicate with one another through the end spaces *c* and *d*. As shown in Figs. 1 and 2, the chamber outside of the pipes is provided with a dome *e*; and a similar dome could be applied to the corresponding chamber of an apparatus for heating without evaporation. Each of the chambers is provided with (1) a valved pipe *f* leading from a source of steam supply, as a steam boiler, the exhaust of a steam-engine, a pump for receiving and compressing exhaust steam, or other suitable source of steam supply, (2) a valved outlet *g* for drawing off the water of condensation, (3) a valved conduit *h* leading from a source of supply of the brine to be heated and (4) means for withdrawing the one or more products of the heating operation. The pipes *f* are shown as formed of branches of a common pipe with a valve in each branch; and the valved outlets *g* for condensed water, as well as the valved conduits *h* for the brine supply are similarly shown; but any suitable arrangement of pipes, outlets or conduits can be used. As it is immaterial to the present invention what becomes of the water of condensation, it is not essential that there should be a pipe or a conduit of any kind for conveying it away; although it would ordinarily and perhaps always be desirable to use such a pipe or conduit.

The conduits for supplying the brine need not be pipes, unless it is desired to introduce the brine under pressure; in other cases troughs would answer. Each chamber has to be closed when it is utilized as the steam-condensing chamber; but it may be open or closed, as may be preferred, when it is utilized as the brine-holding chamber. To remove and to replace a suitable cover (as the top *j* of the heater of Fig. 3, for example) is one way whereby a chamber can be opened when holding brine and closed when holding steam.

In the apparatus of Figs. 1 and 2, (for heating with evaporation of saturated brine) the means for withdrawing the products of the heating operation consist, for each chamber, of a valved vapor outlet *k* and a valved salt outlet *l*. As shown the vapor outlets *k* extend from the small side domes *m* and are united to a common pipe *n*, for leading away the vapors to any desired point of utilization or discharge. The salt outlets are similarly united. If the evaporation is to take place *in vacuo*, the salt outlets have a long leg or other discharging device, such as is used with ordinary vacuum pans.

In the apparatus of Fig. 3 (for heating without evaporation) the product of the heating operation is simply heated brine and the means for withdrawing it consist of a valved conduit *p* for each of the chambers. As shown the arrangement of the pipes marked *h* and *p* respectively, is such that either [the]* pair could be used for introducing the brine to be heated and the other pair for withdrawing the heated brine; and where the heating is without evaporation either pair of conduits could be used either for supply or for discharge.

In operation, brine to be heated, with or without being evaporated as the case may be, is introduced by one of the conduits *h* into the corresponding chamber, (say for example the chamber composed of
the spaces inside of the pipes *a*) and the steam from an appro-
21 priate source is introduced by one of the pipes *f* into the other chamber (to wit, the space surrounding the pipes *a*). The heat of the steam is conducted to the brine through the walls of the pipes *a*, and the steam is at the same time condensed. If the evaporation of the brine is contemplated, the vapor is allowed to escape through the appropriate outlet *k*; and if the brine is, or is allowed to become, saturated, salt is precipitated and accumulates in the salt outlet belonging to the brine-holding chamber; but if the brine is to be heated without evaporation, the heated brine is withdrawn by the appropriate hot-brine conduit *p*; and in any case, the supply of brine is renewed continually with brine from the brine-supply conduit *h*. The salt (when formed) is removed from time to time, or at each reversal, at one of the outlets *l*.

As brine usually holds calcium sulphate in solution, a precipitate of this substance takes place under the action of the heat, or of the heat and -vaporation, and forms an incrustation on the heating surfaces of the brine-holding chamber (to wit, on the inside of the pipes *a* in the example above supposed). After any desired interval, with or without waiting for the coating sensibly to impair the conduction of the heat through the walls separating the chambers, the connections are reversed by opening and closing the proper valves, and the steam is introduced into the chamber which has just been emptied of brine and whose walls have become more or less encrusted as aforesaid (to wit, in the example supposed the steam is let into the inside of the pipes *a*) and the brine to be heated (with or without evaporation) is introduced into the other chamber (to wit, the space outside the pipes *a*) which before was
used as the steam space. As before, the steam imparts its
22 heat through the intermediate conducting walls (to wit, of pipes *a*) to the brine of lower temperature on the opposite side of said walls and is condensed. Where evaporation of said brine is to take place, the temperature of its boiling point under the conditions existing in the brine-holding chamber must be below the temperature of steam condensation under the conditions existing in the steam chamber. As the steam condenses in contact with the

[* Words and figures enclosed in brackets erased in copy.]

calcium sulphate incrustation and the water of condensation runs down the same, the calcium sulphate is gradually dissolved and removed, so that the clean metal surfaces are exposed to the steam. In the meanwhile, however, a crust of calcium sulphate has been gradually forming on the brine side (the outside of the pipes *a* in the example supposed) and continues so to form, until the operator considers it advisable to reverse again the steam and brine supplies. Thus the operation of imparting heat to the brine, with or without evaporating the latter, and with or without the precipitation of salt, may proceed continuously, with the steam and the brine alternately on opposite sides of the heating walls.

The water of condensation is withdrawn continuously or at intervals through the appropriate outlet *g*. A In order to empty the chambers (each in its turn) of brine preparatory to the introduction of steam therein, use may be made of the outlets *g*, or of any other suitable openings at the bottom of the respective chambers. Thus an apparatus having salt outlets could have its chambers emptied of brine through them; or if the heated brine be withdrawn from the bottom of the chambers, these can be emptied through the same outlets; or there may be a special brine draw-off for emptying either or each of the chambers.

Any uncondensed steam may escape by the [of]* same outlet *g*.

23 Where evaporation is to take place in a chamber, it is desirable to arrange for the production of a vigorous circulation; and similar dispositions are sometimes wanted where more elevation of temperature is to be effected. In ordinary vacuum pans, one usual way to accomplish this has been to employ a large pipe in the middle of the heating belt. Such a pipe is shown in Figs. 1 and 2 and furnishes a down-flow passage in the chamber formed by the spaces within the pipes; for the chamber surrounding these pipes a down-flow passage is formed by omitting some of the pipes as shown in Fig. 2. The large pipe could of course be placed at one side and the down-flow passage for the surrounding chamber could be formed through the centre; or both passages could be eccentric.

When the brine on the opposite side of the heat-conducting walls is in ebullition, the transfer of heat through the conducting walls takes place most rapidly and the condensation of steam is most rapid; and there is a certain fitness therefore, when evaporation is carried on in one chamber, in carrying it on also in the other chamber; but, if desired, evaporation can be carried on in one chamber and heating without evaporation in the other, and the apparatus can be adapted to such working. For example, if the apparatus of Fig. 3 be provided (as is the apparatus of Figs. 1 and 2) with a vapor outlet for the end space *c* and a salt outlet for the end space *d*, one of the hot-brine conduits (to wit the conduit for the chamber formed by the spaces inside the pipes) could be omitted. A similar apparatus would be formed if in the apparatus of Figs. 1 and 2 either of

[* Words and figures enclosed in brackets erased in copy.]

the chambers should be provided with a heated-brine outlet,
24 the vapor and salt outlets for this chamber being dispensed with and the inlets and outlets of the other chamber remaining as shown. Other arrangements will suggest themselves.

In any such case, the steam would be condensed in contact with the incrustation in one chamber by the transfer of its heat through the walls to the brine on the opposite side of said walls in order (mainly, and it may be simply) to evaporate the water from said brine; while in the other chamber it would be condensed in contact with incrustation on its side of said walls by the transfer of its heat through said walls to the brine on the opposite side in order to raise the sensible temperature of said brine. Should it require a longer time to remove the incrustation left by the evaporation that that formed by simple heating, the simple heating may be carried on for a longer time. This arrangement (to wit a brine-evaporating chamber on one side the heat-conducting walls and a brine chamber for heating without evaporation on the other) may be desirable for adapting most readily the ordinary vaccum pan, or steam-closed evaporating pan, for operation in accordance with the present invention by adding a steam inlet and a condensed-water outlet to the ordinary brine-holding chamber and a brine inlet and outlet to the ordinary steam space of the heating belt.

In order to condense the steam in contact with the surfaces incrusted with calcium sulphate, it is essential to have a heat-absorbing medium on the opposite side of the heat-conducting walls; and it is an advantage and special improvement to utilize the brine to be heated (with or without evaporation) as such medium by placing it alternately on the opposite sides of said walls; but if it
25 should be preferred to forego the special advantage of this mode, the heat-absorbing medium can be otherwise constituted and the heat absorbed can be utilized in any desired way. If plain water for example were supplied to the outside of heating pipes whose inside surfaces had been encrusted with calcium sulphate and were exposed to steam, the steam could be condensed in contact with the so-encrusted surfaces in imparting to the water the heat necessary to vaporize the same or to raise its temperature: in such case, the water being free from calcium sulphate, there would be no incrustation on the outside of the pipes; and when the steam should be again admitted to the outside of the pipes, to evaporate or to heat without evaporating the brine inside the same, there would be no incrustation to be removed; so that the incrustation-removing operation would be performed only in heating and evaporating A brine within the pipes. The hot water or the steam could be utilized as it is customary to utilize such water or steam.

26 I claim as my invention or discovery:—

1. The process of removing incrustations of calcium sulphate from heating surfaces, consisting in condensing steam in contact with said surfaces by carrying off the heat from the opposite side of the heat-conducting walls, substantially as described.

2. The process of removing incrustations of calcium sulphate from heating surfaces, consisting in condensing steam in contact with said surfaces by transferring its heat to brine of lower temperature on the opposite side of the heat-conducting walls and so carrying off the heat, the steam and brine being applied alternately to each side of said heat-conducting walls so that the heating of the brine and the removal of the incrustation from a previous heating proceed together, substantially as described.

3. The process of removing incrustations of calcium sulphate from heating surfaces, consisting in condensing steam in contact with said surfaces by transferring its heat to saturated boiling brine of lower temperature on the opposite side of the heat-conducting walls and so carrying off the heat, the steam and brine being applied alternately to each side of said heat-conducting walls so that the evaporation of the brine with precipitation of salt and the removal of the incrustation from a previous heating proceed together, substantially as described.

4. An apparatus divided into chambers by heat-conducting walls and provided as to one chamber with a steam-supply pipe, a brine-supply conduit, and means for withdrawing the products of the steam-condensing and brine-heating operations, and as to other chamber with a steam-supply pipe, means for supplying a cooling medium, and means for withdrawing the products of the steam-condensing and the cooling-medium heating operations, substantially as described.

27

5. An apparatus divided into chambers by heat-conducting walls and having each chamber provided with a steam-supply pipe, a brine-supply conduit, and means for withdrawing the products of the steam-condensing and brine-heating operations, substantially as described.

6. An apparatus divided into chambers by heat-conducting walls and having each chamber provided with a steam-supply pipe, a brine-supply conduit, and means for withdrawing water from the steam-condensing operations and water vapor and salt from the brine-heating operations, substantially as described.

28 & 29

In testimony whereof I affix my signature, in presence of two witnesses.

HERMAN FRASCH.

F. W. LOTHMAN.
J. C. UPDEGROVE.

* * * * * * *

30 C. C. K.

WASHINGTON, D. C., *December* 16, 1899.
Mailed " " "

No. 736,843. Filed November 13, 1899. "Means for removing incrustation of calcium sulphate from brine-heating surfaces."

Herman Frasch, care Chas. J. Hedrick, 606 F St. N. W., Washington, D. C.:

Upon perusal of the specification and claims in this case it is seen that two different subjects of invention are presented—process and apparatus. Under rule 41 their joinder in one application is improper, and division is therefore required at the outset (*Ex parte* Rappleye, 85 O. G., 2096).

Claims 1, 2, and 3 are drawn to process; claims 4, 5, and 6 to apparatus. Division on this line must be made before action upon the merits can be given. It is noted that the specification appears unnecessarily prolix. The comparatively simple invention could apparently be presented in less than ten pages.

LITTLEWOOD, *Examiner.*

McE.

31 Room 258.

Herman Frasch. Means for removing incrustation, etc. Filed November 13, 1899. No. 736,843.

WASHINGTON, D. C., *December* 13, 1900.

Hon. Commissioner of Patents.

SIR: When the poet Horace labored to be brief he became obscure.

Applicant desires to be as brief as possible without introducing obscurity. The examiner gives no particulars of improvement in this regard, and it is understood that the suggestion of prolixity is not made a reason for refusing the application.

The sole reason given for this is understood to be the mere presence in the application of *claims* to process and apparatus respectively, the *description* of both being proper and, indeed, necessary.

It is submitted that the Commissioner has no jurisdiction to refuse this application, or, in fact, any application, for any such reason. The reasons for refusing an application are set forth in the statute, and the Commissioner has no jurisdiction to increase or diminish therefrom under the guide of an office rule or in any other way.

The attempt to enforce the presentation in separate applications of claims which the statute authorizes to be made in one is an interference with applicant's legal rights. Not only would it involve applicant in illegal fees and expenses, but it also denies him the protection contemplated by law; for—

"In *Underwood v. Gerber* (C. D. 1893, 340; 63 O. G., 1063; 149 U. S., 224) it was held that where a patentee obtained two patents

on the same day, upon applications filed on the same day, they could not be treated as one patent with two claims." * * *
(Quoted from Miller *vs.* Eagle, C. D. 1894, p. 156.)

32 So long, then, as the fees and other expenses required for two patents and the protection afforded by them are not the same as in the case of one patent with two claims, it is clear that something more than the mere conduct of proceedings is involved in the office rule, and this becomes an infringement on the legal rights of applicant. Most obviously is this so where the matter to be claimed in the subsequent patent is required by statute to be described in the earlier, for "the patentee could not include in a subsequent patent any invention embraced or described in a prior one granted to himself" * * * (James *v.* Campbell, C. D. 1882, p. 85).

The intention of the law is that an applicant shall point out and claim everything described in his specification which, being new and useful, he desires to protect.

That this is the intention of the law is evident from the following considerations:

1. No limitation as to the number or kinds of claim is set forth in the statute.

2. An underlying principle of the patent law is that the protection given to the inventor ought to be coterminous with the new disclosure which he makes to the public, the one being the consideration for the other (Grant *v.* Raymond, 1 Whitman's Patent Cases; 6 Peters, 218).

3. The Supreme Court U. S. have found in a failure to claim matter which is described a presumption of lack of novelty in such matter (Brown *v.* Guild, 6 O. G., 401, column 2; Miller *v.* Bridgeport Brass Co., C. D. 1882, p. 51; Mahn *v.* Harwood, C. D. 1885, p. 149) or a dedication of the same to the public.

4. Under the ruling of the Supreme Court U. S. in James *v.* Campbell, above, if a patentee should not claim all the in-
33 vention disclosed in his patent he cannot get a valid *subsequent* patent for what has been so described without claim.

It is true that an applicant may describe, and, indeed, often must describe, what is public property or is the subject of a prior patent to himself or another, and that such matter cannot lawfully be claimed; but this is simply because said matter is no longer new and the subject of appropriation. It is not because the law intends an inventor in a given specification to point out and claim less than the whole of that which being lawfully described he believes to be his own invention or discovery and in consequence desires to protect by patent.

Moreover, as pointed out in James *v.* Campbell, Mahn *v.* Harwood, and Miller *v.* Eagle, all above, an applicant *in some cases* may reserve a matter described, but not claimed, in a given specification, and may have pending a simultaneous application therefor; but the necessity for an express reservation or a simultaneous application, or both, evidences the expectation of the statute to find in each specifi-

cation a claim to everything therein described for which the inventor desires protection by the patent to be issued on that specification. Any other condition is exceptional, and is so recognized by the decisions.

Moreover, the liberty of reserving to another patent matter described in a given specification and not therein claimed is a limited one (Miller *v.* Eagle, C. D. 1894, p. 157), and what appears in James *v.* Campbell and Mahn *v.* Harwood (both above) ought to be taken subject to the limitation in the former decision, to wit, that "a patentee could not include in a subsequent patent any invention embraced or described in a prior one granted to himself."

34 The decisions in Suffolk Co. *v.* Hayden, 3 Wall., 315, and Washburn and Moen *v.* Beat 'Em All Barbed Fence Co., C. D. 1892, 299, are not contrary to this pronouncement in James *v.* Campbell, because in those decisions the later issued patents was considered "in legal effect * * * a prior patent" (C. D. 1892, p. 304), and did not describe the matter claimed in the earlier issued but in legal effect subsequent patent. So also the circuit court & C. C. A. cases of Thomson and Houston *vs.* Elmira and Horseheads R'y Co., C. D. 1896, p. 122, and same *v.* Ohio Brass Co., C. D. 1897, p. 579.

Still further, even the limited liberty which exists for reserving matter described but not claimed in a patent is a *privilege* belonging to the *inventor*, and not to the Commissioner of Patents. If an inventor attempts to exceed the legal limits of his privilege the Commissioner may resist the attempt, but he has no jurisdiction to compel an inventor to reserve a part of his described invention to a subsequent patent, nor to file a simultaneous or any other application, nor to dedicate a part of his invention to the public, nor to put the inventor in the dilemma of either dedicating a part of his invention to the public or else filing a simultaneous application therefor.

If, however, *neither* of two inventions can be described in the manner required by the statute without describing or substantially suggesting both of said inventions, the law denies to the inventor *all* liberty of obtaining separate patents for said inventions respectively, unless essential modification or qualification can be made in the pronouncement of the Supreme Court in Miller *v.* Eagle, that "where a patentee obtained two patents on the same day, upon applications filed on the same day, they could not be treated as one patent with two claims" (C. D. 1894, p. 156), or in that in

35 James *v.* Campbell, to wit, that "the patentee could not include in a subsequent patent any invention * * * described in a prior one granted to himself" (C. D. 1882, p. 85); for the Miller *v.* Eagle pronouncement would require the two patents to be regarded as prior and subsequent respectively, and since they each contain, and must, under the statute, contain, the same essential description, the one regarded as subsequent would be invalid under James *v.* Campbell, as being for an invention described in a prior patent to the same inventor.

Certainly the Commissioner has no jurisdiction to compel an in-

ventor to dedicate to the public a part of his invention unless he shall be able to secure an essential modification or qualication of the law as pronounced by the Supreme Court U. S.

This is precisely what will happen if separate patents are to be granted in many cases of process and apparatus.

The inventor of a process carried out by apparatus "must describe * * * some apparatus by which the process can be applied" (Tilghman *v.* Proctor, C. D. 1881, p. 177), and the inventor of an apparatus to be used in carrying out a process must describe "the process of * * * using it" (sec. 4888, R. S.).

Consequently in many cases of process and apparatus both must be described as the foundation for any claim at all, and it is not possible to have two patents without including in the subsequent of said two patents an invention described in the prior one granted to the same inventor.

In this connection it should be observed that the invention claimed in the subsequent patent in suit in James *v.* Campbell was a process, and was "embraced or described" in the prior patent only because the implement claimed in this prior patent was used to carry out said process.

36 The Supreme Court U. S. have expressly affirmed an applicant's legal right to one patent with distinct claims therein to process and apparatus respectively, for they said in Merrill *vs.* Yeomans: "If all which is described as new in these specifications is really so, the inventor has a right to a patent for three inventions:

1. For * * * distilling apparatus.
2. For a new process or mode of distilling * * *.
3. For the product of this new process of distillation * * *." (C. D. 1877, page 281.)

And in the telephone cases, "The law has given the discoverer and inventor the right to a patent—as discoverer for the useful art, process, or method of doing a thing he has found, and as inventor for the means he has devised to make his discovery one of actual value." (C. D. 1888, p. 325.)

It is plain that the court meant one patent with distinct claims, because:

1. They say a patent, not patents, nor in general patent protection.
2. In each case the patent in suit was one patent, with distinct claims to process and apparatus respectively.
3. Two patents are not the same thing in legal effect as one patent with two claims; and while this difference was most clearly announced in the latter cases of Underwood *v.* Gerber and Miller *vs.* Eagle (both above), it must legally be presumed to have been in the mind of the court.
4. In the Telephone cases it was expressly recognized that a description of the "means * * * is necessary to show that the art can be used" (C. D. 1888, p. 324), and it cannot be supposed that a subsequent patent for what was thus necessarily described in a prior patent was contemplated, in view of their own pronouncement

in James *v.* Campbell, above, that such subsequent patent must be invalid.

37 In conclusion, then, it is submitted:

1. That an application has the legal right to *claim* in a patent whatever new and useful invention of his own he has the legal right to *describe* in the same patent.

2. That at the least, as Commissioner Paine said in *Ex parte* McClintock, in reference to general and more limited inventions, an inventor in the same patent "may claim what he must describe" (C. D., 1880, p. 50).

3. That where he must describe two things as a statutory condition for claiming either, he not only may claim both, but his only safe course, in view of Miller *v.* Eagle and James *v.* Campbell (both above), is to claim both in the same patent, this being the only possible way to secure valid claims to both unless the pronouncements in these decisions shall be essentially modified or qualified.

4. That the Supreme Court U. S. in Merrill *v.* Yeomans and the Telephone cases (both above) have expressly affirmed an inventor's legal right to claim both process and apparatus in the same patent, so that applicant's right in this regard should be beyond controversy.

5. That no allegation has been made that the statutory description of applicant's process could be made without including his apparatus in the description, and conversely; and that no reason has been or can be given for refusing the present application which would not equally apply to any and every application containing claims to both process and apparatus, no matter how closely related said process and apparatus might be.

38 The Commissioner, then, being without jurisdiction to refuse this application or any application, for the reason given in refusal thereof, it is trusted that no further objection will be made to this application, at least because of such reason.

An allowance is requested.

Respectfully,

HERMAN FRASH,
By CHAS. J. HEDRICK,
*His Attorney.*

39 C. C. K.

DECEMBER 31, 1900.

Mailed " " "

No. 736,843. Filed November 13, 1899. "Means for removing incrustation of calcium sulphate from brine-heating surfaces."

Herman Frasch, care Chas. J. Hedrick, 606 F St. N. W., Washington, D. C.:

The argument filed in this case is simply a denial of the jurisdiction of the Commissioner to make a rule such as rule 41, and terms the requirement here made "an interference with applicant's legal rights."

The rule has been made and approved by the honorable Secre-

tary, and in *Ex parte* Boucher, 88 O. G., 545, applicant will find the reasons which led to the revision of rule 41. That decision forms full answer to the points raised by the argument, and it is suggested that it has been decided that the rules of this office "are just as author-ative as the laws of Congress." United States *ex rel.* Koechlin & Witt *vs.* Commissioner.

The suggestion of prolixity was not given as a reason for
40 refusal of a patent. In fact, no "refusal" appears of record, and in assuming that a patent has been refused the attorney misstates the position of the office.

It is noted that applicant's structure is not found, but that his claims as drawn are broad enough to include many old evaporating structures. See, for instance, Van Ruymbeke, December 3, 1895 (sugar and salt, vacuum pans).

The requirement for division is repeated and insisted on.

LITTLEWOOD, *Examiner.*

[Endorsed:] Serial No., 736,843; paper No. 3.

41 Room 258.

Herman Frasch. Removing incrustation, &c. Filed November 13, 1899. No. 736,843.

606 F ST. N. W.,
WASHINGTON, D. C., *October* 5, 1901.

Hon. Commissioner of Patents.

SIR: The following is in answer to the official letter of December 31 last:

In the Koechlin and Witt case, C. D. 1882, page 442, 22 O. G., 1365, the court said that those Patent Office rules being "reasonable," which are "enacted for its conduct * * * if they are within the powers of the office, are just as authoritative as the laws of Congress itself, if within the limitations of its powers."

Applicant contends that any rule which denies the grant in any and all cases of one patent with both process and apparatus claims is unreasonable, and that it is outside the Commissioner's powers because it attempts to control the substance of applications and not merely the conduct of proceedings in the Patent Office, and also because its provisions would be inconsistent with the law.

On November 13, 1899, applicant filed his present application in all respects in compliance with sections 4888, 4889, 4892, and 4934, R. S.

Soon after an official letter of that date was received, saying that the "papers are duly filed" and that the "case will be taken up for examination in about six weeks."

42 Next followed the official letter of December 16, 1899. I supposed that it was the result of the examination required by section 4893, R. S., and that it was intended to give applicant the information which section 4903, R. S., requires to be given "whenever, on examination, any claim for a patent is rejected."

If any misconception is involved in these suppositions, will the examiner himself please state the position of the office.

The reference cited (patent 550,699 to Van Ruymbeke, 1895) speaks (lines 79–87 of page 1) of certain pipes, $u'$, $u^2$, $u^3$, and $w'$, $w^2$, $w^3$, "which may be opened when it is desired to flush or clean the apparatus with steam or water," and of certain other pipes, $s'$, $s^2$, $s^3$, "for admitting steam or water for this purpose, said pipes leading into the various pans beneath the heating drum thereof."

There is no suggestion, however, by Van Ruymbeke that when steam is admitted its condensation is to be so effected within the pans as that the incrustating material should be dissolved in the resulting water of condensation, nor is there any suggestion of utilizing the steam admitted by pipes $s'$, $s^2$, $s^3$, to heat or to evaporate brine.

There is no suggestion by Van Ruymbeke of any admission of brine or other cooling medium to any heating drum V. If the objection founded upon the reference given is to be insisted on, the examiner is requested to point out the particular places in the patent cited which may be held, respectively, to meet the several terms of applicant's claims.

A reconsideration is requested.

Respectfully,

HERMAN FRASCH,
By CHAS. J. HEDRICK,
*His Attorney.*

43 & 44

OCT. 21, 1901.
Mailed " " "

No. 736,843, filed Nov. 13, 1899, for means for removing incrustation of calcium sulphate from brine-heating surfaces.

Herman Frasch, c/o Chas. J. Hedrick, 606 F St. N. W., city:

The argument filed Oct. 5 has been entered. It is not within the power of the examiner to waive the requirements of the rules as sufficiently set forth in previous office letter.

The requirement of division made in office letter of Dec. 16, 1899, and repeated in that of Dec. 31, 1900, is again repeated.

This action is final on this point.

LITTLEWOOD, *Examiner.*

McE.

* * * * * * *

45

DEC. 16, 1901.
Mailed " " "

# 736,843. Filed Nov. 13, 1899. Means for removing incrustations of calcium sulphate from brine-heating surfaces.

Herman Frasch, care of Chas. J. Hedrick, 606 F St., Washington, D. C.:

The applicant's action of Dec. 13, 1901, is noted.

An appeal in this case is premature, for the reason that there has been no such final rejection as is required by rule 133, nor, indeed,

has there been any rejection. Applicant's case stands under requirement for division under rule 41.

It is noted that neither the examiner nor the board of examiners-in-chief has jurisdiction over the validity of rules, over the Commissioner's power to make rules, or over the power of Congress to make laws to control the Commissioner. Attention is invited to *Ex parte* Frasch, 91 O. G., 459.

The requirement for division was made final in office action of Oct. 21, 1901.

LITTLEWOOD, *Examiner.*

46 Room 258.

Herman Frasch. Removing incrustation, etc. Filed November 13, 1899. No. 736,843.

WASHINGTON, D. C., *December* 18, 1901.

Hon. Commissioner of Patents.

SIR: The following is in answer to the official letter of 16th instant:

To decide whether a given invention is subject-matter for one patent or for two is within the jurisdiction of the examiners-in-chief, according to the rulings in *Ex parte* McDonald, C. D. 1893, p. 99, and in *Ex parte* Hulbert, C. D. 1894, page 1; *Ex parte* Burgess, C. D. 1897, page 64, which rulings are understood not to have been altered.

In Commissioner of Patents *v.* Whitely, 4 Wall., 522, the Supreme Court U. S. decided that a question not involving the novelty, useful-, or originality of the invention was appealable under the statutes then in force.

The matters of merits which are appealable to the board of examiners-in-chief are those affecting the merits of the *patent* to be granted on the *application*, and not merely the merits of the *invention.*

In Neill *v.* Commissioner of Patents, C. D. 1898, page 332, the Court of Appeals D. C. indicated the even rulings of practice would be considered by that court when "some substantial right of a party has been denied." This is also indicated in the later case of Marshutz *v.* Commissioner of Patents, C. D. 1898, page 578.

As understood, the examiner's decision, if sustained, cuts off applicant from obtaining not only such a patent as he asks, but such patent protection as he contends is his legal right. The re-
47 fusal to call the action a rejection does not make it more nor less a final denial of the right claimed. Moreover, it disposes of the application unless and until it shall be amended in matter of substance.

It is conceived that error exists in calling the decision a requirement for division. No division, properly speaking, has or could be required, nor, in fact, is any division contemplated by that portion of rule 41 which is understood to be relied upon.

No division between process and apparatus in certain cases is possible for the reason stated by the Supreme Court U. S. in Leroy *v.* Tatham, 22 How., 132 (underscoring mine):

"And in regard to a practical application of the new conception, it is as necessary as the conception itself, and *they must unite in the patent.*"

I have carefully read the opinion in *Ex parte* Hans A. Frasch, 91 O. G., 459. Said Frasch, it is hardly necessary to say, is not the present applicant. The latter was in no manner a party to the said case.

The said opinion quotes as if from Powder Co. *v.* Powder Works, (98 U. S., 126; 15 O. G., 289) the remark (made in fact in James *v.* Campbell, below) that "a process and a machine are not necessarily one and the same invention. They are generally distinct and different."

This remark implies that a process and a machine may *sometimes* be one and the same invention; and, irrespective of this, it contains no suggestion that after a patent on a process carried into effect with the aid of a machine a later patent on the very identical machine would be valid.

The said opinion quotes the remark in James *v.* Campbell (104 U. S., 356; 21 O. G., 337) that "a patent for a process and a patent for an implement or a machine are very different things."

48 Undoubtedly they are; and they, separately and conjointly, are "different things" from the patent to which "the law has given * * * the right" to applicant—that is to say, a patent for both—"as discoverer for the useful art, process, or method of doing a thing he has found, and as inventor for the means he has devised to make his discovery one of actual value." (See opinion of the Supreme Court U. S. in the Telephone cases, C. D. 1889, p. 325.)

But it does not follow that because a patent for a process would be a different thing from a patent for a machine, that therefore one will not defeat the other when granted to the same inventor.

In James *v.* Campbell, itself a later process patent, — was held void in view of a prior implement patent to the same inventor, the court saying:

"It is hardly necessary to remark that the patentee could not include in a subsequent patent any invention embraced or described in a prior patent granted to himself any more than he could an invention embraced or described in a prior patent granted to a third person."

The Commissioner (Mr. Duell) in the Hans A. Frasch case quotes from former Commissioner Mitchell to the effect that it had been decided over and over again by the Supreme Court of the United States that process and apparatus constitute distinct inventions; but the best evidence of what that court decided *in* the decisions themselves.

No case in the Supreme Court U. S. has been cited in which a later patent has been sustained for the identical apparatus disclosed in a prior process patent to the same inventor, or conversely.

In Tilghman *v.* Proctor, C. D. 1881, page 163, the Supreme Court U. S. are careful to limit the right to a later patent to an *improved* apparatus. They say, referring to Neilson's invention of the hot blast:

"Another person might invent a better apparatus for applying the process than that pointed out by Neilson, and might
49 obtain a patent for such improved apparatus, but he could not use the process without a license from Neilson. His improved apparatus would in this respect stand in a relation to the process analogous to that which an improvement on a patented machine bears to the machine itself." (C. D. 1881, page 175.)

They do not suggest that a later patent to another or to Neilson himself could issue for the very identical apparatus described in Neilson's patent.

The Commissioner (Mr. Duell) quotes from Thomson-Houston Co. *v.* Elmira Co. (71 Fed. Rep., 396) the remark that—

"The invention of a new art, machine, or manufacture, and the invention of an improvement upon either, are substantially distinct and separate; and because this is so, the order of priority between patents to the same inventor for the different inventions, in the absence of abandonment or disclaimer, is immaterial."

Undoubtedly the same person may have one patent for a primary invention and another for an improvement thereon; and it is also true that the patent on the primary invention may issue first or it may in some cases issue second; but if it issue second, then it is supported on the ground that it is *prior in legal effect*, notwithstanding its later issue. As the Supreme Court U. S. said in the Barbed Fence case (Washburn & Moen *v.* Beat 'Em All Barbed Wire Co., C. D. 1892, page 299):

"In legal effect this was a prior patent, since the date of the application and not the date of the patent controls in determining the legal effect to be given two patents issued at different dates to the same inventor and the order in which they are to be considered." (C. D. 1892, near top of page 304).

When the later issued patent for the broad invention cannot be considered the prior in legal effect, it seems to be invalid as in James *v.* Campbell, above, and in Miller *v.* Eagle, C. D. 1894, page 147.

50 The later patent in James *v.* Campbell was a reissue for—

1st. A process.

2d. The implement broadly.

3d. The implement narrowly.

The prior patent was for another form of what would be the same implement considered broadly. The earlier patent (if later in legal effect) could apparently have been considered an improvement on the primary implement or general combination of the later issued patent (the original of the reissue in suit), but such later issued patent was applied for after the issue of the narrow patent, and probably for this reason the narrow, not the broadened, patent was regarded as the earlier "in legal effect," as well as in date of issue.

In Miller *v.* Eagle the later issued patent was the broad patent, and was granted on the earlier (original) application, but the Supreme Court U. S. refused to consider it prior in legal effect because apparently "the power to create a monopoly is exhausted by the first patent." (C. D. 1894, page 156.)

In this case (Miller *v.* Eagle) the Supreme Court U. S. plainly intimate that of two patents, one for a machine and another for a product, the earlier issued might defeat the later issued patent, for they say:

"A single invention may include both the machine and the manufacture it creates, and, in such cases, if the inventions are really separable, the inventor may be entitled to a monopoly of each." (C. D. 1892, page 157.)

The use of the word *if* plainly gives warning that a "machine and the manufacture it creates" are not *necessarily separable*, as rule 41 makes them to be.

In the Hans A. Frasch case the Commissioner says:

51 "This question whether claims for a process and claims for an apparatus should be permitted in the same application is one of office policy."

But from this pronouncement the applicant must with all deference dissent. He submits that the question is one covered by the Constitution and laws passed in pursuance thereof, not one within executive discretion.

In Miller *v.* Eagle the Supreme Court U. S. said:

"It is insisted on the part of the appellee that whether the invention shall be protected in part of its *features* by one patent, and as to the rest by another, or shall be completely protected by a single patent, is a matter which concerns solely the Patent Office and the inventor.

Under the rule announced in the foregoing authorities this proposition cannot be sustained."

With respect to the disclaimer of jurisdiction, attention is called to the fact that a refusal to answer and forward the appeal amounts to a denial not of the examiner's jurisdiction, but only of the jurisdiction of the examiners-in-chief.

It is requested that the appeal to the examiners-in-chief may be answered and forwarded to them for their decision.

Respectfully,

HERMAN FRASCH,
By CHAS. J. HEDRICK,
*His Attorney.*

52 & 53 C. C. K.

DECEMBER 19, 1901.
Mailed " " "

No. 736,843. Filed November 13, 1899. Means for removing incrustation of calcium sulphate from brine-heating surfaces.

Herman Frasch, care Chas. J. Hedrick, 606 F St. N. W., Washington, D. C.:

The letter filed December 18, 1901, has been considered.

The examiner has no power to send forward for consideration by the examiners-in-chief a case which has not received *rejection* upon one or more of the grounds provided in rules 133 and 134. The refusal to send forward is repeated and made final. From this action petition may be taken (rule 145).

The case stands, under requirement of division, between process and apparatus (rule 41), made December 16, 1899; repeated December 31, 1900, and made final October 21, 1901. This final action is also matter for petition.

LITTLEWOOD, *Examiner.*

McE.

* * * * * * *

54 Room 258.

Herman Frasch. Means for removing incrustation of calcium sulphate from brine-heating surfaces. Filed November 13, 1899. No. 736,843.

WASHINGTON, D. C., *December* 19, 1901.

Hon. Commissioner of Patents.

SIR: Your petitioner represents as follows:

First. On November 13, 1899, your petitioner filed his above-entitled application for patent in all respects in due form of law and paid the fee required.

Second. Your petitioner was informed by office letter of said date that his papers were duly filed, and that his said application would be taken up for examination in its order, which it was indicated would be in about six weeks.

Third. By office letter of December 16, 1899, he was informed (*a*) that under rule 41 the joinder of process and apparatus in one application was improper, claims 1, 2, and 3 being drawn to process, and claims 4, 5, and 6 to apparatus; (*b*) that division on this line must be made before action on the merits could be given, and (*c*) that your petitioner's comparatively simple invention could apparently be presented in less than ten pages.

Fourth. On December 13, 1900, your petitioner answered, pointing out (*a*) that he desired to be as brief as possible without introducing obscurity, and that no particulars of improvement in this regard had been given; (*b*) that the sole reason for refusing
55 the application was understood to be the mere presence in the application of *claims* to process and apparatus respectively,

the *description* of both being proper and, indeed, necessary, and (*c*) that the Commissioner of Patents had no jurisdiction to refuse this application or any application for any such reason. By the same communication your petitioner (*d*) persisted in his claim for a patent without altering his specifications (sec. 4903, R. S.), and asked an allowance.

Fifth. By office letter of December 31, 1900, your petitioner was informed (*a*) that the rule was made with the approval of the Secretary of the Interior, is based on reasons stated in *Ex parte* Boucher, 88 O. G., 545, and is "as authoritative as the laws of Congress," citing U. S. *ex rel.* Koechlin & Witt *v.* Commissioner, C. D. 1882, page 442; (*b*) that no "refusal" of a patent "appears of record;" (*c*) that applicant's structure was not found, but that the claims as drawn were broad enough to include many old evaporating structures, one of them being cited by reference to a patent mentioned, and (*d*) that division was insisted on.

Sixth. On October 5, 1901, your petitioner responded, showing (*a*) that by the very decision cited (the Koechlin & Witt case) a rule to be authoritative must be (1) reasonable, (2) for the conduct of proceedings, and (3) within the power of the office, none of which conditions was satisfied by rule 41; (*b*) that applicant supposed the official letter of December 16, 1899, was the result of the examination required by sec. 4893, R. S., and was intended to give applicant the information which sec. 4903, R. S., requires to be given "whenever, on examination, any claim for a patent is rejected," and (*c*) that certain limitations of your petitioner's "specifications" were not found in the patent referred to. In the same communi-
56 cation *be* (*d*) asked for further explanation in case the reference should be insisted on. He further (*e*) persisted in his claim for a patent "without altering his specifications" (sec. 4903, R. S.) and asked a reconsideration.

Seventh. By office letter of October 21, 1901, your petitioner was informed (*a*) that it was not in the power of the examiner to waive the requirements of the rules; (*b*) that the requirement of division made December 16, 1899, and repeated December 31, 1900, was again repeated, and (*c*) that the action was final on this point.

Eighth. On December 13, 1901, your petitioner appealed in due form from the decision of the primary examiner to the board of examiners-in-chief and paid the fee therefor as provided by secs. 4909 and 4934, R. S.

Ninth. By office letter of December 16, 1901, your petitioner was informed (*a*) that an appeal was premature, because there had been no "rejection;" (*b*) that the application stood under requirement of division under rule 41, and (*c*) that neither the examiner nor the board of examiners-in-chief had jurisdiction over the validity of rules nor over the powers of the Commissioner or of Congress. Your petitioner's attention was also invited (*d*) to the decision in *Ex parte* Hans A. Frasch, 91 O. G., 459.

Tenth. On December 18, 1901, your petitioner responded, showing (*a*) that the decision appealed from operated finally to deprive

your petitioner of the patent, and also of the protection to which the law gives him the right; (*b*) that no division, properly speaking, had been required by the examiner or was contemplated by that portion of rule 41 which the examiner relied upon or
57 was, indeed, possible, since the new conception and the means to make it practically useful *must unite in the patent;* (*c*) that the question of whether a given specification set forth subject-matter for one only or for two patents, which was one of the points of the appeal, was within the board's jurisdiction by repeated rulings of different Commissioners, which rulings *had not been altered*, and (*d*) that the refusal to forward the appeal was a denial, not of the examiner's, but of the board's, jurisdiction. Your petitioner (*e*) reviewed the decision in the Hans A. Frasch case and (*f*) requested that the appeal to the examiners-in-chief might be answered and forwarded.

Eleventh. By office letter of December 19, 1901, your petitioner was informed (*a*) that the examiner had no power to forward an appeal unless the case had been *rejected* upon grounds of rules 133 and 134; (*b*) that the refusal to forward the appeal was repeated and made final, and (*c*) that a petition might be taken from this action as also (*d*) from the requirement of division.

Wherefore your petitioner prays as follows:

First. That you will make such order or action as that your petitioner's appeal to the examiners-in-chief may be heard by them.

Second. In the event of a refusal of your petitioner's first prayer, that you will yourself consider the various matters, all and several, raised by said appeal, which is hereby made a part of this petition the same as if here entered in full.

Third. That in any event you will make such order or action as that your petitioner's legal rights may be protected.

Fourth. That you will advise the examiner that his objec-
58 & 59 tion be not insisted upon, whether properly or improperly made by him heretofore, and will direct him to proceed with the application.

Fifth. That you will administer such other or further relief as may be proper in the premises.

A hearing of this petition and appeal is requested at your earliest convenience.

Respectfully,

HERMAN FRASCH,
By CHAS. J. HEDRICK,
*His Attorney.*

* * * * * * *

60 United States Patent Office.

*In re* application of Herman Frasch. Filed November 13, 1899. Serial No., 736,843. Means for removing incrustation of calcium sulphate from brine-heating surfaces.

U. S. PATENT OFFICE, *Dec.* 28, 1901.
Mailed —— —, ——.

Before the Commissioner of Patents on Petition.

*Examiner's Statement.*

To the honorable Commissioner of Patents.

SIR: This petition is taken against the repeated requirements for division between claims for process and claims for apparatus. Applicant was told "that two different subjects of invention are presented—process and apparatus. Under rule 41 their joinder in one application is improper, and division is therefore required at the outset (*Ex parte* Rappleye, 85 O. G., 2096)."

*Ex parte* Rappleye was then in force, and is to the effect that "when the independence of the inventions is clear, division should be made before any action upon the merits."

In the same letter he was further told that "claims 1, 2, and 3 are drawn to process; claims 4, 5, and 6 to apparatus. Division on this line must be made before action on the merits can be given * * *."

Applicant filed an argument against the requirement made, and demanded allowance of the claims as they stood.

He was then told that the arguments which he had filed was simply a denial of the jurisdiction of the Commissioner to
61 make a rule such as rule 41. He terms the requirement made by the examiner "an interference with applicant's legal rights." He was informed that the rule had been made and approved by the honorable Secretary, and that in *Ex parte* Boucher, 86 O. G., 545, applicant would find the reasons which led to the revision of rule 41. The decision forms full answer to the points raised by the argument, and it was suggested that it had been decided that the rules of the office "are just as authoritative as the laws of Congress" (U. S. *ex rel.* Koechlin & Witt *vs.* Commissioner, 22 O. G., 1365); that no "refusal" appears of record, and in assuming that a patent had been refused the attorney misstated the position of the office. In this letter, which was a year later than the first, he was told that his exact structure is not found, but that his claims were drawn broad enough to include many old evaporating structures, and his attention called to the Van Ruymbeke patent. The requirement for division was repeated and insisted upon.

The gist of the next argument, which followed several months later, is to the effect that—

"Applicant contends that any rule which denies the grant in any and all cases of one patent with both process and apparatus claims is unreasonable, and that it is outside the Commissioner's powers be-

cause it attempts to control the substance of applications and not merely the conduct of proceedings in the Patent Office, and also because its provisions would be inconsistent with the law."

He was told that it was not within the power of the examiner to waive the requirements of the rules as asked by him, and division was insisted on.

This was followed by an appeal to the board of examiners-in-chief, which the examiner refused to send forward, and he was informed that an appeal in this case was premature, for the reason that there had been no such final rejection *as is required by rule 133*; nor, indeed, had there been any "rejection;" that the case stood under the requirement for division. That—

"It is noted that neither the examiner nor the board of ex-
62 aminers-in-chief has jurisdiction over the validity of rules; over the Commissioner's power to make rules, or over the power of Congress to make laws to control the Commissioner."

His attention was called to *Ex parte* Frasch, 91 O. G., 459, which decided the points here raised against the applicant.

His prayer should be refused and the petition denied.

Respectfully submitted.

J. B. LITTLEWOOD,
*Examiner, Division VI.*

Washington, D. C., December 28, 1901.

63 Jan. 15, 1902. M. H.

United States Patent Office.

*Ex parte* Herman Frasch. Means for removing incrustation of calcium sulphate from brine-heating surfaces.

Petition.

Application filed November 13, 1899, No. 736,843.

Mr. Charles J. Hedrick for petitioner.

This is a petition from the action of the primary examiner requiring division in the above-entitled case and refusing to forward to the examiners-in-chief an appeal which has been filed.

The application includes claims to a process and claims to an apparatus, and therefore the examiner properly required division and refused to act upon the merits of the claims until that requirement was complied with. The petitioner regarded this as a refusal of a patent to him and filed a request for reconsideration, which he calls a persistence in his claim, under section 4903 of the Revised Statutes, and upon a repetition of the requirement for division filed an appeal to the examiners-in-chief.

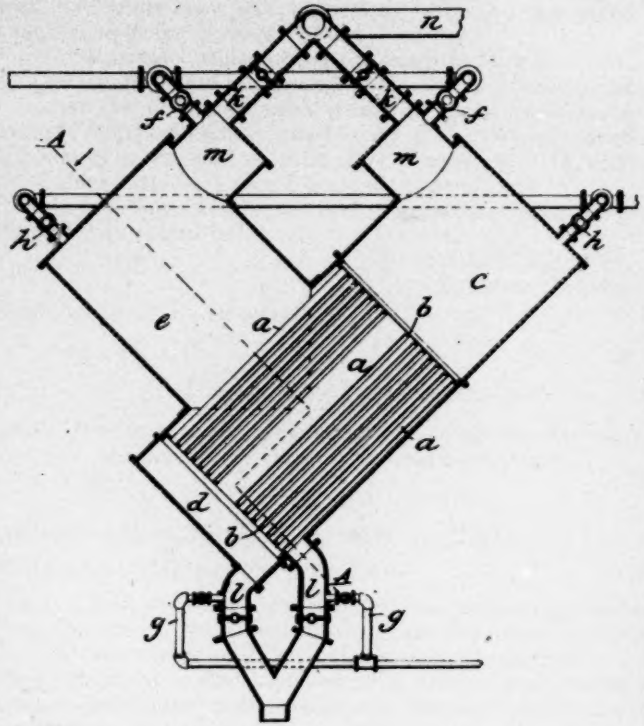
A requirement for division is not an action upon the merits of the application, but is a mere matter of form, and therefore a party has no right of appeal to the examiners-in-chief from such a requirement. It is not a refusal of a patent or patents upon the
64–67 alleged invention or inventions, but is a ruling that the application therefor has not been made in proper form. The



Patent Appeal Docket No. 201

In re application of Herman Frasch } page 69

Fig. 1.




Witnesses:
F. H. Schmitt
R. C. Mizzy.

Inventor
Herman Frasch
by Chas. J. Hedrick
his Attorney

Patent appeal Docket No. 201

In re application
of
Herman Frasch
Ser. No. 69

Fig. 2.

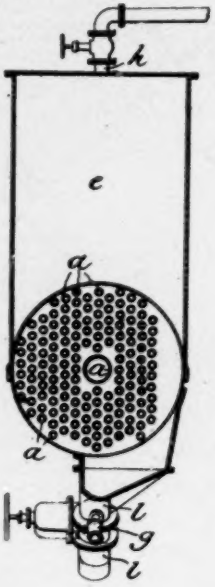
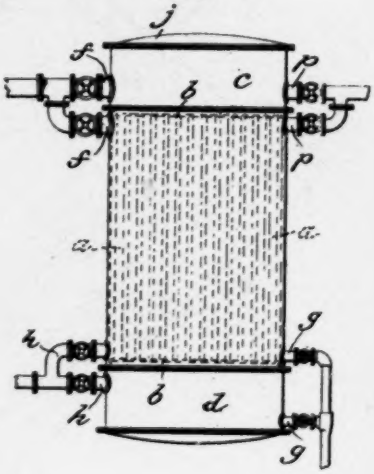



Fig. 3.




Witnesses
F. H. Schott
R. E. Muzzy.

Inventor
Herman Frasch
by Chas. J. Hedrick
his Attorney

requirement of division may be and often is made where all of the claims are admitted to be patentable. The objection is to the way in which the matter is presented and not to the matter itself. The examiner was right in refusing to forward the appeal.

The petition is denied.

F. I. ALLEN,
*Commissioner.*

January 23, 1902.

* * * * * * *

(Here follows drawings marked pp. 68 and 69.)

70 Amount received, $10. Chief clerk. F.

Room 258.

Herman Frasch. Means for removing incrustation of calcium sulphate from brine-heating surfaces. Filed November 13, 1899. No. 736,843.

WASHINGTON, D. C., *December* 13, 1901.

Hon. Commissioner of Patents.

SIR: Appeal is hereby taken to the board of examiners-in-chief from the decision of the primary examiner twice rejecting the claims of the above entitled application for patent.

The points of the decision upon which appeal is taken are as follows:

First. The validity of the authority exercised by the Commissioner of Patents, with the approval of the Secretary of the Interior, under the guise of establishing regulations for the conduct of proceedings in the Patent Office, of adding to or substracting from or in any way modifying the provisions of section 4888 of the Revised Statutes with respect to the substance of the written description, or, in other words, of the specification and claim, required by that section.

The primary examiner is understood in effect to affirm the validity of this authority, since otherwise there would be no ground for the decision appealed from.

Second. The validity of the authority exercised by the Commissioner of Patents in establishing, with the approval of the
70½ Secretary of the Interior, rule 41 of the rules of practice of the United States Patent Office, and in particular in establishing that portion of said rule 41 established February 1, 1900, which reads:

"Claims for a machine and the process in the performance of which the machine is used must be presented in separate applications."

The examiner's decision is understood expressly to be based upon the validity of this authority.

Third. The validity of two patents bearing to each other the following relationships severally, or any two or more, or all of them collectively—that is to say:

(*a.*) The validity of two mutually exclusive patents.

(*b*). The validity of two patents with the same essential specification, neither more nor less, only the *claim* being divided between the two patents.

(*c*.) The validity of two patents for different material reflexes or embodiments of the same conception.

(*d*.) The validity of two patents—one for a process and the other for apparatus—no matter what or how intimate the relationship between such process and apparatus may be.

(*e*.) The validity of two patents—one with that part (or those clauses) of applicant's (appellant's) claim which specifies process, and the other with that part (or those clauses) of his claim which specifies apparatus.

An affirmance of the validity of two such patents is understood to be necessarily involved in the examiner's decision.

Fourth. The validity of the authority exercised by examiner's decision in this case of compelling applicants in general, and the present applicant (appellant) in particular, either to give up a part of his claim entirely or else to accept such protection as might be afforded by two patents bearing to each other the above-recited relationships severally, or any two or more, or all of them
70¾ collectively, except, of course, that the relationship of paragraph (*e*) above would belong to patents to applicant (appellant) in particular and not to the patents of applicants in general.

Fifth. The validity of the authority exercised by the examiner's decision in this case of forbidding applicants in general, and the present applicant (appellant) in particular, to claim all and several the new and useful matters of invention required to be disclosed by him or by them respectively in order to the obtainment of any patent whatsoever, and of refusing the application unless and until a part of such claim shall be canceled.

Sixth. The validity of the authority exercised by the examiner's decision in this case of refusing applications for patents in general, and the above-entitled application in particular, upon the mere ground that the application contains both process claims and apparatus claims.

Seventh. The validity of the authority exercised in this case of refusing the above-entitled application on the grounds of the examiner's decision.

Eighth. The validity and propriety of the examiner's decision if there should be found jurisdictional authority for making the same.

Ninth. The validity and propriety of affirming and enforcing the examiner's decision and the practice represented thereby, should the opinion be held that another decision than the one appealed from would have been inconsistent with the relationship of the examiner to other officers of the Patent Office and the Department of the Interior.

The entire grounds of the examiner's decision are understood to be set forth above, but if any other ground should exist it is requested that the same may be set forth in the examiner's
71–73 answer, in order that it may be considered at the hearing of the appeal

Appellant (applicant) concedes that the claim of his application does cover both process and apparatus, certain clauses or claims being made to process and other clauses or claims to apparatus.

He contends that he has the legal right to make his entire claim with separate clauses or claims of each kind in his said application, and that the examiner's action is an invasion of his said right and *ultra vires*, so far as any authority exists in the Patent Office and the Department of the Interior (either or both) or in the Executive and Judicial branches (either or both) of the Government.

He further contends that any provision of any act of Congress authorizing such action, if any such there be, is unconstitutional and void.

The appeal fee of $10.00 is presented herewith.

Respectfully submitted.

HERMAN FRASCH,
By CHAS. J. HEDRICK,
*His Attorney.*

* * * * * * *

74-84 In the United States Patent Office.

*In re* application for patent of Herman Frasch. Serial No., 736,843. Filed November 13, 1899. Improvements in means for removing incrustation of calcium sulphate from brine-heating surfaces.

WASHINGTON, D. C., *March 4th*, 1902.

To the Commissioner of Patents.

SIR: You are hereby notified of my appeal to the Court of Appeals of the District of Columbia from your decision, rendered on or about the 23d day of January, 1902, rejecting my above-entitled application and refusing me a patent for the invention set forth therein.

The following are assigned as reasons of appeal:

* * * * * * *

85-87

HERMAN FRASCH,
By CHAS. J. HEDRICK,
*His Attorney.*

* * * * * * *

88 In the Court of Appeals, District of Columbia.

In the matter of the application of Herman Frasch. No. 201, patent appeal docket.

It is stipulated by the Commissioner of Patents and the appellant (Herman Frasch) that the annexed official letter, dated November 13, 1899, be included in the evidence in the case and be printed by the clerk as a part of the record.

It is further stipulated that the clerk omit the following portions of the transcript in printing, namely:

(1) all endorsements on all papers; (2) pages 14 and 29 entire,

they being the petition and oath respectively; (3) all matter printed in red on pages 30, 39, 43, 45, 52; (4) all of pages 44, 53, 59, 65, 66, 67, 72, 73, 86, and 87; (5) reasons of appeal, being last nine lines of page 74, all of pages 75 to 84, both inclusive, page 85 down to, but not including, signature, said reasons of appeal being printed in the petition of appeal to this court, *ante*.

CHAS. J. HEDRICK,
*Counsel for Herman Frasch.*
JOHN M. COIT,
*Counsel for Com'r of Patents.*

89 Series of 1880. No. 736,843.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *Nov.* 13, 1899.

SIR: I have to acknowledge the receipt of the petition, specification, oath, and drawing of your alleged improvement in means for removing incrustation of calcium sulphate from brine-heating surfaces, with fifteen dollars as the first fee payable thereon.

The papers are duly filed and your application for a patent will be taken up for examination in its order.

You will be duly advised of the examination.

Case will be taken up for examination in about six weeks.

Very respectfully,
C. H. DUELL,
*Commissioner of Patents.*

Herman Frasch, c/o Chas. J. Hedrick, 606 F St. N. W., city.

[Endorsed:] No. 201, patent appeals. In the matter of the application of Herman Frasch. Stipulation of counsel. Court of Appeals, District of Columbia. Filed Apr. 7, 1902. Robert Willett, clerk.

Endorsed on cover: Commissioner of Patents. No. 201, patent appeal docket. In the matter of the application of Herman Frasch. Court of Appeals, District of Columbia. Filed Apr. 4, 1902. Robert Willett, clerk.

IN THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA, MAY TERM, 1902.

*In re* HERMAN FRASCH. Means for Removing Incrustation of Calcium Sulphate from Brine-heating Surfaces. Patent Appeal No. 201.

## Brief for Commissioner of Patents.

*May it please the Court:*

This purports to be an appeal from a decision of the Commissioner of Patents refusing to grant a patent. The appellant says that his application "was rejected by the Commissioner of Patents and a patent for said invention was refused him."

This statement is not supported by the record, for it is clear from an inspection thereof that a patent has not been refused to this appellant, and no claim in his application has been rejected by any tribunal of the Patent Office. The appeal is clearly out of order, and it is submitted that it should be dismissed.

### FACTS OF THE CASE.

The application includes claims to a process of removing incrustations of calcium sulphate from heating surfaces, and claims to an apparatus for doing the same thing. (See pages 13 and 14, Record.) The primary examiner required division between the process and the apparatus. In other words, he held that the applicant should present in two separate applications the two separate inventions now covered by a single application. This was in strict accordance with rule 41 of the Rules of Practice, which is as follows:

> "41. Two or more independent inventions cannot be claimed in one application; but where several dis-

tinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application.

"CLAIMS FOR A MACHINE AND ITS PRODUCT MUST BE PRESENTED IN SEPARATE APPLICATIONS.

"CLAIMS FOR A MACHINE AND THE PROCESS IN THE PERFORMANCE OF WHICH THE MACHINE IS USED MUST BE PRESENTED IN SEPARATE APPLICATIONS.

"CLAIMS FOR A PROCESS AND ITS PRODUCT MAY BE PRESENTED IN THE SAME APPLICATION."

The appellant attempted to take an appeal to the examiners-in-chief from that requirement, but that appeal was not forwarded for the reason that there had been no rejection of a claim or refusal of a patent, as set forth in the Commissioner's decision on page 30 of the record. It is in view of that decision that this appeal is taken to your honors.

There has been no action by the Patent Office upon the merits of the claims presented by this appellant, since it is the settled practice of that office, founded upon what is believed to be the clear intent of the statutes, not to examine in one application and for one fee several independent inventions. It may be that every claim made by the appellant will be found to be allowable when properly presented for consideration. The objection which has been made is to the way in which the claims are presented, and not to the claims themselves.

This appeal purports to have been filed under sections 4909, 4910, and 4911, Revised Statutes, and section 9 of the act of February 9, 1893, creating this court, but is unwarranted for the reason that there has been no rejection of a claim, which is set forth therein as a prerequisite to the right of appeal. Your honors have repeatedly announced that on an appeal under those sections you will not review the actions of the Commissioner on interlocutory questions or mere matters of practice (Neill *vs.* Commissioner of Pat-

ents, 82 O. G., 749; Marshutz *vs.* Commissioner of Patents, 85 O. G., 778; *In re* Locke, 94 O. G., 432).

The question whether or not division shall be required rests in the discretion of the Commissioner of Patents, and aside from the general principle that a single patent should not cover two or more independent inventions, its determination in many cases turns merely upon office policy, having in view the proper performance of the work presented to it. The question of proper classification of patents so that the work of examining the prior art when new applications are filed may be intelligently performed is an important one to be considered in this connection. As said by the circuit court in McKay *vs.* Dibert, 19 O. G., 1351:

> "* * * the courts have no absolute control over the head of the Patent Office in the exercise of his discretion whether a given invention or improvement shall be embraced in one, two, or more letters patent."

The Supreme Court said in Bennett *vs.* Fowler, 8 Wall., 445:

> "It is difficult, perhaps impossible, to lay down any general rule by which to determine when a given invention or improvement shall be embraced in one, two, or more patents. Some discretion must necessarily be left on this subject to the head of the Patent Office. It is often a nice and perplexing question."

It is not presumed that your honors will entertain appeals from actions of the Commissioner, merely requiring division, or consider the inventions presented in this case to see if the requirement for division was justified. Nor is it presumed, therefore, that on an appeal of this kind you will consider the question as to the validity of the general rule upon the subject which has been adopted by the Commissioner of Patents. As showing the reasons upon which that rule was adopted, however, your attention is called to

the decisions of the Commissioner in *Ex parte* Boucher, 88 O. G., 545, and *Ex parte* Frasch, 91 O. G., 459.

It is a well-settled principle in patent law that a true process is independent of the apparatus by which it is carried out (Cochrane *vs.* Deener, 94 U. S., 780). As said in James *vs.* Campbell, 104 U. S., 356:

> "A patent for a process and a patent for a machine are very different things."

In Heald *vs.* Rice, 104 U. S., 736, the Supreme Court said:

> "A patent for a machine cannot be reissued for the purpose of claiming the process of operating that class of machines, because, if the claim for the process is anything more than for the use of the particular machine patented, it is for a different invention."

If it is for the mere use of the machine, it is not patentable, because not a true process.

In Tilghman *vs.* Proctor *et al.*, 19 O. G., 859, it was said:

> "It is very certain that the means need not be a machine or an apparatus. It may, as the court says, be a process. A machine is a thing. A process is an act or a mode of acting. The one is visible to the eye—an object of perpetual observation. The other is a conception of the mind, seen only by its effects when being executed or performed. Either may be the means of producing a useful result."

The Supreme Court in Rubber Co. *vs.* Goodyear, 9 Wall., 788, said:

> "Patentable subjects, as defined by the patent law, are 'any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter.' A machine may be new, and the product or manufacture proceeding from it may be old. In that case the former would be patentable and the

latter not. The machine may be substantially old and the product new. In that event the latter, and not the former, would be patentable. Both may be new, or both may be old. In the former case both would be patentable; in the latter, neither. The same remarks apply to processes and their results. Patentability may exist as to either, neither, or both, according to the fact of novelty, or the opposite. The patentability, or the issuing of a patent as to one, in nowise affects the rights of the inventor or discoverer in respect to the other. They are wholly disconnected and independent facts. Such is the sound and necessary construction of the statute."

There can be no doubt that a process and an apparatus are divisible inventions, and therefore the question whether or not they shall be divided is a matter left by law to the discretion of the Commissioner of Patents. Section 483 of the Revised Statutes gives him authority to make a rule that a process and an apparatus should be presented in separate applications.

It is submitted that this appeal should be dismissed.

JOHN M. COIT,
*Counsel for Commissioner of Patents.*

# COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

*In re* FRASCH.

Decided June 23, 1902.

Mr. Charles J. Hedrick for the appellant.
Mr. John M. Coit for the Commissioner of Patents.

SHEPARD, *J.:*

The proceeding in this case began with an application by Herman Frasch, filed November 13, 1899, for a patent for a process and apparatus for removing incrustation of calcium sulphate from brine-heating surfaces.

The application concludes with six claims, the first three of which are for the process, and the last three for a particular apparatus to be used in the application of the process.

The primary examiner on December 16, 1899, notified the applicant that his specifications and claims presented two different subjects of invention, namely, process and apparatus, and, calling his attention to rule 41 requiring division in such cases, stated that—

> division on this line must be made before action upon the merits can be given.

Rule 41 reads as follows:

> 41. Two or more independent inventions cannot be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application.
>
> Claims for a machine and its product must be presented in separate applications.
>
> Claims for a machine and the process in the per-

formance of which the machine is used must be presented in separate applications.

Claims for a process and its product may be presented in the same application.

After hearing argument on behalf of the appellant, the examiner repeated the order for division, and notified the applicant that there was no appeal because there had been no rejection of his application. He therefore declined to transmit the case to the examiners-in-chief as appealed from his decision, and called applicant's attention to his right of petition to the Commissioner of Patents under rule 145, which authorizes the review by the Commissioner of any repeated ruling of an examiner—

> which does not involve the merits of the invention claimed, or the rejection of a claim.

On December 19, 1901, applicant presented a petition to the Commissioner, in which he recited the proceedings in the office and the rulings of the examiner and prayed relief.

On January 23, 1902, the Commissioner rendered the following decision upon this petition:

> This is a petition from the action of the primary examiner requiring division in the above-entitled case and refusing to forward to the examiners-in-chief an appeal which has been filed.
>
> The application includes claims to a process and claims to an apparatus, and therefore the examiner properly required division and refused to act upon the merits of the claims until that requirement was complied with. The petitioner regarded this as a refusal of a patent to him and filed a request for reconsideration, which he calls a persistence in his claim, under section 4903 of the Revised Statutes, and upon a repetition of the requirement for division filed an appeal to the examiners-in-chief.
>
> A requirement for division is not an action upon the merits of the application, but is a mere matter of form, and therefore a party has no right to appeal to

the examiners-in-chief from such a requirement. It is not a refusal of a patent or patents upon the alleged invention or inventions, but is a ruling that the application therefor has not been made in proper form. The requirement of division may be and often is made where all of the claims are admitted to be patentable. The objection is to the way in which the matter is presented and not to the matter itself. The examiner was right in refusing to forward the appeal. The petition is denied.

From that decision the appeal has been prosecuted. On behalf of the Commissioner, a motion has been entered to dismiss for want of jurisdiction in this court to entertain the appeal.

The motion to dismiss the appeal must be granted. The right to appeal to this court from a decision of the Commissioner of Patents is limited to two classes of cases: First, where an application for patent has been finally denied; and, second, where, in an interference proceeding, there has been a final determination of the question of priority of invention between adverse claimants (R. S., secs. 4911, 4912, 4913, 4914; R. S. D. C., sec. 780; act creating Court of Appeals, D. C., approved February 9, 1893, sec. 9).

There has been no denial of the application in this case. Its merits have not been considered. The examiner has declined to pass upon the application or to consider the allowance of the claims, because, in his opinion, he is bound by the terms of rule 41 to demand a division of the application—that is to say, a separate application each for the process and for the apparatus embraced in the claims of the pending application. On petition against this ruling, the examiner has been sustained by the Commissioner. It is a mere interlocutory order from which, in either class of cases, there can be no appeal, for reasons which have been heretofore stated, and need not be repeated (*Westinghouse vs. Duncan*, 2 App. D. C., 131, 134). Moreover, upon appeal from a final decision on the merits, it has been held that—

the rulings on questions of mere practice in the Patent Office will not be reviewed in this court, unless it appear that there has been an abuse in the exercise of discretion, and that substantial rights have been thereby affected or denied (*In re Marschutz*, 13 App. D. C., 228, 236; *In re Neill*, 11 App. D. C., 584, 588).

The contention of the appellant is, that rule 41 is inconsistent with the statutes providing for the grant of letters patent, and, therefore, beyond the power of the Commissioner of Patents to enact; wherefore its enforcement in this case has worked a practical denial of the application. That such is the substantial or necessary result of the ruling we cannot agree. We do not mean to say that there may not be a way in which the power to enact rule 41 might be brought in question as necessarily involving the denial of a substantial right under the law.

If there be such a way, however, it has not been pursued in this proceeding. Whether the power exists presents a question of great importance, both to applicants for patents and to the Government, if for no other reason than the doubling of fees which must necessarily result from its strict enforcement. Nevertheless, the question is one of practice, and to be determined by this court must come up, not on appeal from an interlocutory order for the enforcement of the rule, but as necessarily involved in a final decision of the Commissioner rejecting an application for a patent, as intimated in the cases last above cited.

Without intending to intimate any view in respect of the authority for, or the expediency of the purpose of, the enactment of rule 41 by the Commissioner, it may be of some interest to briefly state its history.

The rule, as it now reads, was adopted by Mr. Commissioner Duell July 18, 1899. The change consisted in adding to the rule, as it then read, the three last paragraphs which require separate applications for claims for a machine and its product, for a machine and the process in the per-

formance of which it is used, and a single application for a process and its product.

Under the general terms of the old rule 41, the practice of the Patent Office had varied from time to time under different administrations, and fallen into some confusion as claimed by Mr. Commissioner Duell in a decision wherein he set forth the reasons inducing him to amend the rule in the particulars noted (*Ex parte Boucher*, 88 O. G., 545; C. D., 1899, p. 133, decided July 11, 1899).

In that opinion he referred to the decision of the Supreme Court of the United States which recognized the general discretion committed to the head of the Patent Office in the matter of the division of applications (*Bennett vs. Fowler*, 8 Wall., 445), as well as to the manner in which that discretion had been exercised by many preceding Commissioners.

In a later case he considered the subject again, at length, in justifying the amendment that had been made (*Ex parte Frasch*, 91 O. G., 459; C. D., 1900, p. 50).

In that opinion he cited several decisions of the Supreme Court of the United States, as sustaining his view that a process and an apparatus to be used in its application, are separate and distinct inventions.

Without pursuing the subject further, the appeal will be dismissed without prejudice, for the reasons given; and this decision and the proceedings herein will be certified to the Commissioner of Patents as required by law. It is so ordered.

# Court of Appeals, District of Columbia.

*Patent Appeal Docket.*

*No. 201.*

IN THE MATTER OF THE APPLICATION OF HERMAN FRASCH.

**Brief in Support of Motion to Reinstate and for Other Relief.**

From a decision made January 23, 1902, by the Commissioner of Patents, the applicant took an appeal, which the Commissioner moved to dismiss, and which was dismissed (100 O. G., 1977; D. C. App., —), for lack of jurisdiction in the court to hear the same, the court holding that the decision sought to be reviewed was an interlocutory order and not a final rejection of the application.

The applicant (appellant) moves the court as follows:

(1.) To reinstate his appeal.

(2) To hear and determine his appeal.

(3.) To revise the decision appealed from upon all and several the points set forth in the reasons of appeal.

(4.) To remand the case with directions, if further proceedings in the Patent Office should be deemed necessary or desirable.

(5.) To make such other or further order and to grant such other or further relief as may be proper in the premises.

In the motion it is submitted that the court had and has jurisdiction to entertain the appeal from the decision sought to be reviewed.

I.

Failure to give relief on this appeal, if it does not jeopardize applicant's legal rights, would make them obtainable only through much litigation.

Should he apply for a mandamus to direct the Commissioner to take further proceedings, one defense might be that the Commissioner had finally passed upon the application as presented, and that his errors could be corrected only by appeal.

> "*The question* was vital and its resolution fatal. Only a reversal by the tribunal of appeal could revive it, and cast upon him the duty of further examination" (Commissioner *v.* Whitely, 4 Wall., 522).

The courts on mandamus proceedings might or might not be bound by the ruling dismissing the appeal.

It is understood in the present case that the Commissioner's action, up to a certain point, could be reviewed on mandamus; but appeal is the normal mode of review, since on appeal the whole case can be inquired into (Union Steamboat Co., 178 U. S., 317, 319), even as to matters as to which mandamus would lie.

II.

In Insurance Co. *v.* Comstock, 16 Wall., 258, a writ of error to the U. S. district court had been dismissed by the circuit court. The Supreme Court affirmed the jurisdiction of the circuit court and said (page 271):

> "It is entirely competent for the circuit court, under the circumstances, to grant a rehearing and reinstate the case, and to proceed and decide the questions presented in the bill of exceptions."

The certification to the Commissioner of the decision of dismissal of appeal is not relevant to the present motion. If the court erred in denying its jurisdiction, certification does not take away the power now to correct the mistake any more than it would a superior court's power of mandamus (Parker's case, 131 U. S., 221). Leave to file a petition for mandamus could not be asked until after certification.

III.

In the Whitely case (4 Wall., 522, above) the court said that the Commissioner had found the question whether Whitely was or was not entitled to obtain a reissue without co-owners of the original patent joining in the reissue application

> "lying at the threshold of his duties. It required an answer before he could proceed further. His decision was against the appellant. * * * From this decision, whether right or wrong, the relator had a right under the statute to appeal."

In the Frasch case the present Commissioner has found, as he seems to say, the question whether Frasch is or is not claiming

> "more devices than could properly be made the subject of a single patent" (Sessions *v.* Romadka, 145 U. S., 29)

lying at the threshold of *his* duties and, having decided it against the appellant (Frasch), has refused to proceed further. It is submitted that from this decision, whether right or wrong, Mr. Frasch had and has "a right under the statute to appeal."

This right of appeal cannot be defeated by the form of expression which the Commissioner may give to his decision (Collins *v.* New Hampshire, 171 U. S., 30, 34; Commissioner *v.* Whitely, 4 Wall., 522; 50 Fed. Rep., 863; 94 Fed. Rep., 313).

The main part of the decision is actually expressed as follows:

> "The application includes claims to a process and claims to an apparatus, and therefore the examiner properly required division and refused to act upon the merits of the claims until that requirement was complied with" (printed Record, 30).

Can it be held that Whitely would have been less entitled to an appeal had the Commissioner *required* him to have all co-owners of the original patent join in the application for reissue, *refusing to proceed* further until that *requirement* should be complied with?

Suppose the Commissioner had found one of two claims anticipated and, instead of rejecting the bad claim, had *required* division between the good and the bad, would this form of expressing his conclusion oust the jurisdiction of the Court of Appeals to review such finding? Would the form of expression, "requirement of division," make the order interlocutory?

Under the statutory procedure objection is taken to the substance of a patent application, not by way of demurrer,

plea, or answer, but only by rejection (secs. 4903 and 4909, R. S.) or by refusal of "a patent on application" (sec. 4915, R. S.). A distinction exists between a first (sec. 4903) and a second rejection (sec. 4909) or definitive refusal of "a patent on application" (sec. 4915); after the former the law gives the right to "a re-examination of the case;" after the latter the remedy is by appeal (sec. 4910, etc.), or bill in equity (sec. 4915).

What, then, is the decision appealed from? Does it recognize any right to a re-examination? Does it recognize a right to an examination of first instance?

To these questions the language is pertinent which the court used in the Whitely case (4 Wall., 522, above):

> "The Commissioner says, in his answer to the rule that he could not examine the application, because none had been filed in the Patent Office.
>
> "The position is untenable * * *
>
> "The relator had done all in his power to make his application effectual, and had a right to consider it properly before the Commissioner.
>
> "It was so. * * * It was his first duty to receive the application, whatever he might do subsequently. Without this initial step there could be no examination, and indeed, no rightful knowledge of the subject on his part. Examination and the exercise of judgment, with their proper fruit, were to follow, and they did follow."

The Commissioner's statement (printed Record, 31) that

> "the requirement for division may be and often is made where all of the claims are admitted to be patentable"

requires amendment or explanation of the word "patentable." The following are suggested by way of examples:

*Example a.*

The requirement for division may be, and often is, made where all the claims are admitted to be *otherwise* patentable.

*Example b.*

The *rejection of an application for multifariousness, if authorized by law and otherwise proper*, may be, and, *whether authorized or not*, often is, made where the claims *separately considered might otherwise* be admitted to be patentable.

In Whitely's case the claims might, jointly and severally, have been admitted to be patentable in the Commissioner's sense, that is, when divorced from a particular application; but they were held not patentable on the application as presented; and from "that decision, whether right or wrong," the statute gave to Whitely the right of appeal.

The decision of the Commissioner (present or past) ought to be construed, when possible, not as the arbitrary refusal of an acknowledged right, but rather as a denial of the right itself, to wit, the right of applicant "to receive a patent, according to law, for his invention, as specified in his claim" (sec. 4915, R. S.).

IV.

The decision appealed from was not interlocutory, as contemplating some inquiry of law or fact to be made preparatory to another determination of the same question. (See citations in Richmond *v.* Atwood, C. D. 1892, 676; 52 Fed. Rep., 10.)

The direction of the Commissioner is that applicant abandon part of his claims, so far as the patent on this application is concerned, the abandonment to be absolute or not as other proceedings may determine. Can such a direction be considered as at all preliminary to another determination

of the same question or even the same subject-matter? Does it not rather remove the claim (or part of the claim) finally from decision (Durham *v.* Commissioner, D. C. App., ; C. D. 1895, 314)?

Moreover, there are no matters of law or fact which the Commissioner wishes to inquire into preparatory to his final decision on the application presented. A finding in applicant's (appellant's) favor on matters of novelty and utility would not alter the Commissioner's decision. A finding against them is unnecessary to support the rejection if the decision appealed from is the right use of a valid authority.

The decision appealed from was a final decision within the definition quoted with approval in Kingman *v.* Western Mfg. Co. (170 U. S., 675, 680) from Bostwick *v.* Brinkerhoff (106 U. S., 3), namely:

> "that if there should be affirmance here, the court below would have nothing to do but to execute the judgment or decree it had already rendered."

The decision appealed from was, moreover, the rejection of the

> "application for a patent, on the ground that the applicant is not, on the merits, entitled to it" (Butterworth *v.* U. S. *ex rel.* Hoe, 112 U. S., 50);

that is to say, conceding everything else in applicant's favor, the decision affirms that he is not entitled to the patent applied for because the alleged new invention or discovery includes

> "more devices than could properly be made the subject of a single patent" (Sessions *v.* Romadka, 145 U. S., 29, as above).

There is question whether such an objection would hold in any case, especially when the devices are connected in their design and operation (Hogg *v.* Emerson, 11 How., 587;

Bates *v.* Coe, 8 Otto, 48; Gill *v.* Wells, 22 Wall., 241); but, however that may be and however wrong or right the Commissioner may be, his decision is a definitive determination by him against the appellant on the question whether the patent for which application has been made

> "ought to issue" (Hoe case, 112 U. S., 50, above).

Former Commissioner Marble held:

> "If several distinct inventions were embraced in the same patent, it would be invalid for that reason. When the office, therefore, directs an applicant to divide his application, it is not simply for the purpose of requiring applicant to conform to the classification of the office, nor because it will require more time to examine the matters embraced in the application, but because the patent can cover only a single invention and be valid" (*Ex parte* Van Matteson, 24 O. G., 389; C. D. 1883, 52, 53–54).

Other Commissioners have taken different views of the matter of division; but, whatever may be the opinions of the successive Commissioners, it seems plain that requirement to divide is a determination against the title set up by applicant to "the alleged new invention or discovery" (sec. 4893, R. S.), (which invention or discovery is neither more nor less than the whole subject-matter of the specification; compare the saying in C. R. I. & P. R'y *v.* Martin, 178 U. S., 245, 248, that the "cause of action * * * is for all the purposes of the suit, whatever the plaintiff declared it to be in his pleading"). The requirement to divide is an adjudication "that such applicant is" *not* "entitled, according to law, to receive a patent for his invention, as specified in his claim" (sec. 4915, R. S.).

## V.

It is a recognized principle that the grant of a power involves the grant of the necessary means for carrying the power into effect. Moreover, a denial of the means necessary to a right is substantially a denial of the right itself.

> "We think the right to revive attached * * *. It was a right of substantial value, and became inseparably connected with the cause of action * * *" (*In re* Connaway, 178 U. S., 421, 427, quoting B. & O. R. R. *v.* Joy, 173 U. S., 226).

In this sense, if the appeal to the examiners-in-chief was the necessary means for securing the applicant's (appellant's) legal right, the Commissioner's decision, saying

> "The examiner was right in refusing to forward the appeal" (printed Record, 31),

was a decision reviewable by the court on this appeal.

It is to be observed also that applicant twice refused to divide (printed Record, 15–19, and printed Record, 20–21), and that the examiner declared his decision to be "final on this point" (printed Record, 21), which declaration of finality the examiner twice repeated later (printed Record, 22, and printed Record, 26).

Moreover, applicant's petition, which the Commissioner "denied" without exception (printed Record, 31), contained five prayers which covered all possible forms of relief (printed Record, 28).

The Commissioner's decision outlaws the application, not only from the tribunal of the examiners-in-chief, but from every tribunal in the Patent Office.

Rulings of former Commissioner Hall, pertinent in this connection, are given in parallel columns (italics not in original), as follows:

*Ex parte Firm.*

Decided May 23, 1887, 39 O.G., 1199; C.D. 1887, 27, 31.

"If the specification is too broad, if it covers any of the matter that has been in interference, or if it is so indistinct, informal or ambiguous that the public may be imposed upon by the issuance of a patent, it is the *duty* of the examiner to require correction and modification so as to bring the case within the rules of the office, and *if such correction and modification be not made, to refuse the patent.*"

*Ex parte Mill.*

Decided August 12, 1887, 40 O. G., 918; C. D. 1887, 92 (p. 94).

"Whether the case is allowed or rejected on the merits, until the formal objections are disposed of, a *patent cannot issue,* nor can there be a second rejection, nor an appeal on the merits * * * when in the first step in an examination *a vital objection* to form is seen * * * no further examination is to be had as to merits until it is corrected. * * * (p. 95). The question of division would present *a vital objection* * * * ."

Note, in connection with Mr. Hall's reference to *vital objection*, the language in Whitely's case:

> "*The question* was vital to the application, and its resolution was fatal, so far as he was concerned."

VI.

In Miller *v.* Eagle, 151 U. S., 186, the court refers to the proposition on the part of the appellee that

> "whether this invention shall be protected in part of its *features* by one patent, and as to the rest by another, or shall be completely protected by a single patent, is a matter which concerns solely the Patent Office and the inventor."

The court said:

> "Under the rule announced in the foregoing authorities, this proposition cannot be sustained."

The Commissioner is understood to go even beyond the appellee's proposition, and to contend (so far as the grant of patents is concerned) that the matter rests solely with the Patent Office. He is understood to have moved to dismiss the present appeal simply upon that contention. According to it, the mere *will* of the Commissioner controls, inventors being supposed by him to have no legal rights in the matter.

The Commissioner's action in this case, including the promulgation of rule 41, seems to applicant contrary to section 1, article I, of the Constitution. It seems

> "to legislate, and not to interpret and give effect to the statute as passed by Congress" (Bate Refrigerating Co. *v.* Sulzberger, 157 U. S., 1; C. D. 1895, 233, 251);

for the provisions touching the "payment of fees * * * and other due proceedings" (sec. 4886, R. S.), including "the written description" and specifications of claim (sec. 4888, R. S.), are thought to be part of the "conditions" mentioned in the following extract:

> "But it is for Congress to prescribe the conditions upon which it will secure to inventors the exclusive right to their inventions" (Bate case just above).

This power to prescribe cannot be delegated. If Congress has delegated it, the statute is invalid.

Moreover, Congress itself has no power, under so much of section 8, article I, as relates to inventors and their discoveries, to do other than secure "an exclusive right" to a given "discovery" (or disclosure); it cannot split up into separate transactions what is in its nature one, so as to vest mutually excluding separately assignable rights.

Besides, the Commissioner's decision is not "due process of law" (Art. V of Amdts. to Constitution). It also seems to be wholly without statutory warrant and otherwise prejudicial.

But, whatever may be the correct view of these and other matters, their determination is the proper subject of an appeal.

> "The very point to be decided upon an appeal here is whether they had such discretion and whether they exercised it in a manner that cannot be reviewed in this court; * * * whether in the exercise of what the court asserts to be its discretionary power it has invaded established rights of the petitioners in this case, contrary to law * * * " (Farmers' Loan and Trust Co., 129 U. S., 209).

The Court of Appeals of the District of Columbia has authority to determine (*a*) whether an act of Congress is constitutional; (*b*) whether an office rule is authoritative, because warranted as well by the Constitution as by the actual congressional enactments and because otherwise unobjectionable; (*c*) whether the Commissioner has the discretion which he claims; (*d*) whether, in short, the action sought to be revised was the right exercise of a valid authority.

## VII.

Applicant contends that every applicant has under the statute the legal right to "particularly point out and distinctly claim" *every matter*, otherwise patentable, which is included in the necessary disclosure of the antecedent "written description" and to which applicant lays claim "as his invention or discovery" (sec. 4888, R. S.).

In short, he contends that he "*may* claim what he *must* describe" (Commissioner Paine in *Ex parte* McClintock, 17 O. G., 267; C. D. 1880, 41, 50. Italics not in original).

He is "entitled to receive a patent, according to law, for his invention, as specified in his claim" (sec. 4915, R. S.), and it is no valid objection that his said invention as so specified includes both process and apparatus, the appli-

cant's first disclosure of both being necessarily made in the same application.

Applicant's contentions are set forth in detail in the reasons of appeal assigned to the Commissioner (printed Record, 1–7, and Brief for Appellant, 22–32), in other portions of the record and previous brief. If he should be desired or permitted to elucidate them further, orally or in writing, he will be pleased so to do.

In support of them it may not be amiss to refer here:

(*a.*) to Miller *v.* Eagle (151 U. S., 186), where it is said:

> "In *Underwood v. Gerber* (149 U. S., 224) it was ruled that where a patentee obtained two patents on the same day, upon applications filed on the same day, they could not be treated as one patent with two claims." * * *

(*b.*) To Washburn and Moen *v.* Beat 'Em All Barbed Wire Co. (143 U. S., 275), which seems to require that two patents to the same inventor should be considered in a certain *order*, for it speaks of

> "the legal effect to be given to two patents issued at different dates to the same inventor and the order in which they are to be considered."

(*c.*) To James *v.* Campbell (104 U. S., 356), wherein it is said:

> "The patentee could not include in a subsequent patent any invention embraced or described in a prior one granted to himself any more than he could an invention embraced or described in a prior patent granted to a third person."

(*d.*) To Pope Mfg. Co. *v.* Gormully & Jeffery (144 U. S., 238), which is not in the previous brief and from which it appears that

> "While it is sometimes said that each claim of a patent is a separate patent, it is true only to a limited

> extent. Doubtless separate defenses may be interposed to different claims, and some may be held to be good and others bad; but it might lead to very great confusion to permit a patentee to split up his title within the same territory into as many parts as there are claims."

(*e*.) To McMahan's case (48 O. G., 255; C. D. 1889, 169, 171), which refers specifically to cases of process and apparatus, and says:

> "By requiring two patents to be taken in such cases as this one would cover the right to make and vend the apparatus, while the other would cover only the right to use it. An invention would thus be split up into separate parts, one of which might fall into the hands of one assignee and the other into those of another, perhaps antagonistic."

## VIII.

In Insurance Co. *v.* Comstock, 16 Wall., 258, the court, in dismissing a writ of error, gave to the opinion the effect practically of a writ of mandamus. In Oliver *v.* Felbel (20 D. C. App., ——; 100 O. G., 2384) the court intimated that it was without jurisdiction, yet proceeded to say what it thought "the proper practice to be."

The determination in the court's decision dismissing the present appeal that the decision appealed from was "interlocutory" implies that the Commissioner must do *something*, for the word "interlocutory" (see above) implies further proceedings.

It is conceived that the possession by the court of jurisdiction of the appeal need not prevent it from giving the directions necessary for further proceedings below, nor the want of it from indicating precisely the *procedendo*, whose existence was thought to make the decision appealed from interlocutory. If other proceedings should still be con-

sidered necessary or desirable in the present case, in order to the enlightenment of the court, or to the orderly conduct of affairs, it is trusted that they may be definitely ordered or indicated; but, unless some such reason exists, what advantage can be obtained by additional proceedings in the Patent Office in this case? In view of the Commissioner's attitude, such proceedings would be merely formal and perfunctory.

The Commissioner of Patents does not ask what the court calls in Roehm *v.* Horst (178 U. S., 1, 19) "*a locus penitentiæ.*" He rests upon his decision as a final dismissal of the application. It is this official attitude of finality which compels applicant reluctantly to ask by this motion for a further consideration of the question of jurisdiction.

## IX.

In conclusion, therefore, it is submitted:

(*a.*) That the court had and has jurisdiction to hear and determine the appeal and to revise the decision appealed from as to all and several the points set forth in the reasons of appeal.

(*b.*) That if further proceedings in the Patent Office are necessary or desirable, the court has authority to direct and definitely to indicate what they should be.

(*c.*) That the court has authority to grant some relief on the appeal and motion.

Respectfully,

CHAS. J. HEDRICK,
*Of Counsel for Herman Frasch,*
*Applicant and Appellant.*

Office Supreme Court
FILED
DEC 7 1903
JAMES H. McKENNEY,
Clerk

# Supreme Court of the United States.

October Term, 1903.

No. 13. ORIGINAL.

Ex parte HERMAN FRASCH, Petitioner.

## PETITION FOR WRIT OF MANDAMUS.

**Motion for Writ, Notwithstanding Return, and for Other or Further Relief.**

## BRIEF FOR PETITIONER.

CHARLES J. HEDRICK,
*For Petitioner.*

McGILL & WALLACE, Printers, Washington, D. C.

# Supreme Court of the United States.

**October Term, 1903. No. 13, Original.**

EX PARTE HERMAN FRASCH, PETITIONER.

**Petition for Writ of Mandamus to Court of Appeals District of Columbia—Motion after Return.**

And now, to wit, this 14th day of December, 1903, comes the above-named petitioner, by his attorney, and moves the court to issue a writ of mandamus as prayed for, notwithstanding the return of the justices of the Court of Appeals of the District of Columbia, and to grant such other or further relief as may be proper in the premises.

HERMAN FRASCH,

*By Chas. J. Hedrick, his Attorney.*

IN THE

# Supreme Court of the United States.

**October Term, 1903.**

No. 13, ORIGINAL.

EX PARTE HERMAN FRASCH, PETITIONER.

PETITION FOR WRIT OF MANDAMUS.

## BRIEF FOR PETITIONER.

The present brief is additional to arguments in the exhibits annexed to petition.

### Statement of the Case.

An appeal taken from a decision of the Commissioner of Patents to the Court of Appeals, D. C., was dismissed for supposed want of jurisdiction in the court to hear and determine the same. A petition was filed for a writ of mandamus directing that the appeal be heard and determined.

A rule to show cause having issued and return having been made, the petitioner now asks for allowance of the writ, notwithstanding the return, and for such other or further relief as may be proper in the premises.

In the patent office are three tribunals:

(1) The Primary Examiner (sec. 482, R. S.),

(2) The Board of Examiners-in-chief (sec. 482, R. S.),

(3) The Commissioner (sec. 481, R. S.).

The last named claims, and, in fact, exercises, not only appellate, but also original authority over all applications in every stage, except as controlled by the courts (Anderson and Dyer *vs.* Lowry, 89 Official Gazette, 230); and this claim has received recognition by the Supreme Court, D. C. (Hull *vs.* Commissioner, 7 Official Gazette, 559, and 8 Official Gazette, 46), and by the Court of Appeals, D. C. (Drawbaugh *vs.* Commissioner of Patents, 77 Official Gazette, 313). This plenary authority is not beyond question (Butterworth *vs.* U. S. *ex rel* Hoe, 112 S., 50, 67; dissenting opinion in Hull *vs.* Commissioner, 7 Official Gazette, 562).

The Commissioner objects to petitioner's application for patent solely on the ground that the claims are drawn, some to a process and others to an apparatus.

To enforce such objection he has, by his decision sought to be reviewed,

(1) affirmed a final decision of the Primary Examiner requiring the cancellation of one set of claims;

(2) affirmed the Primary Examiner's decision refusing further action upon the application until one set of claims should be canceled;

(3) refused to allow the Examiners-in-chief to hear an appeal which petitioner took from the final decision of the Primary Examiner aforesaid;

(4) refused to make any order or action whereby fur-

ther proceedings could be had in the patent office (without waiver of claim) or to afford any relief whatever in the premises.

Petitioner has all along asserted, and no tribunal has denied, that the *description* of both process and apparatus is proper and, indeed, necessary (exhibit record, page 15). Under the Commissioner's decision the *claim* to one o them must be *canceled* while the *disclosure* of both must remain. There is no showing as to how, if at all, the process and apparatus could be used separately.

The reasons which petitioner assigned to the Commissioner for the former's appeal to the Court of Appeals (pages 1-7 of exhibit record) are printed in the Appendix hereto (pages i-viii *post*).

## Points.

I. Petitioner's process and apparatus are both essential to a patentable invention under section 4886, R. S.

II. His process and apparatus are both necessarily embraced in the description required by section 4888, R. S.

III. He could not obtain two valid patents without showing a capacity for separate use on the part of his process and his apparatus, respectively, nor could he have two valid patents with the same essential disclosure in each.

IV. He is entitled to one patent with both sets of claims therein.

V. The Commissioner in person has definitely rejected petitioner's application as to part of the invention therein and has refused him the patent applied for.

VI. His decision is not interlocutory but final.

VII. Further proceedings in the patent office would be fruitless.

VIII. The Court of Appeals had and has jurisdiction to hear and determine petitioner's appeal.

IX. Mandamus to the Court of Appeals is petitioner's proper remedy.

X. Petitioner is entitled to some remedy by judicial process.

## I.

*The petitioner's process and apparatus are both essential to a patentable invention.*

> "A patentable invention is a mental result. * * Everything within the domain of the conception belongs to him who conceived it." (Smith *vs.* Nichols, 21 Wallace, 112, 118.)

For obtaining salt from brine, it is common to heat the brine by steam pipes immersed therein; and, inasmuch as brine ordinarily contains calcium sulphate (otherwise sulphate of calcium, sulphate of lime, gypsum), these pipes become incrusted with a coat of calcium sulphate, which interferes with the transmission of heat from the steam to the brine, and which has to be removed from time to time.

Prior to petitioner's invention, the heating of the brine had to stop during each removal of the incrusting coat; and considerable expense for labor was involved in effecting the removals. With the aid of said invention neither stoppage of the heating operation nor additional labor is required.

*I: Invention of both Process and Apparatus essential to Patentability.*

Petitioner conceived that the calcium sulphate could be removed by the action of condensing steam and that the same steam which by its condensation is heating a batch of brine might be simultaneously employed in removing the calcium sulphate deposited from a previous batch.

But, to be patentable, petitioner's new conception had to be "shown to be of practical utility" by having "its material reflex and embodiment" (Smith *vs.* Nichols, as above) in a "machine, process or product" (*ibidem*).

> "A machine is a thing * * visible to the eye—an object of perpetual observation." (Tilghman *vs.* Proctor, 102 U. S., 707, 728.)
>
> "A process is an act or mode of acting * * seen only in its effects when being executed or performed" (*ibidem*).
>
> "When a mode of doing a thing is referred to as something permanent, it is properly termed an *engine*; when to something fugitive a *method*" (page 18 of appendix to 3 Wheaton).

Petitioner's new conceptions required a double embodiment; because the steam and the brine, whose actions are fugitive and seen only in the effects when petitioner's process is "being executed or performed," had to be confined and controlled by an appropriate apparatus which is *permanent* and *visible*.

In LeRoy *vs.* Tatham, the new conception was that seamless lead pipe could be made by dividing the lead and bringing the parts together under heat and pressure. The court said:

> "In regard to the practical application of the new conception, it is as necessary as the conception itself and they must unite in the patent" (22 Howard, 132. 139).

The Tathams' process demanded visible appliances to confine and control the lead; but the apparatus which they used was before known in the manufacture of macaroni.

Petitioner's case was different: no prior apparatus available by him had previously existed. He was obliged, therefore, to originate both a process and an apparatus in order to have an invention which, in the language of section 4886 R. S., should be useful as well as new.

> "The patent was supported because he (Neilson) had invented a mechanical apparatus by which a current of hot air, instead of cold, could be thrown in, and this new method was protected by the patent" (O'Reilly *vs.* Morse, 15 Howard, 62, 116).

> "he was entitled to a patent for that process * * having * pointed out a particular apparatus for that purpose, and having thus shown that the process could be practically and usefully applied" (Tilghman *vs.* Proctor, 102 U. S., 707, 724–725).

> "The art consists in so controlling the force as to make it accomplish its purpose. * * * Bell discovered that it could be done by gradually changing the intensity of a continuous electric current, so as to make it correspond exactly to the changes in the density of the air, caused by the sound of the voice. This was his art. He then devised a way in which these changes of intensity could be made and speech actually transmitted." (The Telephone Cases, 126 U. S., 1, 532-533.)

## II.

*Petitioner's process and apparatus are both necessarily embraced in the description required by section 4888, R. S*

This section, referring to the "invention or discovery," requires

> "a written description of the same, and of the manner and process of making, constructing, compounding, and using it."

> "Perhaps the process is susceptible of being applied in many modes, and by the use of many forms of apparatus. The inventor is not bound to describe them all in order to secure to himself the exclusive right to the process, if he is really its inventor or discoverer. But he must describe some particular mode, or some apparatus by which the process can be applied with at least some beneficial result, in order to show that it is capable of being exhibited and performed in actual experience. (Tilghman *vs.* Proctor, 102 U. S., 707, 728-729.)

> "If the mode of doing it, or the apparatus in or by which it may be done is sufficiently obvious to suggest itself to a person skilled in the particular art, it is enough in the patent to point out the process to be performed without giving supererogatory directions as to the apparatus or method to be employed." (*Ibidem*, 728.)

This is only another way of saying that

> "That which is common and well known is as if it were written out in the patent and delineated in the drawings." (Webster Loom Co. *vs.* Higgins, 105 U. S., 580, 586.)

In such case any necessary apparatus would be embraced in the written description as effectually as if

"delineated in the drawings," and it is none the less true that such reflex and embodiment in visible and permanent form is, if new, as much "within the domain of the conception" (Smith *vs.* Nichols, 21 Wallace, 112, 118) as the process itself.

To avoid doubtful disputation, it is commonly safer to present drawings; but it is the disclosure which is required, rather than a particular mode of making the same.

Every applicant must disclose

> "the whole truth relative to his invention or discovery." (Sec. 4920, R. S.; Electric Boot and Shoe Finishing Co. *vs.* Little, 75 Federal Reporter, 276.)

Section 4888, R. S., says expressly "in the case of a machine," and by implication in other cases, that the inventor "shall explain * * the best mode in which he has contemplated applying that principle" * * .

The same description is apparently required as in a British patent, namely, such a description as

> "that the public may, after the expiration of the term, have the use of the invention in as cheap and beneficial a way as the patentee himself uses it." (page 20 of appendix to 3 Wheaton.)
>
> "The patentee suggests it as what he conceived to be the best way, apparently because the result is produced with great rapidity and certainty." (Tilghman *vs.* Proctor, 102 U. S., 707, 719.)

Petitioner's disclosure of both his process and his apparatus is essential, therefore, to a statutory specification.

## III.

*Petitioner could not obtain two valid patents without showing a capacity for separate use on the part of his process and his apparatus, respectively; nor could he have two valid patents with the same essential disclosure in each.*

To be patentable, an invention must be shown in the patent to be useful; and what is considered at the time of application to be the best mode of carrying it into effect must be disclosed. To be patentable separately, it would seem that inventions must be shown in the patents to be separately utilizable when carried into effect in such best modes, respectively.

> "A single invention may include both the machine and the manufacture it creates, and in such cases, if the inventions are really separable, the inventor may be entitled to a monopoly of each. * * * The cases cited * * * come to this point only, that a later patent may be granted when the invention is clearly distinct from, and independent of, one previously patented." (Miller *vs.* Eagle, 151 U. S., 186, 199.)

Separate utilization would be shown if the patents, arranged in order, should none of them claim any matter necessarily disclosed in any of its predecessors, and the differences should be substantial and not colorable merely. (McClain *vs.* Ortmayer, 141 U. S., 419; McCreary *vs.* Pennsylvania Canal Co., 141 U. S., 459, 467.)

> "This was in legal effect a prior patent, since the date of the application and not the date of the patent controls in determining the effect to be given

to two patents issued at different dates to the same inventor and the order in which they are to be considered." (Washburn and Moen *vs.* Beat 'Em All Barbed Wire Co., 143 U. S., 275, 281.)

"Thus in Suffolk Company *vs.* Hayden (3 Wall., 315), it was held * * * that it is the issue date and not the filing date which determines priority to patents issued to the same inventor on the same machine." (Miller *vs.* Eagle, 151 U. S., 186, 197.)

"It is hardly necessary to remark that a patentee could not include in a subsequent patent any invention embraced or described in a prior patent granted to himself any more than he could an invention embraced or described in a prior patent granted to a third person." (James *vs.* Campbell, 104 U. S., 356, 382.)

"In Underwood *vs.* Gerber (149 U. S., 224) it was ruled that where a patentee obtained two patents on the same day, upon applications filed the same day, they could not be treated as one patent with two claims." * * * (Miller *vs.* Eagle, 151 U. S., 186, 198.)

"When a patentee anticipates himself, he cannot, in the nature of things, give validity to the second patent." (*Ibidem*, 197.)

"This conclusion is no way affected by the reservation attempted to be made in the 1879 patent * * * for the reason that the broad idea sought to be reserved is embodied in identically the same mechanical device constituting the invention and covered by the first patent, which completely occupies all the ground that was reserved." (*Ibidem*, 201.)

"All that the law requires of him is that he shall not claim as new what is covered by a former invention, whether made by himself or some other person." (O'Reilly *vs.* Morse, 15 Howard, 62, 122.)

The foundation for the rulings touching the validity of two patents to the same party appears to be:

First, in the lack of any community of interest in the holders of two patents, although issued to the same person on the applications of the same inventor;

Second, in the nature of "the exclusive right" of the Constitution (Art. I, sec. 8, clause 8) and the statute (sec. 4884, R. S.)

Claims in the same patent support each other as parts of one franchise and exclusive right. (Merrill *vs.* Yeomans, 94 U. S., 568; The Telephone Cases, 126 U. S., 1). They are not separately assignable.

> "While it is sometimes said that each claim of a patent is a separate patent, it is true only to a limited extent. Doubtless separate defenses may be interposed to different claims, and some may be held to be good and others bad; but it might lead to very great confusion to permit a patentee to split up his title within the same territory into as many parts as there are claims." (Pope Mfg. Co. *vs.* Gormully & Jeffery, 144 U. S., 248, 252.)

Claims in separate patents would not support, but antagonize, each other if they at all conflict. The patents would be separately assignable (sec. 4898, R. S.).

The "exclusive right" of the Constitution and statute is more than a bare right to exclude others; it is an exclusive right to exclude others; and it involves a right of not being excluded by others.

If A had a bare right to exclude others, there would be no invasion of that right by allowing B to exclude others also. A could exclude as much after as he could before the grant to B.

But if A has a monopoly of excluding others, then it invades his right to let B exclude on his own account.

Or, if A has a right of use and enjoyment, it invades his right to give to B the power to exclude A.

> "The plaintiff * * * was, therefore, the owner of a monopoly recognized by the Constitution and by the statutes of Congress." (Bement *vs.* National Harrow Co., 186 U. S., 70, 88.)

> "The very object of these laws is monopoly." (*Ibidem*, 91.)

> "That the grant is made upon the reasonable expectation that he will either put his invention to practical use or to permit others to avail themselves of it upon reasonable terms, is doubtless true." (*Ibidem*, 90, quoting 47 U. S. App., 146, 160.)

Two *monopolies* of exclusion, as to the same matter, are in the nature of things impossible: two rights of *mutual exclusion* would defeat the "reasonable expectation" of the last quotation and would tend to retard rather than promote the progress of science and the useful arts.

Like all property, a protected invention must be used in subjection to the police power and eminent domain and to any existing paramount rights, inchoate or perfected; but, like other property also, its use can not be impaired in favor of later or subordinate rights.

Possibly a patent might be paramount to another as to one part and tributary thereto as to another part of its subject-matter, but it can not be both paramount and tributary as to the same part or as to parts necessarily conjoined in use.

If two or more patents could be treated as forming one monopoly in legal effect, there seems to be no reason

(unless lack of consideration for the later grants) why there might not be any number of such patents on one invention, to the same patentee, if they should all be issued on the same day or should otherwise be so limited as to expire together, and should not be assignable separately. Yet in Miller *vs.* Eagle, the court referred to

> "the well-settled rule that two valid patents for the same invention can not be granted either to the same or to a different party" (151 U. S., 186, 197),

and made no exception of patents issued on the same day to the same party.

In McKay *vs.* Jackman, an original process patent, which had been sustained with some "embarrassment" over an earlier machine patent in McKay *vs.* Dibert (5 Federal Reporter, 587), was declared invalid, for one reason, because of James *vs.* Campbell (104 U. S., 356), which was after McKay *vs.* Dibert.

> "As before shown, Blake's machine patent exhibited both the shoe of his product patent and mode of construction of his process patent, to which he was no more lawfully entitled than Norton was to his second patent for what was exhibited in the first." (12 Federal Reporter, 615, 621.)

In Eastern Paper Bag Co. *vs.* Standard Paper Co., the Circuit Court dismissed James *vs.* Campbell as solely "dealing with the subject of reissues under the statute." (30 Federal Reporter, 63, 65.)

But James *vs.* Campbell was not dealing *solely* with reissues.

Norton (the assignor of Campbell) had three patents for implements (apparatus), two issued on August 9,

1859, and December 16, 1862, respectively, and the third on April 14, 1863. This last was applied for January 5, 1863, and reissued in 1870.

> "Now a mere inspection of the patents referred to above will show that after December, 1862, Norton could not lawfully claim to have a patent for the general process of stamping letters with a postmark and canceling stamp at the same time, nor for the general combination of a post-stamper and blotter in one instrument, nor for the combination of a post-stamper and blotter connected by a cross-bar, for all these things, in one or other specific form, were exhibited in these prior patents. Any such claim, therefore, in the reissued patent of 1870 must be inoperative and void, as well because the thing claimed was anticipated in former patents as because it would be for a different invention from that contained and described in the original patent." (104 U. S., 356, 382.)

Norton's prior *implement* patents were held to anticipate the *process*, as well as the general combination, notwithstanding the declaration, in the same opinion, that for the purposes of a reissue

> "A patent for a process and a patent for an implement or a machine are very different things. (*Powder Co.* vs. *Powder Works*, 98 U. S., 136.) * * a process and a machine for applying the process are not necessarily one and the same invention. They are generally distinct and different. The process or act of making a postmark and canceling a postage stamp by a single blow or operation as a subject of invention is a totally different thing in the patent law from a stamp constructed for performing that process." (James *vs.* Campbell, 104 U. S., 356, 377.)

To uphold the reissue for the process or general combination (either or both)

> "would be to grant a new and distinct privilege to the patentee" (Dunham *vs.* Dennison Mfg. Co., 154 U. S., 103, 111).
>
> "not the invention he sought to secure" (104 U. S., 356, 378)

when Norton applied for the original patent for a specific implement.

Whether the process or general combination (either or both) on the one hand, and the specific implement exhibiting the same as useful on the other, were or were not capable of being secured by separate patents would be determinable by other principles.

Had Norton's process and general combination claims been made in his 1859 patent, or had they been made in a patent prior in legal effect to the 1859 patent, they would have been unobjectionable on the ground of anticipation.

The specific form by which the process and general combination would be exhibited in such prior patent would have to be claimed in the same patent; but each subsequent specific form could be regarded as

> "A new idea * grafted upon an old invention, * distinct from the conception which preceded it, and be an improvement." (Smith *vs.* Nichols, 21 Wallace, 112, 118).

But "everything within the domain" of the prior conception "belongs to him who conceived it" (*Ibidem*). It does not matter

> "whether what preceded was covered by a patent or rested only in public knowledge and use. In neither case can there be an invasion of such domain, and an appropriation of anything found

> there. In one case everything belongs to the prior patentee, in the other to the public at large." (*Ibidem*, 119.)

This language was not used with respect to conceptions of the same inventor; but priority between such conceptions exists (pages 11 and 12 *ante*) when by obtaining separate patents the personality of the inventor has been lost in holders of separately assignable exclusive rights.

If petitioner should take two patents, each of them would necessarily be an invasion of the domain of the other and an appropriation of matter necessarily found there, in order to exhibit a thing of practical utility. The later patent would attempt to deprive the holder of the prior patent of the use and enjoyment, in the identical form therein described, of the matter claimed in such prior patent. It would destroy the monopoly of the prior patent to the use of what would be therein claimed; because the holder of the later, as well as the holder of the earlier patent, could exclude others from practicing the thing patented in said earlier patent.

In Rubber Co. *vs.* Goodyear, the court, after referring to a "machine * and the product or manufacture proceeding from it," and also to "processes and their result," said:

> "The patentability or the issuing of a patent as to one in nowise affects the rights of the inventor or discoverer in respect to the other." (9 Wallace, 788, 796.)

But the court there was dealing with divisional reissues, and not with original patents. Its remarks are *obiter;* for only one, and that the lower numbered, of the two divisions, was sustained.

The remarks themselves seem inconsistent with the later decision in Mosler Safe and Lock Co. *vs.* Mosler, Bahman & Co. (127 U. S., 354), in which the process patent was defeated by a product patent previously issued to the same inventor on a contemporaneous application. The said remarks do not in terms refer to process and machine (apparatus), respectively.

In Cochrane *vs.* Deener (94 U. S., 780), the reissues of four original patents, issued on the same day, were held valid and infringed. The first of these reissues was for the process and the others for combinations of mechanical devices. These were not necessarily (if in fact) disclosed in the process patent; because neither the "suction-pipe" of the first mechanical patent (94 U. S., 788), nor the "collecting-chamber" of the two later mechanical patents (94 U. S., 789), was necessary to the process which comprised

> "the application of the blast, and the carrying off of the fine impurities whereby the middlings are purified preparatory to regrinding after being separated from the other parts." (94 U. S., 786.)

No consideration was given by the court to the effect of disclosure in prior (process and machine) patents on later (machine) patents, under the doctrine afterwards elucidated in James *vs.* Campbell, 104 U. S., 356; Miller *vs.* Eagle, 151 U. S., 186; and other cases herein cited.

The court, in 95 U. S., 355, refused to set aside the decision in Cochrane *vs.* Deener (above) as collusive, but declared the defense to have been weak and the decision itself to be not binding as authority.

In Oval Wood Dish Co. *vs.* Sandy Creek, N. Y., Wood Mfg. Co., there were three patents granted on contemporaneous applications, the first filed and first issued for the product, the next filed and next issued for the machine, and the last filed and last issued for the process. The Circuit Court held that

> "after the dish and the machine patents there was no room for the process patent." (60 Federal Reporter, 285, 290.)

In Underwood *vs.* Gerber, the Circuit Court said:

> "This novel method of manifolding an invention was adopted, as complainants state, in order to comply with recent decisions of the Patent Office, interpreting Rule 41 of that office, and holding that when a person has invented something in an art, or, as it is ordinarily called, 'a process,' also a machine for carrying out the process, and also the manufacture or article which is produced in the operation or process by the machine, he must take out three separate patents—one for the process, one for the machine, and one for the product." (37 Federal Reporter, 682, 683 684.)

## IV.

*Petitioner is entitled to one patent with both sets of claims therein.*

Petitioner's right to the protection being unquestioned, if both sets of claims would be valid only when obtained in the same patent, his legal right to the single patent must necessarily be conceded.

The same conclusion follows an independent consideration of the law.

The Commissioner has *authority* under the law to issue a patent with claims therein to process and apparatus, re-

spectively. They are "connected in their design and operation" (11 Howard, 587, 606). Industrially considered, they have the same "nature and design" (sec. 4884, R. S.). Hundreds, not to say thousands, of such patents have been issued. They have been uniformly sustained when they have come (as many have come) into litigation.

Silisby *vs.* Foote, 20 Howard, 378.

Merrill *vs.* Yeomans, 94 U. S., 568.

American Cotton Tie Co. *vs.* Simmons, 106 U. S., 89, 92.

The Telephone Cases, 126 U. S., 1, 537.

Hoyt *vs.* Horne, 145 U. S., 302, 304.

With some exceptions, the practice of the patent office has always been to include in the same patent process claims and apparatus claims, based on the same essential disclosure. There was no attempt until 1899 to establish the contrary practice by regulation approved by the Secretary of the Interior.

Failure to secure both in one patent gave "embarrassment" to the Circuit Court in McKay *vs.* Dibert (5 Federal Reporter, 587, 590), and apparently resulted in the defeat of the process claim in McKay *vs.* Jackman (12 Federal Reporter, 615), and the Oval Dish case (60 Federal Reporter, 285).

In James *vs.* Campbell, the court indicates with respect to each of Norton's broad claims (for the process and general combination, respectively) that

> "he might have asked to have it patented at the same time and in the same patent" (104 U. S., 370)

with the specific form of implement.

In New *vs.* Warren, the Circuit Court said with respect to a process claimed in the reissue of a machine patent

> "The description on which it was founded was in the original, and the process, if patentable at all, might have been claimed there; but it was not." (22 Official Gazette, 588, second column.)

In Merrill *vs.* Yeomans, the court said of a single patent:

> "There is no question here but that the patent is good for the second claim, for the superheating coil, with its steam pipe, &c. And we are all of the opinion that it is good for the process of distillation described in the specifications, by which the heavy hydrocarbon oils are deodorized. It is, therefore, a valid patent for two important matters well set forth and described." (94 U. S., 568, 573.)

In the Telephone Cases, the Court sustained Bell's single claim as covering both process and apparatus.

> "But this argument ignores the fact that the claim is, first for the process; and second, for the apparatus. It is to be read (1) as a claim for the method of transmitting vocal and other sounds telegraphically, as herein described, by causing electrical undulations similar in form to the vibrations of the air accompanying the said vocal or other sounds, substantially as set forth, and (2) for the apparatus for transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations . . . substantially as set forth." (126 U. S., 1, 537.)

Not only is a process-apparatus patent authorized; but there is *no direction* in the statute making it the Commissioner's *duty* to *refuse* an application because it contains claims to apparatus and process, respectively.

Such direction has been sought

(1) in the wording of section 4886 R. S., which specifies "art, machine, manufacture or composition of matter";

(2) in a supposed necessity for strict unity in the subject-matter of each patent;

(3) in the examination system on account of a supposed greater facility of classification by having two patents with the descriptive portions of their specifications identical;

(4) in the necessity for more fees, in view of the fact that

> "The expenditures of the office, if the present system of examination is to be continued, must, from the very nature of things, continue to increase, and it will be an unfortunate day for the system when the expenditures of the Patent Office exceed the receipts." (*Ex parte* Boucher, 88 Official Gazette, 545, 548.)

In Boucher's case the Commissioner also said, with reference to a patent containing process claims and apparatus claims, that

> "if a case is ever presented for consideration which compels the decision of the question * I fail to see how the patent can either lawfully or logically be upheld." (88 Official Gazette, 546, bottom of column 2.)

This last objection goes, however, to the Commissioner's *authority*, not to his *duty* under the authority; it goes to the *mandate*, not to the *direction* of the statute. It is sufficiently covered by what has been said on pages 21, 22, *ante*.

(1.) The Constitution speaks of the discoveries of in-

ventors and obviously includes both processes and apparatus in the term "useful arts." The "art" of the statute should receive a similar construction:

> "An art may require one or more processes or machines in order to produce a certain result or manufacture (Corning *vs.* Burden, 15 Howard, 252, 267.)
>
> "To sum up the state of the art, * * * What then was the contribution of this patent to the art?" (referring to the patent for the *machine* in suit in National Cash Register Co. *vs.* Boston Cash Indicator and Recorder Co., 156 U. S., 502, 513.)

If the language of some opinions might seem restrictive, it will probably be found that no more was intended than that the patentability of a process results from the use of the word "art" in the statute.

The early acts of Congress, including the Act of 1836, were entitled "Acts to promote the progress of useful arts."

In the Act 1800, chapter 25, section 1, reference is made to

> "any invention, art or discovery."

Yet the act to which it was supplementary had the present wording of

> "art, machine, manufacture or composition of matter." (Act of 1793, chap. 11, sec. 1.)

The Act of 1790 had specified

> "any useful art, manufacture, engine, machine or device." (Chap. 7, sec. 1.)

The word "art" in all the acts, as in the Constitution itself, includes all the rest which were added in the statutes only for further assurance.

(2.) It may be argued that a patent must be for an invention (singular number), that a single invention can be expressed in a single claim, and that, therefore, the Commissioner ought to allow only one claim to be made at a time in the same application. This argument contradicts the wording of the statute, which speaks in the plural of "specifications" (next to last line of sec. 4903, R. S., and lines 13 and 14 of sec. 4622), and "any of the claims" (line 2 of sec. 4909), which allows a decree for a patent not only for the "invention as specified in his claim," but "for any part thereof" (sec. 4915, R. S., lines 8 and 9), which allows divisional reissues

> "for distinct and separate parts of the thing patented" (sec. 4916, R. S., lines 16 and 17),

which upholds the validity of a patent

> "for all that part which is truly and justly his own, provided the same is a material and substantial part of the thing patented." (Sec. 4917, R. S., lines 5 to 7)
>
> "definitely distinguished from the parts claimed without right." (Sec. 4922, R. S., line 12.)

The thing patented may consist, therefore, of "definitely distinguished parts" under the express words of the statute.

In Bates *vs.* Coe and Parks *vs.* Booth, the court said:

> "More than one patent may be included in one suit and more than one invention may be secured in the same patent" * * (98 U. S., 31, 48; 102 U. S., 96, 105.)

(3.) It is better for classification purposes not to have two patents with the same essential disclosure in each.

A given description would best be in one place only, if the guides point unerringly to that place. If the classification is so faulty that duplication is necessary, duplicate copies of any patent specification are sold by the Patent Office at five cents each.

The supposed facility for classification, if it existed, is outside the statute and is not a direction of the same to determine the Commissioner's duty. Certainly it counts for nothing against a fair performance of the inventor's contract. Under this he must originate a useful invention and disclose "the whole truth" relative thereto; it is not fair to object to his claiming whatever is new in the necessary disclosure.

(4.) Section 4886, R. S., refers to

"payment of the fees required by law"

and section 4934, R. S., gives the fee bill. Neither section can be considered a direction making it the duty of the Commissioner to manifold specifications with consequent fees, when the patent system seems to him to need all the money it can get.

The general principle of law is that what the law authorizes for an individual's benefit it commands to be done, in the absence of any contrary direction. This applies especially to inventors.

> "To promote the progress of useful arts is the interest and policy of every enlightened government. * * * This subject was among the first which followed the organization of our Government. * * * It can not be doubted that the settled purpose of the United States has ever been, and continues to be, to confer on the authors of useful inventions an exclusive right to their inven-

tions for the time mentioned in their patents. It is the reward stipulated for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions. The laws * * * ought, we think, to be construed * * * to execute the contract fairly on the part of the United States, where the full benefit has been actually received, if this can be done without transcending the intention of the statute or countenancing acts which are fraudulent or may prove mischievous." (Grant *vs.* Raymond, 6 Peters, 218, 241-242.)

"But the discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use which he may perfect and make absolute by proceeding in the manner which the law requires." (Gayler *vs.* Wilder, 10 Howard, 477, 493.)

"The Government of the United States, as well as its citizens, is subject to the Constitution; and when it grants a patent the grantee is entitled to it as a matter of right, and does not receive it, as was originally supposed to be the case in England, as a matter of grace and favor." (James *vs.* Campbell, 104 U. S., 356, 358.)

The statute is mandatory:

"the Commissioner shall issue a patent therefor." (Sec. 4893, R. S.)

"Congress are not empowered to grant to inventors a favor, but to secure to them a right. And the term 'to secure a right' by no possible implication carries with it the opposite power of destroying the right in whole or in part." * * * (Court of Claims in McKeever *vs.* U. S., in 23 Official Gazette, 1525, column 2 of page 1526; affirmed by Supreme Court U. S., 23 Official Gazette, 1530, column 1.)

The vesting of petitioner with an inchoate right does not imply a direction to defeat or impair that right by

frittering it away by duplication of patents or by illegal and in many cases prohibitive exactions.

Section 483, R. S., neither empowers nor directs the Commissioner to make a rule as to what claims are proper in a given patent.

> "But they are to be deemed such, not because the Secretary of the Navy has announced that they will so regard them, but because they are, in fact, services performed at sea, and not on shore." (U. S. *vs* Symonds, 120 U. S., 46, 49.)

The statute only authorizes the Commissioner to regulate the *conduct* of proceedings, which themselves are statutory. Rule 41 attempts to prescribe the substantial contents of the specification and claim and so of the patent to be issued.

It is for

> "Congress to prescribe the conditions upon which it will secure to inventors the exclusive right to their inventions" (Bate Refrigerating Co. *vs.* Sulzberger, 157 U. S., 1, 43),

and when an Act of Congress authorizes a given patent upon given fees and proceedings, it is evidence that no other condition is included in the contract.

Petitioner's process is a pioneer process; and his apparatus is a pioneer apparatus. In one patent both sets of claims would be certainly sustained with the scope given to a pioneer invention. Does anybody certainly know that the courts would sustain the claim in the later patent with the same liberality, if at all?

The Patent Office

> "is more liberal in construing the differences between claims in one application than if they were

> in separate applications both as to the materiality and the patentability of those differences" (*ex parte* Griffith, 85 Official Gazette, 936, column 2 of page 937).

The opinions in McKay *vs.* Jackman (12 Federal Reporter, 615); McClain *vs.* Ortmayer (141 U. S., 419); Underwood *vs.* Gerber (37 Federal Reporter, 682; 149 U. S., 224), show that the same difference in liberality of treatment is shown by the courts.

The policy of the statute is against rather than in favor of the multiplication of patents.

This is shown by the requirement of section 4886, R. S., that the invention must be useful, of section 4888, R. S., that the process of using the invention in the "best mode" must be described (expressly in case of machines and impliedly in other cases), of section 4920, R. S., that nothing "less than the whole truth relative to his invention or discovery" must be set forth.

The idea of the law is not to restrict the subject-matter in a given patent, but to obtain the fullest information for the public benefit and to give a commensurate reward.

It is also shown by the fact that claims as such are not assignable (page 13 *ante*); and that the Commissioner may allow or refuse, but can not require, a reissue in *divisions*.

> "The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant." * * (Sec. 4916, R. S., lines 15 to 18.)

The *demand of the applicant* is the condition precedent for any exercise of discretion by the Commissioner. The Act of 1837, chapter 45, section 5, made it necessary that

> "the patentee shall desire several patents to be issued for distinct and separate parts of the thing patented."

The *discretion* referred to in Goodyear *vs.* Waitt, 5 Blatchford, 468, and Bennett *vs.* Fowler, 8 Wallace, 445, was just this authority to refuse or to allow a reissue applicant's demand for divisional patents. It recognizes no authority in the Commissioner to demand a division against the desire of the applicant.

The statute, morever, does clearly direct the allowance in a patent of whatever claims may be proper to protect all the novelty necessarily disclosed therein.

The plain meaning of section 4886, R. S., is that whatever is essential to usefulness is, at the least, part of the thing (or invention) for which "any person," otherwise entitled, may, by a single application, "upon payment of the fees required by law, and other due proceedings had, obtain a patent."

When section 4888, R. S., says

> "and he shall particularly point out and distinctly claim * * as his invention or discovery,"

it does not mean subject to the will of the Commissioner of Patents. The plain meaning is that, after the inventor has set forth "the whole truth relative to his invention or discovery" (sec. 4920, R.S.), he has full liberty to claim whatever he regards as his own within that disclosure, subject to a traverse of his claim to novelty, originality

and present title, and that by the statutory requirement of disclosure in one specification the Commissioner is concluded from any refusal for multifariousness.

This was the view of the Commissioner in *ex parte* McClintock.

> "The inventions covered by a generic and a specific claim are distinct, although dependent, inventions. The only ground upon which one specific claim can be joined in the same patent with a generic claim is that the applicant, in order to support his generic claim, must describe some one of the species, and may claim what he must describe" (17 Official Gazette, 267, column 2 of page 271).

In Miller *vs.* Eagle, the court held that general (generic) and more limited (specific) claims could not be sustained in separate patents when "embodied in identically the same mechanical device" (151 U. S., 186, 201).

As shown above, petitioner had to invent and describe his apparatus in order to support a process claim; and the process is exhibited as useful by the aid of the identical apparatus in which his apparatus claim is embodied.

Conversely the only known use of the apparatus is to carry out the process; and this latter is, therefore, necessarily disclosed as a basis for an apparatus claim.

From the analogy, declared by the court in Bates *vs.* Coe and Parks *vs.* Booth (page 25 *ante*), between the inclusion of inventions in the same patent and the inclusion of patents in the same bill in equity, it seems to follow that the law for joinder of claims in a patent is at least as liberal as that for joining patents in a bill.

> "When a bill alleges infringement of several patents for different inventions, to escape the objection of multifariousness, it must aver that the inventions are capable of conjoint use, and are in fact so used by the defendant" (Barney *vs.* Peck and Snyder (16 Federal Reporter, 413).

The Supreme Court U. S. in express words has declared the *legal right* to one patent claiming and securing both the process and the apparatus.

> "It is fairly to be inferred from this statement, that if all which is described as new is really so, the inventor has a right to a patent for three inventions:
>
> 1. For a modification or improvement in the distilling apparatus.
> 2. For a new process or mode of distilling heavy hydrocarbon oils, by which they are deprived of their offensive odors.
> 3. For the product of this new process of distillation, namely, the deodorized heavy hydrocarbon oils fitted for use in the arts." (Merrill *vs.* Yeomans, 94 U. S., 568, 569).

> "For such discoveries and such inventions the law has given the discoverer and inventor the right to a patent—as discoverer for the useful art, process or method of doing a thing he has found, and as inventor for the means he has devised to make his discovery one of actual value. (The Telephone Cases, 126 U. S., 1, 533).

## V.

*The Commissioner in person has definitely rejected petitioner's application as to part of the invention, and has refused him the patent applied for.*

The decision appealed from implies the patentability of both sets of claims as separate franchises; but it de-

nies the right of petitioner to both as parts of one franchise.

Two patents do not form the same thing legally as one patent with all the claims therein; and even if two were just as good as one, it seems idle to refer to a requirement of division (which refuses the one patent applied for) as other than a rejection, at least in part, of petitioner's "claim for a patent" (sec. 4903, R. S.).

Where a subject-matter which may properly be covered by one patent might also properly be protected in two patents, the option of taking two patents in place of one is the property of the inventor, no less in the case of original patents than of reissues (sec. 4916, R. S.).

But every subject-matter is not thus divisible.

> "The case against one defendant may be so entire as to be incapable of being presented in several suits" (Story's Equity Pleading, section 271*a*).

Claims may be so interconnected as to be invalid in part in separate patents (Miller *vs.* Eagle, 151 U. S., 186; pages 11–20 *ante*).

Moreover, even if two patents were (as they are not) the legal equivalent of one patent, the contract of the United States with inventors includes the perfecting of their inchoate rights upon the fees and proceedings prescribed by statute (sec. 4886, R. S.; Gayler *vs* Wilder, 10 Howard, 477, 493).

> "A defendant has no right to say that an action shall be several which a plaintiff elects to make joint. A separate defense may defeat a joint recovery, but cannot deprive a plaintiff of his right to prosecute his own suit to final determination in his own way. The cause of action is the subject-matter

> of the controversy, and that is for all the purposes of the suit, whatever the plaintiff declared it to be in his pleading" (Torrence *vs.* Shedd, 144 U. S., 527, 531; quoted in C., R. I. & P. Ry. *vs.* Martin, 178 U. S., 245, 248).

When an application for patent has been objected to, the thing in controversy is the franchise to be secured on that application. No other application is before the office. A right or an absence of right to other franchises is not in controversy.

The "alleged new invention or discovery" to be examined under section 4893, R. S., is the measure of the franchise and is "for all the purposes of the" application, whatever the applicant declares it to be in his specification.

The Commissioner's decision upon petitioner's application can be supported (if at all) only upon the ground that petitioner is not "justly entitled under the law" (sec. 4893, R. S.) upon the application presented "to receive a patent for the invention, as specified in his claim" (sec. 4915, R. S.). Said decision goes even further than this, however, for it denies petitioner's right to a patent for said invention on any application.

The Commissioner will grant a patent on application for part of that invention; but the statute itself distinguishes the invention from "any part thereof" (sec. 4915, R. S., page 25 *ante*).

The protection of both sets of claims in one patent, as parts of one franchise and exclusive right, is of the essence of petitioner's contract with the United States. It is even more than

> "a right of substantial value * * inseparably connected with the cause of action." (*In re* Connaway 178, U. S., 421, 427, quoting B. & O. R. R., *vs.* Joy, 173, U. S., 226, 228).

The sole purpose of the Commissioner's decision is the cancellation of part of the claim; and consequently a rejection of the application with respect to the part to be canceled. It affects the substance of the grant to be made when the application matures to patent.

## VI.

*The Commissioner's decision is not interlocutory but final.*

The form in which the Commissioner has expressed his decision does not affect its status as interlocutory or final. (Collins *vs.* New Hampshire, 171, U. S., 30, 34; Commissioner *vs.* Whitely, 4 Wallace, 522; Potter *vs.* Beal, 50 Federal Reporter, 860.)

A decision is interlocutory when

> "made before final decision and for the purpose of ascertaining matter of law or fact preparatory to a final decree." (Richmond *vs.* Atwood, 52 Federal Reporter, 10, 20–21).

It does not appear that any further consideration need be given to the case; nor that the Commissioner is deliberating or wishes to deliberate further, respecting petitioner's title to the patent (franchise or document) for which he has applied.

Nothing is reserved by the Commissioner if petitioner will not conform with the official requirement, and the only thing left for petitioner under the decision is to

cancel a part of his claim. The most complete anticipation of such part could accomplish no more, so far as the present application is concerned.

The Commissioner *intends* his decision to be without prejudice to the presentation of the canceled claims in a separate application; but the Commissioner's authority might be exceeded in so entertaining them; and even if not, his decision denies petitioner's just title to the patent applied for.

The "title of the claimant" to be ascertained by the statutory "investigation" (112 U. S., 67) or "examination" (sec. 4893, R. S.) is not some abstract right of protection, but the one patent (document and franchise) which petitioner asks by his application. The Commissioner has deliberately and definitely said he will in no event grant this unless directed by the courts to do so.

As petitioner understands, he has also refused in part the protection which he concedes to be petitioner's just reward; since that protection can fully be secured under the statute only by a single franchise, granted and evidenced by one patent document, which shall include both sets of petitioner's claims.

The Primary Examiner said that his determination was "final" (exhibit record, pages 21, 22 and 26), and the Commissioner sustained his ruling.

Moreover, the Primary Examiner dismissed the application presented, by refusing to entertain it further for any purpose; and the Commissioner sustained that also.

The Commissioner refused to allow the appeal to be heard, which petitioner took to the Examiners-in-chief.

He refused to give any relief.

The return says that

> "There had been no consideration of or action upon the merits of the application" (page 3).

Whitely made the plea that no examination had been made; and the then Commissioner said

> "in his answer to the rule that he could not examine the application, because none had been filed in the Patent Office.
>
> "The position is untenable. * *
>
> "The relator had done all in his power to make his application effectual, and had a right to consider it properly before the Commissioner.
>
> "It was so * * The Commissioner found the question, whether the assignee was such a one as the law entitled to a reissue, lying at the threshold of his duties? * * * Having resolved it in the negative, there was no necessity for him to look further into the case. Entertaining such views it would have been idle to do so. *The question* was vital to the application, and its resolution fatal, so far as he was concerned. Only a reversal by the tribunal of appeal could revive it, and cast upon him the duty of further examination." (Commissioner *vs.* Whitely, 4 Wallace, 522, 532-533.)

Here the question is not one of parties, but of subject-matter. The Commissioner finds that petitioner's "alleged new invention or discovery" (sec. 4893, R. S.) includes

> "more devices than could properly be made the subject of a single patent." (Sessions *vs.* Romadka, 145 U. S., 29, 40 ).

"Entertaining such views," why should he "look further into case?" "*The question* was vital," and its adverse resolution fatal, so far as the Commissioner is concerned.

He asserts an authority to determine legislatively what can or can not be included in a single patent; and this authority is invalid; but petitioner can question it only by proper legal proceedings.

The dismissal of a bill for multifariousness is a final decree. (Walker *vs.* Powers, 104 U. S., 245; Gaines *vs.* Chew, 2 Howard, 619.) An order sustaining a demurrer for multifariousness with leave to amend would not be a final decree in a strict sense; although it might be in the nature of a final decree.

Possibly the distinction between a decree of dismissal and an order sustaining a demurrer with leave to amend was in the mind of the Court of Appeals; if so, it is to be regretted that it was not expressed in such manner that there would be no doubt about the Commissioner's withdrawing from the position that petitioner can do nothing more with the present application in the Patent Office, without cancellation of part of the claim.

Had petitioner attempted by mandamus to compel further action of any kind in the Patent Office, he might, on the one hand, have lost the benefit of the appeal which the Court of Appeals refused to hear and, on the other, have failed to obtain any relief through mandamus on the ground that the remedy was appeal. (Commissioner *vs.* Whitely, 4 Wallace, 522.)

The Commissioner's decision is, however, more than an order sustaining a demurrer for multifariousness under the current practice in the courts. One difference is that any further order by the Comm issioner would be nugatory. Under the present order petitioner can do

one thing only with his application in the Patent Office, that is to say, he can cancel a part of the claim; and no further order of the Commissioner could abridge this right to disclaim in order to avoid the objection of multifariousness. It exists even after patent (Sessions *vs.* Romadka, 145 U. S., 29, 40).

Should Congress give to every complainant, whose bill should be dismissed for multifariousness, the right of reinstatement by disclaimer, a formal order of dismissal would be a mere superfluity. By leave of the Appellate Court, a bill dismissed for multifariousness can now be amended (Gaines *vs.* Chew, 2 Howard, 619, 653).

Another difference is that applications for patents can be *finally* refused, that is, "twice rejected," as to *part* of the claim (sec. 4909, R. S.); and in such case the rest of the claim is not dead, but only in suspense. So far as appears, there is nothing to prevent the immediate allowance of petitioner's application, with one set of his claims. The other set stands rejected under the Commissioner's order. The finality of that rejection is not affected by the fact that the order does not name the particular set to be canceled. Petitioner would be obliged to determine this in complying with the order.

The preliminary rejection under section 4903, R. S., is interlocutory, because "the Commissioner" is required to "order a re-examination of the case"; but the Examiner did twice make such re-examination of petitioner's case (pages 19-21 of exhibit record); and the Court of Appeals points to no statute giving any further right of examination to petitioner. The Examiner did, and the Commissioner does, expressly deny any such right.

It is conceived, however, that the right to a re-examination could be waived. The Commissioner gives his decision the effect of a final order; and petitioner has taken the same view of it.

The return says that the

> "ruling was made by the Commissioner of Patents upon an interlocutory petition to him under Rule 145 * * * not * * * on an appeal, under section 4910 of the Revised Statutes." (Pages 2 and 3.)

But if the said ruling shows a definite determination of the Commissioner (subject only to the courts) in no event to allow to petitioner the patent applied for, it was a final decision of rejection, however it may have been made.

The Commissioner claims, and, in fact, exercises (pages 41 and 42, *post*), the authority to determine the merits of any application at any stage of the case.

If there has been any irregularity, it is on the part of the Patent Office. If the irregularity is such as to vitiate and make void in law the said ruling, that is only an additional matter for determination on the appeal.

Petitioner actually took an appeal to the Board of Examiners-in-chief (sec. 4909, R. S.), but the Examiner withheld it, and the Commissioner sustained his action. The tenth, twelfth and fourteenth of the reasons of appeal (Appendix, pages vi, vii and viii, *post*) assigned as error his so doing. This question was, therefore, one of those before the Court of Appeals for its decision.

The only possible relief when the Examiner withheld the appeal under section 4909, R. S., was to apply to the

Commissioner in person. The petition of appeal was not interlocutory, but with respect to two, if not three, "final" decisions of the Examiner. It was justified by section 481, R. S., without regard to Rule 145, or by necessity, if section 481, R. S., should not apply.

The Commissioner acted in person on Whitely's case, without reference to the Primary Examiner and the Examiners-in-chief. Both these tribunals then existed. The Board of Examiners-in-chief was established by Act of 1861 (172 U. S., 585). Whitely's application was filed 1863 (4 Wallace, 522). The court held that Whitely had the right to appeal.

The Act of 1836, chapter 357, section 7, in force in Whitely's day, provided that

> "the Commissioner shall make, or cause to be made, an examination."

Section 4893, R. S., provides that

> "the Commissioner of Patents shall cause an examination to be made."

Then he was

> "to superintend, execute and perform all * * * acts and things * * * provided * * * by law." (Sec. 1 of Act of 1836.)

Now he is required to

> "superintend or perform all duties * * * directed by law." (Sec. 481, R. S.)

The Supreme Court D. C. (two judges dissenting) held with reference to section 481, R. S. (the law now in force), that

> "The law designates the judge who is to superintend and he may even do all the work. * * * In

> the very inception of a matter for a patent the Commissioner controls the application, by express enactment, and he is the officer to cause an examination to be made, and could even do it himself. Section 4893——." (8 Official Gazette, 46, first column of page 48.)

The same court's opinion on a prior hearing, with the opinions of the dissenting judges, can be found in 7 Official Gazette, 559, 562.

See also the Commissioner's opinion in Anderson and Dyer *vs.* Lowry (89 Official Gazette 203), and that of the Court of Appeals, D. C., in Drawbaugh *vs.* Commissioner of Patents (77 Official Gazette, 313, column 1 of page 316).

If, then, as these decisions in effect hold, the law touching the examination of applications for patents is the same now as it was in Whitely's day, the decision in 4 Wallace, 522, is clear authority for the appeal which petitioner took to the Court of Appeals.

On the other hand, suppose the law to be changed so that now the Commissioner has no original and no appellate authority, except on appeal from the decision of the Examiners-in-chief (sec. 4910, R. S.), his actual decision is none the less a definite denial in fact of petitioner's title.

A decision to be final (with reference to appeal) does not have to be correct nor even to be authorized. Appeals are constantly taken to review questions of jurisdiction, and the practice is not to dismiss the appeal but to reverse the decree, if the court below exceeded its jurisdiction.

The Commissioner has charge of petitioner's papers (sec. 481, R. S.). He is the head of the Patent Office. When he makes an adverse decision, whether authorized or not, it in fact bars the "title of the claimant" until it is reversed or set aside.

Bernardin contended

> "that the decree of the Court of Appeals was utterly void because of the unconstitutionality of the statute by which it was empowered to exercise jurisdiction" (U. S. *ex rel.* Bernardin *vs.* Duell, 172 U. S., 576, 582);

But the court said

> "we think, that, under the circumstances, the remedy by appeal existed." (*Ibidem.*)

Yet the statute only allowed appeal from a "final judgment or decree of the said Court of Appeals." (Sec. 8 of act approved February 9, 1893.)

The authority of the Commissioner to make the ruling sought to be reviewed is a proper subject of inquiry by the Court of Appeals on every appeal, and a decree of affirmance necessarily sustains that authority. If lack of authority should appear, the right decision is not dismissal (which has much the effect of affirmance), but reversal.

An absence of authority to make a given decision certainly does not make the same interlocutory.

The right to appeal, as from a final decision, would exist, even if there should be a concurrent remedy by mandamus (Sandford Fork and Tool Co., 160 U. S., 247; Union Steamboat Co., 178 U. S., 317).

Petitioner contends not merely that the Commissioner's decision is erroneous, but that it is null and

void, because it arrogates to the Commissioner powers conferred on Congress and not delegated, if capable of delegation, namely, the power to limit legislatively the scope of franchises to be obtained on given applications and proceedings.

This contention is consistent with the refusal of a patent because it would cover more devices than would be proper in one patent under the statute; but it denies that the Commissioner may cut loose from the statute and refuse a patent on application, in whole or in part, upon reference to conditions, rules, or what not, originating with himself.

It also denies any authority in the Commissioner at any time to raise an objection of multifariousness, on account of two sets of claims, when the same matter is necessarily disclosed as a basis for each set (pages 5, 11–20, 30–32, *ante*), or when there is no showing of a capacity for separate use.

The plain meaning of the statute is that whatever is necessarily first disclosed in a given specification, should be claimed in the same. To separate the claims thereto is exceptional, if not intolerable.

Petitioner also contends that, if the Commissioner's decision is within his authority, it is erroneous.

None of petitioner's contentions, however, admits said decision to be interlocutory rather than final.

The Commissioner denies the legal right of any applicant in any case to have given claims in a given patent upon a given necessary disclosure. He claims to exercise, in fact does exercise, and in petitioner's case is ex-

ercising, an absolute and autocratic authority to control the claims in applications for patents. The whole matter rests, he contends, in his executive discretion, which can not be controlled by the Court of Appeals, D. C. He does not, when so acting, interpret the will of Congress; but he is himself both author and interpreter of the conditions under which the inventor can or can not secure given claims in the same patent.

For this reason he moved to dismiss petitioner's appeal.

It was not because his decision was interlocutory, but because he considered it so final and conclusive that the Court of Appeals could not look at it.

He is understood to hold that no patent, however multifarious, would be invalid on that account; and, therefore, he is at liberty to do as seems to him best in requiring division.

But this view of the Commissioner's authority has not always obtained in the Patent Office.

> "If several distinct inventions were embraced in the same patent, it would be invalid for that reason. When the office, therefore, directs an applicant to divide his application, it is not simply for the purpose of requiring applicant to conform to the classification of the office, nor because it will require more time to examine the matters embraced in the application, but because the patent can cover only a single invention and be valid" (*ex parte* Van Matteson, 24 Official Gazette, 389, lower part of column 2.)

The requirement of division must either be based on this ground of invalidity or upon some *direction* of the

statute to which the Commissioner can refer. An autocratic authority in the Commissioner on so vital a matter is not and could not constitutionally be given either to an executive or to a judicial officer.

When the Commissioner acts to require division, his action, if lawful at all, is judicially

> "to interpret and give effect to the statute as passed by Congress" (Bate Refrigerating Co. *vs.* Sulzberger, 157 U. S., 1, 43.)

The Commissioner's decision is final, on his part; for, if sustained on appeal, he

> "would have nothing to do but execute the judgment or decree * * already rendered" (Kingman *vs.* Western Mfg. Co., 170 U. S., 675, 680, quoting Bostwick *vs.* Brinkerhoff, 106 U. S., 3.)

It need not bar another application for the canceled claims. (Colorado Eastern Railway Co. *vs.* Union Pacific Ry. Co., 94 Federal Reporter, 312.)

## VII.

*Further proceedings in the Patent Office would be fruitless.*

> "If it appear that the party who makes an absolute refusal intends to put an end to the contract so far as performance is concerned, and that the other party must accept this position, why should there not be speedy action and settlement in regard to the rights of the parties?" (Roehm *vs.* Horst, 178 U. S., 1, 19).
>
> "It is true the order does not in terms dismiss the bill, but that was its necessary result. It denied the relief sought and there was no other course open to the appellant. * * * * To proceed

further would have been fruitless" (McNiece *vs.* Eliason, 78 Maryland, 168, 175, sustaining appeal by complainant on order allowing demurrer).

> "There are the general provisions as to what shall constitute an application and when it shall be completed, and it must be inferred when in the first step in an examination a vital objection to form is seen that no further examination is to be had as to the merits until it is corrected. * * * The question of division would present a vital objection—that is, if there appeared an application containing claims for two separate and distinct inventions." (*Ex parte* Mill, 40 Official Gazette, 918, column 1 of page 920.)

> "*The question* was vital to the application, and its resolution fatal, so far as he was concerned." (Commissioner *vs.* Whitely, 4 Wallace, 522, 533.)

The Patent Office is carrying out its own view of petitioner's contract; it has assumed powers it does not have, and has otherwise erred; it has definitely denied the legal rights which petitioner claims under said contract. "Why should there not be speedy action and settlement in regard to the rights" of petitioner?

## VIII.

*The Court of Appeals had and has jurisdiction to hear and determine petitioner's appeal.*

Section 9 of the act approved February 9, 1893 (Code D. C., sec. 228), transfers to the Court of Appeals the jurisdiction which the Supreme Court, D. C., had to

> "hear and determine all appeals from the decisions of the Commissioner of Patents, in accordance with the provisions of sections forty-nine hundred and

eleven to section forty-nine hundred and fifteen, inclusive, of chapter one, title LX, of the Revised Statutes." (Sec. 780, R. S. D. C.)

Section 11 of the Act approved February 9, 1893, provides

> "That the said Court of Appeals shall have power to issue all necessary and proper remedial prerogative writs in aid of its appellate jurisdiction."

Section 4911, R. S., omitting a reference to interferences, now repealed, reads:

> "If such party * * * is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc."

Section 4912 requires notice and reasons of appeal.

Section 4913 provides for certified copies, a return by the Commissioner, and an examination under oath of "the Commissioner and the examiners."

Section 4914 provides that the court shall revise the decision appealed from on "the points set forth in the reasons of appeal," and that the court's decision "shall govern further proceedings in the case," but shall not "preclude any person interested from the right to contest the validity of the patent."

Section 4915, in part, provides that

> "Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court * * * may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear."

The other sections which seem most important touching the right of appeal, as distinguished from the right to the patent, are:

"Section 481. The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; * * * ."

"Section 4893. On filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

"Section 4894. All applications for patents shall be completed and prepared for examination within one year after the filing of the application, and in default thereof, or upon the failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable."

Section 4895 allows issue of the patent to an assignee.

Section 4896 allows the representatives of a dead inventor to obtain a patent

"on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime."

"Section 4903. Whenever on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such

information and references as may be useful in judging of the propriety of renewing his application or of alterting his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case."

"Section 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal."

"Section 4910. If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person."

Sections 4911 to 4915, inclusive, are given above.

The Court of Appeals, under the strictest construction of the law, has jurisdiction of petitioner's appeal, unless a decision is necessary by the Examiners-in-Chief, intermediate the Primary Examiner and the Commissioner in person.

He is an "applicant for a patent" (sec. 4909); he is, therefore, "such party" as is referred to by section 4911; but if the word "such" necessarily implies two rejections of at least a part of his claims, then a part of his claims were "twice rejected" by the Primary Examiner (exhibit record, pages 15–21).

The objection of want of parties, which the Commissioner opposed to Whitely's application, was not recited in section 7 of the Act of 1836, and Whitely's application had not been "twice rejected" by the Primary

Examiner (as specified in section 3 of the Act of 1861); yet the court held that appeal would lie (4 Wallace, 522, 533).

The objection in Whitely's case was not to the subject-matter of the application (in other words, it was not to the "alleged new invention or discovery"), but only to Whitely's title on the application filed to obtain protection therefor. Here the objection is to Frasch's "alleged new invention or discovery" and to his title lawfully to protect the same in both its parts on the application under consideration.

No decision of the Examiners-in-chief was rendered; but petitioner took an appeal to them, which the Commissioner suppressed; and the decision to suppress was itself proper subject of appeal. The right to have such proceedings in the Patent Office as will protect the Court of Appeals' jurisdiction over the quasi-judicial decisions of the Patent Office is conferred by statute on the court (sec. 11, page 48, *ante*).

The statute does not require a separate proceeding in order that the Court of Appeals should direct a proper procedure in the Patent Office (Oliver *vs.* Felbel, 100 Official Gazette, 2384, lower part of column 2 of page 2386).

Moreover, if the Commissioner had authority to make a decision rejecting petitioner's application, without regard to the Examiners-in-chief, the plain meaning of the statute is that the Court of Appeals has jurisdiction to revise said decision. It was not the intention of Congress to put the appellate jurisdiction of the Court

of Appeals in the power of the Commissioner, through the control which he has over other officers of the bureau.

On the other hand, if the Commissioner has no valid authority of rejection except on appeal from the Examiner-in-chief, the statute gives jurisdiction to the Court of Appeals to revise said decision, to reverse it for want of authority and to remand the case for further consideration in the Patent Office in due order of appeals. See tenth, twelfth and fourteenth of petitioner's reasons of appeal (Appendix, pages vi, vii and viii, *post*).

An appellate court has jurisdiction to pass upon the lower court's jurisdiction; and its adverse determination thereof would not take away the jurisdiction of the Appellate Court to hear and determine the appeal (Nashua & Lowell Ry. Corp. *vs.* Boston & Lowell Ry. Corp., 51 Federal Reporter, 929, 930).

The principal statute to be considered here is section 780, R. S., D. C.; for it confers the jurisdiction, and sections 4911 to 4915, R. S., are brought in by reference.

The Court of Appeals is to hear all appeals from the decisions of the Commissioner of Patents; it is to hear and determine them in accordance with sections 4911 to 4915, R. S.

This last section refers to a bill in equity; but it must be construed as part of the enactment giving jurisdiction. It shows, among other things, that the Court of Appeals exercises equitable and not common law jurisdiction when an appeal is taken to it from a decision of the Commissioner of Patents.

It also shows that its jurisdiction is complete, touch-

ing any and every refusal of "a patent on application" by the Commissioner, whether for the whole of the "invention, as specified in his claim, or for any part thereof." As shown above (pages 50–52, *ante*), the same result follows from a consideration of section 4911, R. S.

The distinction between executive and judicial functions can not be overlooked; but it plainly appears that Congress, in its contracts with inventors, stipulates a right to (1) the protection; (2) the franchise through which the protection is afforded; (3) the patent document which grants and evidences the franchise, and (4) the fees and other proceedings to obtain the patent document. The determination of the existence and scope of these stipulations is a judicial function.

Considering the inchoate right to a patent franchise as property, of which "No person * shall * be deprived * * without due process of law" (5th amendment to Constitution), it is most fitting that the existence and scope of such right (when claimed) should be ascertained by courts of record.

Whatever may be the distinctions between perfected and inchoate rights, and whatever might be the constitutionality of an act entrusting the judicial duty of ascertaining an inventor's rights exclusively to executive officers, Congress plainly intended to give each inventor every appropriate remedy for the enforcement by judicial process of his inchoate right to a given franchise and exclusive right.

> "It will have been seen that in the gradual development of the policy of Congress in dealing with the subject of patents, the recognition of the

> judicial character of the questions involved became more and more pronounced." (U. S., *ex rel.* Bernardin *vs.* Duell, 172 U. S., 576, 588.)

The right to appeal is a beneficial one and "should be liberally construed" (4 Wallace, 532), especially when it involves the judicial ascertainment of property rights, in conformity with the Constitution and the amendments thereto.

The power of the Court of Appeals, instead of being a limited one, is very large and extends to every quasi-judicial act of the Commissioner of Patents (Opinion of the Assistant Attorney-General, approved by the Secretary of the Interior, in Poole *vs.* Avery, 87 Official Gazette, 357).

The statutory words conferring jurisdiction are "all appeals" (sec. 780, R. S. D. C). The presumption is that the Commissioner's decisions are quasi-judicial and intended to be reviewable by the Court of Appeals. The burden is on the Commissioner to establish the contrary, and he should be required to make out so clear a case that the authority of the Secretary of the Interior could safely be invoked (Poole *vs.* Avery, *ante*).

The Act does not use the words "final decision"; and if it did, a decision which bars petitioner from any further conduct of his case before the Patent Office is final.

At the least, the court's jurisdiction extends to every decision by the Commissioner in person restricting the subject-matter and scope (either or both) of the grant to be made on an application under examination.

The Court of Appeals could give, and in any view of

the case ought to have given, some relief. It ought to have reopened a door into the Patent Office, if felt compelled otherwise to refuse for a time a determination by f of petitioner's title to the patent applied for.

## IX.

*Mandamus to the Court of Appeals is petitioner's proper remedy.*

When an appellate court dismisses an appeal for supposed want of jurisdiction to hear and determine the same, the remedy is mandamus (Insurance Co. *vs.* Comstock, 16 Wallace, 258; R. R. *vs.* Wiswall, 23 Wallace, 507).

Even in the case of a court of first instance,

> "if the court, after sufficient service on the defendant, erroneously declines to take jurisdiction of the case or to enter judgment thereon, a writ of mandamus lies to compel it to a determination of the case, except when authority to issue a writ of mandamus has been taken away by statute." (In re Grossmayer, petitioner, 177 U. S., 48, 49.)

The court has power to issue mandamus to the Court of Appeals, D. C., for it is "appointed under the authority of the United States." (Sec. 688, R. S.) It is not necessary that there should be an appeal in reference to the matter to which the mandamus relates. (*Ex parte* Bradley, 7 Wallace, 364, 376.)

In the present case, if the Court of Appeals had sustained the authority which the Commissioner exercises in fact, but unlawfully, petitioner could have appealed (sec. 8 of Act approved February 2, 1893, Code D. C.,

sec. 233), on the ground that the validity of an authority exercised under the United States was called in question, and also the validity of a statute of the same, if any exist, granting such absolute and autocratic power to the Commissioner of Patents. Or petitioner could have applied for a writ of certiorari. (Act approved March 3, 1897, Code D. C., sec. 234).

In U. S. *ex rel.* Bernardin *vs.* Duell, the decisions of the Court of Appeals, D. C., on Patent Office appeals were held to be reviewable by the Supreme Court of the United States the same as other decisions of that court.

> "The validity of the act of Congress allowing an appeal to the Court of Appeals in interference cases was necessarily determined when that court went to judgment, yet no attempt was made to bring the case directly to this Court * * * . * * * ; and we think that, under the circumstances, the remedy by appeal existed * * * ." (172 U. S., 576, 581–582.)

Neither the claim of autocratic authority by the Commissioner, nor the rightful exercise of such authority, could deprive the Court of Appeals of jurisdiction to hear petitioner's appeal.

> "The very point to be decided upon an appeal here is whether they had such discretion and whether they exercised it in a manner that cannot be reviewed in this court * * * whether in the exercise of what the court asserts to be its discretionary power it has invaded established rights of the petitioners in this case contrary to law." * * * (Farmers' Loan and Trust Co., 129 U. S., 206, 215.)

> "But when the legislature proceeds to impose on that officer other duties, when he is directed peremptorily to perform certain acts; when the rights

> of individuals are dependent on the performance of those acts, he is so far the officer of the law; is amenable to the laws for his conduct, and can not at his discretion sport away the vested rights of others." (Marbury *vs.* Madison, 1 Cranch, 137, 165-166.)

The Court of Appeals did not pass upon the very broad authority which the Commissioner claims, but refused to inquire into it.

As the issue of the writ of mandamus rests in the sound discretion of the court (*In re* Key, 189 U. S., 84), it has seemed advisable to show somewhat in detail (1) that the writ asked by petitioner is in aid of a clear right, to wit, the right to one patent with claims therein to all the patentable matter necessarily first disclosed by petitioner in such patent; (2) that such right has been denied by the Patent Office after all the consideration which it is in the power of petitioner to obtain from the officials thereof; (3) that Congress plainly intended to provide for petitioner a remedy by the appeal which he has taken.

Petitioner seems to have no remedy but mandamus in some form. Proceedings in mandamus to compel further action on the part of the Patent Office might or might not be entertained by the Supreme Court of the United States, when they reached it, if petitioner had not first exhausted or have shown himself to be without the remedy of appeal to the Court of Appeals.

A right to mandamus and to appeal may exist concurrently to a limited extent (Union Steamboat Co., 178 U. S., 317; Sanford Fork and Tool Co., 160 U. S., 247); but, inasmuch as the entire case can only be reviewed on appeal, the latter is preferable for this reason, as also because it is the ordinary remedy.

## X.

*Petitioner is entitled to some remedy by judicial process.*

A remedy is the correlative of a right. Congress by the whole trend of its legislation intends to give inventors the remedy of judicial process to enforce the perfecting of their inchoate rights (Commissioner *vs.* Whitely, 4 Wallace, 522; U. S. *ex rel.* Bernardin *vs.* Duell, 172 U. S., 576).

Petitioner's dilemma under the Commissioner's decision is that he must either (1) abandon a part of his claim or else (2) take a subsequent patent for matter necessarily disclosed in a prior patent and not shown to be capable of separate utilization.

This dilemma is due to the fact that the patent acts require of petitioner a disclosure of both process and apparatus, as a basis for making his process claims and the same essential disclosure as a basis for making his apparatus claims.

Moreover, he can not show any capacity for separate use, because his process requires some apparatus, and the apparatus disclosed is the only apparatus he knows to be suitable, while he at present knows of no use for his apparatus except to carry out his process.

The law does not make this dilemma for petitioner, but the Commissioner of Patents. Surely there is a remedy whereby petitioner may be relieved of choosing between the horns.

> "If it is found that errors in pleading have been committed by either party injurious to his rights,

> an opportunity would certainly be afforded him to correct in some subsequent proceeding, so as to bring the real points in controversy fairly before the court." (Smith *vs.* Ely, 15 Howard, 137, 142.)

In Insurance Co. *vs.* Comstock (16 Wallace, 258, 270-271), the court dismissed a writ of error, but gave to the opinion the effect practically of a writ of mandamus.

In Mutual Life Insurance Co. *vs.* Phinney, 178 U. S., 327, a Circuit Court of Appeals, for supposed want of juisidiction, had dismissed a writ of error. On certiorari, the Supreme Court U. S. sustained the jurisdiction of the Circuit Court of Appeals; but there seems to have been no question raised as to whether mandamus was not the proper proceeding

If certiorari was the proper remedy to correct error on the part of the Court of Appeals, the present petitioner has furnished everything needed for certiorari proceedings; and it is prayed that his petition be given effect as an application for certiorari or as whatever pleading might be the proper remedy for the case, which in its present condition seems at a stand still between the patent office and the Court of Appeals.

Even if the proper remedy is mandamus directed to the Commissioner of Patents, the final arbiter in the matter would be the Supreme Court U. S.; and the present record affords substantially everything which an appeal in mandamus procedings could afford.

The case is strictly *ex parte*. There is no contestant.

Public and private interests alike will be affected favorably and not injuriously by an early and full determination of the questions involved.

A remedy is demanded *ex debito justitiae*, if for no other reason.

Wherefore, petitioner prays that the court issue a peremptory writ of mandamus directing the Court of Appeals, D. C., to hear and determine petitioner's said appeal. He also prays that the court grant any other or further relief which may be proper in the premises.

CHAS. J. HEDRICK,
*Attorney for Herman Frasch, Petitioner.*

# APPENDIX.

*Reasons of Appeal from decision of Commissioner of Patents to Court of Appeals, District of Columbia (exhibit record, pages 1-7).*

First. The authority exercised by the Commissioner of Patents, with the approval of the Secretary of the Interior, in establishing or attempting to establish rule 41 is invalid, because unconstitutional. Among the many grounds of unconstitutionality the following few are here set forth by way of example, namely:

A. The rule is in contravention of section I of article I, which section vests all the legislative powers of the Constitution in Congress and not in any executive officer or officers.

B. The rule is in contravention of that paragraph of section VIII of article I, which paragraph grants the power to secure to inventors the exclusive right to their respective discoveries, but said rule operates to deprive inventors whose discoveries cover new processes, requiring new apparatus to make the same practically useful, of the exclusive right to either their said new processes or their said new apparatus, although said processes and said apparatus must both be disclosed by such inventors in order to obtain any exclusive right whatsoever.

C. The rule is in contravention of the clause of article V of the amendments to the Constitution, which forbids any person to be deprived of property without due process of law, inasmuch as by the mere will of an executive officer or officers it deprives the inventors mentioned in paragraph B above of their property in a part of their said discoveries.

Second. The authority exercised by the Commissioner of Patents, with the approval of the Secretary of the Interior, in establishing or attempting to establish rule 41

is invalid, because without warrant of law. Among the many grounds upon which such absence of legal warrant can be urged, the following few are set forth by way of example, namely:

A. The Revised Statutes distinguish clearly between (1) the lawful subject-matter of a patent, (2) the statutory proceedings for obtaining a patent, and (3) the conduct of the said statutory proceedings; the only authority given by any act of Congress is to regulate the *conduct* of the statutory proceedings, but rule 41 is directed toward ascertaining and prescribing what shall be the lawful subject-matter of a patent.

B. Congress has not delegated to the Commissioner of Patents, nor to any executive officer or officers, the making of such a rule as is rule 41.

C. In fact, under the Constitution, Congress could not make such a delegation of power, as the enactment of the said rule would be an exercise of the legislative power.

Third. The authority exercised by the Commissioner of Patents, with the approval of the Secretary of the Interior, in establishing, or attempting to establish, rule 41, is invalid, because the said rule is unreasonable. Among the many grounds of unreasonableness, the following few are here set forth by way of example, namely:

A. The inventor *must* invent and *must* disclose matter which the said rule will not allow him to claim in the very patent wherein such disclosure *must* be made, and as a condition precedent to which the said matter *must* be invented.

B. The rule forbids the claiming in one patent of matters which repeated decisions of the Supreme Court of the United States have held to be the proper subjects of distinct claims in the same patent, which that tribunal has never recognized as proper subject-matter for separate patents, and which seem by the pronouncements of the same tribunal to be forbidden to be claimed in separate patents.

C. The rule contemplates two patents identical in the subject-matter invented and disclosed and differing only in the claim.

Fourth. The authority exercised by the Commissioner of Patents, with the approval of the Secretary of the Interior, in establishing, or attempting to establish, rule 41 is invalid, because said rule is inconsistent with law. Some of the many grounds of its inconsistency with law are hereinabove set forth and need not be repeated. In addition, the following are here set forth, likewise by way of example, namely:

A. Congress having legislated with respect to the subject matter of a patent, any alteration, by enlargement or restriction, or otherwise, of the statutory provisions is inconsistent therewith.

B. Congress having set forth certain fees and proceedings by which an exclusive right may be secured to one or more specified inventions or discoveries or inventions and discoveries, a rule demanding two or more sets of fees and two or more proceedings is inconsistent with the congressional enactments.

C. The rule forbids what Congress has authorized, namely, one patent for both a new process and the new apparatus by which such process is made of practical usefulness.

D. The rule enjoins what the law forbids, to wit, the establishment of mutually exclusive monopolies.

E. The rule enjoins what the law forbids, to wit, the limitation of the vested and inchoate rights under one patent by a patent subsequent thereto, both in order of issue and in legal effect.

F. The rule contemplates what the law forbids, to wit, the limitation of the inchoate rights of the public under a patent by a second patent subsequent thereto, both in date of issue and in legal effect.

G. The rule contemplates the exercise (in the issue of a second patent) of authority previously exhausted (in the issue of patent earlier in order of issue).

H. The rule denies the right which the law gives to an applicant of formulating his own claim.

I. The rule denies the right which the law gives to an applicant of claiming in a patent whatsoever patentable subject-matter he *must* disclose therein.

K. The rule denies the right which the law gives for such discoveries and inventions as Bell's telephone,

Merrill's production of hydrocarbon oils, Neilson's hot blast, and this appellant's incrustation-removing means, namely, the right to one patent "as discoverer for the useful art, process, or method of doing a thing he has found, and as inventor for the means he has devised to make his discovery one of actual value."

L. The rule enjoins what the law forbids, to wit, the inclusion "in a subsequent patent" to an inventor of an "invention embraced or described in a prior patent granted to himself."

Fifth. The authority is invalid which the Commissioner exercises in refusing patents to applicants in general and a patent to the present applicant (appellant) in particular unless and until his process claims or else his claims to the new apparatus used in the performance of said process shall be canceled.

Said authority is invalid for the following reasons, severally and collectively:

(*a.*) It is invalid because unconstitutional.

(*b.*) It is without warrant of law.

(*c.*) It is unreasonable.

(*d.*) It is inconsistent with law.

As some of the many grounds upon which (*a*) unconstitutionality, (*b*) absence of legal warrant, (*c*) unreasonableness, (*d*) inconsistency with law, can and will be urged, those hereinbefore set forth in the paragraphs marked by capital letters under the first, second, third, and fourth reasons of appeal are to be taken as here set forth by way of example.

Sixth. The authority exercised in this case, of requiring applicants in general, and the present applicant in particular, to cancel a part of his claim (or any one or more of his claims) to patentable subject-matter, is invalid, especially when two patents issued—one on the part required to be canceled and the other on the remaining part—would bear to each other the following relationship severally or any two or more or all of them collectively—that is to say:

1. That of two mutually exclusive patents.

2. That of two patents with the same essential specification, neither more nor less, only the *claim* being divided between the two patents.

3. That of two patents for different reflexes or embodiment of the same conception.

4. That of two patents for the process and the apparatus respectively, which process and apparatus were both claimed in Bell's first patent in suit in Dolbear *vs.* American Bell Telephone Co., 126 U. S., 1; C. D. 1888, p. 322; 43 O. G, 377.

5. That of two. patents for the process and the apparatus respectively, which process and apparatus were both claimed in the one patent in suit in Merrill *vs.* Yeomans, 94 U. S., 568; C. D. 1877, p. 279; 11 O. G., 970.

6. That of two patents for respectively Neilson's apparatus and Neilson's method, referred to in O'Reilly *vs.* Morse, 15 How., 62.

7. That of two patents for respectively the process and the apparatus of appellant's above-entitled application.

Seventh. The authority is invalid, which was and is exercised by the Commissioner of Patents in this case, of forbidding applicants in general, and this applicant in particular, to claim all and several the new and useful matters of invention required to be disclosed by him or by them respectively in order to the obtainment of any patent whatsoever, and of refusing the application unless and until a part of his or their claim shall be canceled. This authority is invalid for the following reasons, severally and collectively:

(*a.*) It is invalid because unconstitutional.

(*b.*) It is without warrant of law.

(*c.*) It is unreasonable.

(*d.*) It is inconsistent with law.

As some of the many grounds upon which (*a*) unconstitutionality, (*b*) absence of legal warrant, (*c*) unreasonableness, (*d*) inconsistency with law, can and will be urged, those hereinbefore set forth in the paragraphs marked by capital letters under the first, second, third, and fourth reasons of appeal are to be taken as here set forth by way of example.

Eighth. The authority exercised by the Commissioner of Patents in this case of refusing or holding up applications for patents in general, and the above-entitled application in particular, upon the mere ground that the application contains both process claims and apparatus claims, is invalid, because:

(*a.*) It is unconstitutional.
(*b.*) It is without warrant of law.
(*c.*) It is unreasonable.
(*d.*) It is inconsistent with law, and upon grounds hereinbefore sufficiently set forth, the same to be taken as here repeated.

Ninth. The authority exercised by the Commissioner of Patents in this case, of refusing the above-entitled application upon any ground apparent in the record and proceedings in this case, is invalid, because:

(*a.*) It is unconstitutional.
(*b.*) It is without warrant of law.
(*c.*) It is unreasonable.
(*d.*) It is inconsistent with law, and upon grounds hereinbefore sufficiently set forth, the same to be taken as here repeated.

Tenth. The authority exercised by the Commissioner of Patents in refusing to forward appellant's appeal of December 13, 1901, to the board of examiners-in-chief, or to direct that it be forwarded, is invalid, because:

(*a.*) It is without warrant of law.
(*b.*) It is inconsistent with the statute in such case made and provided.

Some of the grounds which can and will be urged in support of these reasons are as follows:

(A.) One or more or all of the points set forth in the said appeal to the said board were proper to be considered and passed upon by the examiners-in-chief.

(B.) It is and was the duty of the said board to determine their own jurisdiction in the first instance, and not the prerogative of the examiner or of the Commissioner of Patents in person.

Eleventh. The Commissioner of Patents erred in holding that applicant (appellant) was not and is not justly entitled under the law to the patent prayed for, because the above-entitled application includes claims to a process and claims to an apparatus, or upon any ground apparent in the record and proceedings in this case.

Twelfth. The Commissioner of Patents erred in holding that because the above-entitled "application includes claims to a process and claims to an apparatus," "there-

fore the examiner properly required division." If the law authorizes (as it does authorize) one patent including claims to a process and claims to an apparatus, and if it gives (as it does give) to appellant a right to such a patent, it was the duty of the examiner and Commissioner to speed the progress of the application. If, on the other hand, the present applicant (appellant) had been found claiming (as he is not claiming) more or other than the law authorizes to be secured in the patent to be issued on the above-entitled application, it would have been the duty of the examiner to reject the applicant (or, as the statute puts it, the claim for a patent) on that ground. In any case, if he would not allow the application, it was his duty on the coming in of an appeal to the examiners-in-chief to forward the same to them for their determination of the points involved in the appeal. In no case can the Commissioner of Patents compel an applicant to file a divisional or, in fact, any application whatsoever.

Thirteenth. The Commissioner of Patents erred in holding that a "requirement for division is not an action upon the merits of the application, but is a mere matter of form." So far is it from being a mere matter of form that to secure a patent without the claims to process or to apparatus might be held by the courts to be an absolute abandonment and waiver of those claims, notwithstanding the issue of another patent containing the omitted claims.

In any event, the action is one of the merits.

(*a.*) Because the law gives inventors the right, on payment of one set of fees and the conduct of one proceeding, to secure protection for whatever matters may be authorized by law to be secured in one patent.

(*b.*) Because a patent with both process claims and apparatus claims is manifestly a different grant, as well from one whose claims are solely to process as from one whose claims are solely to apparatus.

(*c.*) Because the courts have repeatedly held claims void by reason of their having been granted in two patents instead of in one.

(*d.*) Because the legal effect of two patents is not the same as that of one patent.

(*e.*) Upon the analogy of the inclusion of two or more inventions in one patent to the inclusion of two or more patents in one bill in equity, an improper inclusion in such bill making it demurrable for multifariousness, and the decision on such demurrer being appealable, when it is against the inclusion, as a final decision on the merits of the bill.

(*f.*) Because submission to the so-called "requirement of division" involves an alteration in the specification in its very essence—that is to say, in the substance of the claim.

Fourteenth. The Commissioner of Patents erred in holding that "a party has no right of appeal to the examiners-in-chief from such a requirement" as the so-called "requirement of division." The statute gives such a party the same right of appeal which it gives to any applicant whose "claim to a patent" may be "rejected."

Fifteenth. The Commissioner of Patents erred in holding that the action in the above-entitled application "is not a refusal of a patent or patents upon the alleged invention or inventions," since obviously he did and does refuse applicant a patent covering as well the new process as the new apparatus.

Sixteenth. The Commissioner of Patents is in error as to the action on the above-entitled application being in effect "a ruling that the application has not been made in proper form," an "objection to the way in which the matter is presented, and not to the matter itself;" for in point of fact the matter in issue is neither a patent for the process divorced from the apparatus nor a patent for the apparatus divorced from the process, but a patent for the process and apparatus as one patentable discovery and invention, and no suggestion has been made of any change in the form or manner of presenting said matter which would render the present application more acceptable to the Commissioner of Patents. What he demands is that the applicant (appellant) accept a patent essentially different from that which he asks as his legal right.

Seventeenth. The Commissioner of Patents erred in rejecting above-entitled application for patent.

Eighteenth. The Commissioner of Patents erred in refusing the patent applied for.

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# Supreme Court of the United States.

**October Term, 1903. No. 13, Original.**

EX PARTE HERMAN FRASCH, PETITIONER.

**Memorandum requested by the Court at hearing of December 21, 1903.**

148 U. S., 372, American Construction Co. *vs.* Jacksonville, Tampa and Key West Ry. Co., and Same *vs.* Pennsylvania Co. for Insurance, &c., Nos. 14 and 15, original, October Term, 1892.

> "There were two petitions to this court, each praying, in the alternative, for a writ of mandamus or a writ of certiorari, to the United States Circuit Court of Appeals for the Fifth Circuit." (Page 373.)
>
> "The following orders, therefore, will be entered in these two cases:
>
> *In No. 14, writs of mandamus and certiorari denied; and petition dismissed.*
>
> *In No. 15, writs of mandamus denied; and rule granted to show cause why a writ of certiorari should not issue to bring up and quash the decree of the Circuit Court of Appeals.*" (Page 388.)

CHAS. J. HEDRICK,

*Attorney for Herman Frasch, Petitioner.*

# In the Supreme Court of the United States.

OCTOBER TERM, 1903.

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No. 13. ORIGINAL.

EX PARTE HERMAN FRASCH, PETITIONER.

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*ON PETITION FOR WRIT OF MANDAMUS TO THE COURT OF APPEALS, DISTRICT OF COLUMBIA.*

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## BRIEF FOR RESPONDENTS.

This is an original petition for mandamus to be directed to the chief justice and associate justices of the court of appeals, District of Columbia, commanding them to hear on its merits and determine petitioner's appeal to that court from a decision of the Commissioner of Patents.

The proceedings in the Patent Office began with an application by Herman Frasch, filed November 13, 1899, for a patent covering a process and apparatus for removing incrustations of calcium sulphate from brine-heating surfaces.

The application contained six claims, the first three of which were for the process and the last three for a particular apparatus to be used in applying the process.

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On December 16, 1899, the Commissioner notified the applicant that the primary examiner had ruled that his specifications and claims presented two different subjects of invention—process and apparatus—called his attention to Rule 41, requiring division in such cases, and stated that "division on this line must be made before action upon the merits can be given."

Rule 41 is as follows:

> Two or more independent inventions can not be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application.
>
> Claims for a machine and its product must be presented in separate applications.
>
> Claims for a machine and the process in the performance of which the machine is used must be presented in separate applications.
>
> Claims for a process and its product may be presented in the same application.

Upon further consideration, and after hearing argument, the examiner repeated the order for division, and the applicant was notified that there was no appeal because there had been no rejection of his application; and the examiner, though requested so to do, therefore declined to transmit the case to the examiners in chief on appeal from his decision, but advised applicant of his right to petition the Commissioner under Rule 145, which is as follows:

Rule 145. Upon receiving a petition stating concisely and clearly any proper question which has been twice acted upon by the examiner, and which does not involve the merits of the invention claimed, or the rejection of a claim, and also stating the facts involved and the point or points to be reviewed, an order will be made fixing a time for hearing such petition by the Commissioner, and directing the examiner to furnish a written statement of the grounds of his decision upon the matters averred in such petition within *five days after being notified of the order fixing* the day of hearing. The examiner shall at the time of making such statement furnish a copy thereof to the petitioner. No fee is required for such a petition.

On December 19, 1901, applicant presented a petition to the Commissioner, in which he recited the proceedings in the office, the rulings of the examiner, and prayed relief; and on January 23 thereafter the following decision upon the same was rendered:

> This is a petition from the action of the primary examiner, requiring division in the above-entitled case and refusing to forward to the examiners in chief an appeal which has been filed.
>
> The application includes claims to a process and claims to an apparatus, and therefore the examiner properly required division, and refused to act upon the merits of the claims until that requirement was complied

with. The petitioner regarded this as a refusal of a patent to him and filed a request for reconsideration, which he calls a persistence in his claim, under section 4903 of the Revised Statutes, and upon a repetition of the requirement for division filed an appeal to the examiners in chief.

A requirement for division is not an action upon the merits of the application, but is a mere matter of form, and therefore a party has no right to appeal to the examiners in chief from such a requirement. It is not a refusal of a patent or patents upon the alleged invention or inventions, but is a ruling that the application therefor has not been made in proper form. The requirement of division may be and often is made where all of the claims are admitted to be patentable. The objection is to the way in which the matter is presented and not to the matter itself. The examiner was right in refusing to forward the appeal.

The petition is denied. (Record, 30–31.)

From the decision of the Commissioner an appeal was prosecuted to the court of appeals for the District of Columbia, where petitioner contended that rule 41 is inconsistent with the statutes providing for the grant of letters patent beyond the power of the Commissioner of Patents to enact, and that in this case the rule had worked a practical denial of his application; and, further, that the Commissioner erred in sustaining the examiner and refusing to direct that an appeal be granted to the board of examiners in chief.

The Commissioner appeared and moved to dismiss the appeal for want of jurisdiction to entertain the same. The cause was heard and, after consideration thereof, the motion was granted and the appeal dismissed, the court being of the opinion that the merits of the original application had not been considered or passed on, that the order of the primary examiner was a mere interlocutory one, and that no final decision on the merits had been rendered. The opinion of the court, an elaborate one, is found in the record.

After decree dismissing the appeal was directed, petitioner asked the court to reinstate the case and to hear and determine the same, supporting this motion with an elaborate argument. Upon consideration this was denied.

At the October term, 1903, an original application was presented to this court, asking leave to file a petition for mandamus to the chief justice and associate justices, court of appeals, District of Columbia, commanding them to hear and determine upon the merits the appeal from the decision of the Commissioner of Patents. Permission having been granted, the petition was filed here and a rule issued requiring said chief justice and associate justices to show cause why the writ of mandamus should not issue as prayed for.

Answer has been made to the rule, from which it appears that the court of appeals considered the appeal to it from the Commissioner, and being of the opinion that the ruling made by him was

merely upon a question of procedure, and not a rejection of a claim or the refusal of a patent from which an appeal is permitted under the provisions of section 4911 of the Revised Statutes, they therefore dismissed the same.

Code of the District of Columbia, act of March 3, 1901 (31 Stats., 1227):

> SEC. 233. Any final judgment or decree of the court of appeals may be reexamined and affirmed, reversed, or modified by the Supreme Court of the United States, upon writ of error or appeal, in all cases in which the matter in dispute, exclusive of costs, shall exceed the sum of five thousand dollars, * * * and also in cases, without regard to the sum or value of the matter in dispute, wherein is involved the validity of any patent or copyright, or in which is drawn in question the validity of a treaty or statute of, or an authority exercised under, the United States.
>
> SEC. 234. In any case heretofore made final in the court of appeals it shall be competent for the Supreme Court of the United States to require, by certiorari or otherwise, any such case to be certified to said Supreme Court for its review and determination. * * *

Petitioner now asks that the writ of mandamus issue as originally prayed for, notwithstanding the return of the justices of the court of appeals of the District of Columbia.

The return to the rule shows the court of appeals of the District of Columbia both heard and determined the cause which was submitted to them, and upon full consideration were of opinion that the statutes had not given them jurisdiction in such a case to review and revise the action of the Commissioner, and it was so adjudged. This was a final adjudication of the matter before them. This court is now asked to interpose, by writ of mandamus, to reverse the ruling of the lower court as to jurisdiction, and to command it to adjudge the issues upon other considerations.

**If petitioner is entitled to have the action of the court of appeals reviewed in this court, he should have asked for a writ of certiorari.**

The section of the District Code above quoted gives this court the right to review any final judgment of the court of appeals, when no appeal or writ of error has been given, by writ of certiorari, and if petitioner is entitled to have the opinion now complained of reviewed here, he should have applied for such a writ. The law is well settled that mandamus will not be granted where there is another adequate remedy.

*Ex parte Newman*, 14 Wall., 152.
*In re Grossmeyer*, 177 U. S., 49.
*In re Key*, 189 U. S., 84.

In *Mutual Life Ins. Co.* v. *Finney* (178 U. S., 327), the case was taken on error to the circuit court of

appeals, which court dismissed the writ on the ground that it had no jurisdiction. Application was made to this court and the case brought here on certiorari, where the issues involved were considered and the case remanded.

**An express remedy is afforded by statute—plain, specific, and fully adequate to redress any grievance complained of by petitioner.**

Petitioner's whole case is based upon the contention that the Commissioner in person has definitely rejected the application and refused the patent applied for, and that such decision is not interlocutory but final.

The statutes provide where an application for a patent has been twice rejected by the primary examiner an appeal may be taken to the board of examiners in chief, and from that board a further appeal is given to the Commissioner in person; and finally, from the decision of the Commissioner an appeal may be taken to the court of appeals of the District of Columbia, which court is required to hear and determine the appeal and revise the decision in a summary way. (Rev. Stat., sections 4909–10–11, 4914; act creating court of appeals, D. C., Feb. 9, 1893, sec. 9.)

Section 4915, Revised Statutes, provides: "Whenever a patent on application is refused, either by the Commissioner of Patents or by the supreme court of the District of Columbia, upon

appeal from the Commissioner the applicant may have a remedy by bill in equity, and the court * * * may adjudge that such applicant is entitled, according to law, to receive a patent for his invention as specified in his claim, or for any part thereof, as the facts of the case may appear * * *."

If, as petitioner maintains, the judgment of the Commissioner denying his request was final and a definite rejection of his application for a patent, the statute above referred to gives him a plain and adequate remedy, and it is well established that under such circumstances mandamus will not lie.

*High's Extraordinary Legal Remedies*, section 16: "Whenever, therefore, an express remedy is afforded by statute, plain and specific in its nature, and fully adequate to redress the grievance complained of, mandamus will not lie."

In *Morgan* v. *Daniels* (153 U. S., 124), it was said by this court that a bill in equity filed under section 4915, Revised Statutes, "is something more than a mere appeal. It is an application to the court to set aside the action of one of the Executive Departments of the Government."

In *Butterworth* v. *Hoe* (112 U. S., 68), this court held that the remedy by a bill in equity under section 4915, Revised Statutes, applies "when the Commissioner decides to reject an application for a patent on the ground that the applicant is not on the merits entitled to it."

**A mandamus can never be used to perform the office of a writ of error or appeal, and whether it shall issue in any case is a matter of discretion.**

In *Ex parte Newman* (14 Wall., 152) there came before this court an application for a writ of mandamus directed to the judge of the United States circuit court. A libel had been filed in the district court, and from its action in reference thereto an appeal was taken to the circuit court, where it was dismissed for want of jurisdiction. Thereupon this court was asked to issue a mandamus to the circuit judge, commanding him "to entertain jurisdiction of said cause on appeal and to hear and decide the same on the merits," and the request was refused. The question involved was elaborately considered, and Justice Clifford, who delivered the unanimous opinion of the court, among other things (p. 165), said:

> Applications for a mandamus to a subordinate court are warranted by the principles and usages of law in cases where the subordinate court, having jurisdiction of a case, refuses to hear and decide the controversy, or where such a court, having heard the cause, refuses to render judgment or enter a decree in the case; but the principles and usages of law do not warrant the use of the writ to reexamine a judgment or decree of a subordinate court in any case, nor will the writ be issued to direct what judgment or decree such a court shall render in any pending case, nor will the writ be issued

in any case if the party aggrieved may have a remedy by writ of error or appeal, as the only office of the writ when issued to a subordinate court is to direct the performance of a ministerial act or to command the court to act in a case where the court has jurisdiction and refuses to act, but the supervisory court will never prescribe what the decision of the subordinate court shall be, nor will the supervisory court interfere in any way to control the judgment or discretion of the subordinate court in disposing of the controversy. * * * (P. 168.) Confessedly, the petitioners are without remedy by appeal or writ of error, * * * and it is insisted that they ought on that account to have the remedy sought by their petition. Mandamus will not lie, it is true, where the party may have an appeal or writ of error, but it is equally true that it will not lie in many other cases where the party is without remedy by appeal or writ of error. * * * The writ of mandamus will not lie in any case to a subordinate court unless it appears that the court of which complaint is made refused to act in respect to a matter within the jurisdiction of the court, and where it is the duty of the court to act in the premises. * * * Superior tribunals may by mandamus command an inferior court to perform a legal duty where there is no other remedy, and the rule applies to judicial as well as to ministerial acts, but it does not apply at all to a judicial act to correct an error, as where the act has been erroneously

> performed. If the duty is unperformed and it be judicial in its character, the mandate will be to the judge directing him to exercise his judicial discretion or judgment, without any direction as to the manner in which it shall be done, or if it be ministerial, the mandamus will direct the specific act to be performed.

In *Ex parte Railway Company* (103 U. S., 794) this court decided that it would not issue a mandamus to a circuit court directing it to restore to the docket a cause which had been dismissed upon a plea to the jurisdiction. In denying the motion to show cause why a peremptory mandamus should not issue, Mr. Chief Justice Waite (p. 796) said:

> This motion is denied, first—because it is an attempt to use the writ of mandamus as a writ of error to bring here for review the judgment of the circuit court upon a plea to the jurisdiction filed in the suit. * * *

In *Ex parte Baltimore and Ohio Railroad* (108 U. S., 566) the court denied a petition for mandamus to the circuit court of the United States directing it to take jurisdiction in a replevin suit, wherein the writ had been quashed and vacated. Mr. Chief Justice Waite, delivering the opinion of the court (p. 567), said:

> This is a final judgment in the action, and, if the case is otherwise within our jurisdiction, subject to review here on a writ of error. Upon such a writ the question of the right to maintain the action on which the cause was adjudged below, if presented

> by the record, may be reexamined here. It has been often held that mandamus can not be used to perform the office of a writ of error.

In *American Construction Company* v. *Jacksonville Company* (148 U. S., 372), wherein a petition was filed asking for a mandamus, Mr. Justice Gray, speaking for the court (p. 379), said:

> A writ of mandamus can not be used to perform the office of an appeal or writ of error to review the judicial action of an inferior court. * * * It does not, therefore, lie to review a final judgment or decree of the circuit court sustaining a plea to the jurisdiction, even if no appeal or writ of error is given by law.

In the recent case of *In re Key* (189 U. S., 84) application was made to this court for leave to file a petition for mandamus requiring the court of appeals for the District of Columbia to reinstate, and proceed to a hearing and determination on the merits, an appeal to it from the supreme court of the District, which, upon motion, had been dismissed upon the ground that it had no jurisdiction on appeal from the judgment of the court below in such cases. In an opinion denying the writ, Mr. Chief Justice Fuller, speaking for the court (p. 85), said:

> The writ of mandamus can not be used to perform the office of an appeal or writ of error and does not lie to review a final judgment or decree sustaining a plea to the jurisdiction even if no appeal or writ of error

> is given by law. It is not granted in doubtful cases, or where there is another adequate remedy, and whether it shall go or not usually rests in the sound discretion of the court.

*High's Extraordinary Legal Remedies*, section 191:

> It may be said generally that when a court, acting in a judicial capacity, has dismissed an appeal from an inferior tribunal its order of dismissal is regarded as a judicial determination of the question, and however erroneous, it is final and conclusive, and its correctness will not be questioned by mandamus. Thus, when a court of general jurisdiction has dismissed an appeal from a justice of the peace, mandamus will not lie to compel it to proceed to a hearing and determination of the appeal, since the effect of the writ in such case would be to review all the proceedings of the court below and to convert the writ of mandamus into a writ of error.

**The decision of the court of appeals in dismissing the appeal from the Commissioner of Patents was correct.**

The right of an appeal from the action of the Commissioner to the court of appeals of the District of Columbia is based on the provisions of sections 4909, 4910, and 4911 of the Revised Statutes, the act of February 9, 1893 (ch. 74), enti-

tled "An act to establish a court of appeals for the District of Columbia, and for other purposes," and section 228 of the Code of the District of Columbia (c. 854, act of 1901). The acts of 1893 and 1901 confer upon the court of appeals the jurisdiction formerly granted to the supreme court of the District of Columbia by the three sections of the Revised Statutes just referred to, which are as follows:

> SEC. 4909. Every applicant for a patent or for the reissue of a patent any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners in chief, having once paid the fee for such appeal.
>
> SEC. 4910. If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person.
>
> SEC. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the supreme court of the district of Columbia, sitting in banc.

The right of appeal given by section 4911, Revised Statutes, exists only where there has been an adverse decision upon the merits, and in the present case no such decision was made by the Commissioner.

**It is clear that the Commissioner's decision, to be appealable under section 4911, Revised Statutes, must amount to a final rejection of the application and must dispose of the whole case on its merits, and not merely relate to a preliminary question of procedure.**

*Bostwick* v. *Brinkerhoff* (106 U. S., 3):

> If the judgment is not one which disposes of the whole case on its merits, it is not final. Consequently it has been uniformly held that a judgment of reversal with leave for further proceedings in the court below can not be brought here on writ of error.

This court, in *Butterworth* v. *Hoe* (112 U. S., 50), held in effect that the ruling of the Commissioner, to be appealable, must be adverse upon the merits of the claim, for it was there said in reference to the statute and the companion statute (section 4915) relating to a bill in equity:

> It applies only when the Commissioner decides to reject an application for a patent on the ground that the applicant is not, on the merits, entitled to it.

In that case the Commissioner refused to issue the patent, but made no ruling upon the merits, and this court accordingly held the remedy was not by appeal or bill in equity.

In *Commissioner of Patents* v. *Whiteley* (4 Wall., 522), cited by the petitioner, the Commissioner ruled adversely upon the merits of the applicant's claim, holding that he was not the owner of the

invention and was not entitled to a reissue and that if granted to him upon that application or any other, it would be invalid. The ruling disposed of the whole case on its merits and supports the view that the decision must go to the merits before an appeal will lie. It was not the purpose of section 4911 to give the court of appeals power to regulate mere matters of procedure as they arise in patent applications, since section 483, Revised Statutes, expressly gives to the Commissioner of Patents authority to make rules governing procedure. The statutes unmistakably point to him and not to the court as the one to govern such questions. The court merely reviews and directs upon the merits of cases.

The court of appeals said in *Steinmetz* v. *Allen* (104 O. G., 853):

> It is not denied that to constitute a rejection of the claims in the meaning of the statute the action * * * must amount in legal effect to an adverse decision in respect to the merits of the claim and be of a character to defeat the right to the patent therefor, unless reversed on appeal.

This has been the uniform construction of the law by all tribunals that have considered it, and it is clearly the right one.

The ruling by the Commissioner in the present case did not reach the merits. There is no holding that the petitioner is not entitled to every claim

made by him. He has not been required to relinquish any of his claims, but has merely been required to present them separately instead of together. This is clearly a matter of procedure, and it alone would have been settled by the court of appeals if the appeal had not been dismissed. A decision of the question presented would not have determined whether the applicant was to receive a patent upon any claim made by him. That would have remained to be determined when the merits of the claims were considered. The question was, therefore, clearly a preliminary one relating to procedure and not an appealable question disposing of the whole case upon the merits.

Division is not required upon the ground that the patent, if granted covering the two inventions, would be declared invalid. No question as to the validity of the patent is involved, since the courts have never declared a patent invalid because of the joinder of distinct inventions. Division, therefore, involves no question of merits.

Commissioner Fisher said as far back as 1869, referring to decisions sustaining patents:

> The doctrine of both of these cases seems to be that while the rule which assigns distinct inventions to distinct patents is a proper one, and one which the Com nissioner may properly enforce, yet, if the patent actually issue, the courts will sustain it. It is certainly nowhere asserted that it is the duty

> of the Commissioner to include two or more inventions in one patent, but it is evidently referred to his discretion. (*Ex parte Yale*, C. D., 1869, 110.)

At about the same time this court said in *Bennett* v. *Fowler* (8 Wall., 445):

> It is difficult, perhaps impossible, to lay down any general rule by which to determine when a given invention or improvements shall be embraced in one, two, or more patents. Some discretion must necessarily be left on this subject to the head of the Patent Office. It is often a nice and perplexing question.

In *Ex parte Mefford* (C. D., 1883, 95; 25 O. G., 1881), Commissioner Butterworth said:

> From the decisions of the courts prior to this time it is clear that a patent containing them all would not for that reason be held invalid. (*Hogg* v. *Emerson*, 6 Howard, 437; *Barrett* v. *Hall*, 1 Mason, C. C., 447; *Moody* v. *Fisk*, 2 Mason, 112; *Wyeth* v. *Stone*, 1 Story, 273.)
>
> But it does not follow because the courts would not hold the patent invalid that it is the duty of the Patent Office to allow the application in its present form.

These cases announce the construction of the law which has always been followed. *Ex parte Fefel*, 57 O. G., 409; *ex parte Everson*, 68 O. G., 1381; *ex parte Burgess*, 64 O. G., 1759; *ex parte Demeny*, 64 O. G., 1649.

The reason for requiring division was thus stated by Commissioner Fisher in *ex parte Yale* (*supra*):

> Another consideration, which is not less important, is found in the classification of the various subjects of invention and the assignment of the different classes to different examiners. This division of labor is absolutely essential to the prompt and thorough examination of applications. It is adopted to facilitate the transaction of the public business, and the inventor himself is directly and immediately benefited by a strict adherence to it. Any union of inventions in one patent that would seriously impair this classification ought not to be permitted. Besides the delay and increased difficulty in making the examination, if the patent covers devices which enter into two classes, the drawing, which is single, must be deposited in the portfolio of the one class and be wanting in the portfolio of the other. It may thus be overlooked in the examination of the next case.

In *Ex Parte Everson* (*supra*), twenty-four years later, it was said:

> The office classification must be considered in determining the question whether process and apparatus may be joined in the same application. This question of classification is one of the highest importance, and unless the lines of classification are kept clear there is danger that the present patent system will fall to pieces of its own weight.

It is absolutely necessary that the question of division be controlled by the Commissioner under his authority as an executive officer in order that he may carry out the examination system which Congress has created. The problem of classification is a serious one when it is considered that 25,000 patents are granted each year.

The requirement for division merely affects the question of costs to the applicant and does not affect substantial rights. The question of costs is not appealable.

The petitioner argues that if his process and his apparatus claims are embodied in two patents instead of one, the courts may hold one of those patents invalid. There is no suggestion that *both* patents will be declared invalid, but merely that *one* may be. The only possible ground, and the only one suggested why one patent may be declared invalid, is that it covers the same thing as the other. Two patents for the same thing are not permissible.

If they do cover the same thing and one is sustained the applicant has all necessary protection. He is not entitled to duplicate claims in one patent any more than in two.

As a matter of fact, however, there is no danger whatever of the court holding that a patent upon a process covers the same thing as a patent upon the apparatus. If the process claim is not independent of the apparatus, it is merely for the function of

the apparatus and is invalid, whether in the same case or a separate case. This is settled by many decisions of this court.

It is a well-settled principle in patent law that a process and an apparatus are distinct, separable, and independent things. A process is the mode of treatment to produce a certain result, and as said in *Cochrane* v. *Deemer* (94 U. S., 780):

> It is an act or a series of acts performed upon the subject-matter to be transformed and reduced to a different state or thing—

whereas a machine is a combination of mechanical elements which may or may not be useful in performing the acts which constitute the process.

As was said in *Corning* v. *Burden* (15 How., 252):

> It is when the term process is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not affected by mechanism or mechanical combinations.

The court in that case further pointed out that an alleged process which is the mere function of mechanism is not patentable.

As said in *James* v. *Campbell* (104 U. S., 356):

> A patent for a process and a patent for an implement or a machine are very different things.

In *Heald* v. *Rice* (104 U. S., 737) this court said:

> A patent for a machine can not be reissued for the purpose of claiming the process of operating that class of machines, because,

> if the claim for the process is anything more than for the use of the particular machine patented, it is for a different invention.

If it is for the mere use of the machine it is not patentable, because not a true process.

In *Tilghman* v. *Proctor et al.* (102 U. S., 707), it was said:

> It is very certain that the means need not be a machine or an apparatus. It may, as the court says, be a process. A machine is a thing. A process is an act or a mode of acting. The one is visible to the eye—an object of perpetual observation. The other is a conception of the mind, seen only by its effects when being executed or performed. Either may be the means of producing a useful result.

In *Rubber Company* v. *Goodyear* (9 Wall., 788–796), Mr. Justice Swayne, delivering the opinion, said:

> Patentable subjects, as defined by the patent law, are "any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter." A machine may be new, and the product or manufacture proceeding from it may be old. In that case the former would be patentable and the latter not. The machine may be substantially old and the product new. In that event the latter, and not the former, would be patentable. Both may be new or both may be old. In the former case both would be

> patentable; in the latter, neither. The same remarks apply to processes and their results. Patentability may exist as to either, neither, or both, according to the fact of novelty, or the opposite. The patentability or the issuing of a patent as to one in no wise affects the rights of the inventor or discoverer in respect to the other. They are wholly disconnected and independent facts. Such is the sound and necessary construction of the statute.

If the appellant succeeds in obtaining a decision that his process is absolutely dependent upon his mechanism, he will then have a decision that his process claims are not patentable because for the function of his mechanism.

An examination of the published decisions of the Patent Office (which extend from 1869 to date) fails to reveal any case in which the question of division has been treated as an appealable matter under sections 4909, 4910, and 4911, Revised Statutes. It has uniformly been held that it was a preliminary matter left entirely to the discretion of the Commissioner of Patents.

Present rule 42 of the Patent Office provides that where a party is required to divide his application and limit it to one invention—

> If the independence of the inventions be clear, such limitation will be made before any action upon the merits; otherwise it may be made at any time before final action thereon.

There have been differences of opinion as to when division should be required, some holding that division should always be required between process and apparatus (*Ex parte Blythe*, 30 O. G., 1321, C. D., 1885, 82; *Ex parte Herr*, 41 O. G., 463, C. D., 1887, 105; *Ex parte Boucher*, 88 O. G., 545, and *Ex parte Frasch*, 91 O. G., 459), and others holding that the question depended upon the circumstances of the particular case. There has never been a difference of opinion, however, upon the question whether division affects the merits and is an appealable matter.

This uniform and long-established construction of the statute by the able patent lawyers who have held the position of Commissioner is entitled to great weight. As said in *Bate Refrigerating Company* v. *Sulzberger* (157 U. S., 1):

> If the statute be not so explicit as to preclude construction; if upon applying to it the established rules of interpretation; if looking at it in the light of previous legislation on the subject; if there be reasonable ground for adopting either one of two constructions; this court, without departing from sound principle, may well adopt that construction which is in harmony with the settled practice of the executive branch of the Government.

To adopt the construction contended for by this petitioner would be to upset the entire practice of the Patent Office, under which 50,000 applications

for patents are disposed of each year. To hold that preliminary matters are appealable would cause great confusion.

If one ruling as to procedure is appealable, all others are. Last year the Commissioner decided 1,814 cases on interlocutory petition without fee, and 118 cases on appeal under section 4910, Revised Statutes. If rulings as to procedure are appealable, each of those cases should have come before him by appeal. The appeal fees alone would have amounted to $54,420. The present case came before him by interlocutory petition without fee and not by appeal.

The court of appeals well said, in *Steinmetz* v. *Allen* (*supra*):

> These rules, with many others, forming a system of practical procedure for the Patent Office, were adopted by able and experienced patent lawyers who occupied the position of Commissioner of Patents, and they have been in force for many years and the practice of the office has been made to conform to them. To support, at this late day, the contention of the appellant and declare these rules in any material respect invalid upon the theory that they restrict the right of appeal, would be attended with very serious consequences to the Patent Office, indeed to the public. An established practice, such as has obtained under these

rules, ought not to be disturbed by the court, except upon the clearest principle of right and necessity.

RESPONDENTS RESPECTFULLY ASK THAT THE PETITION FOR MANDAMUS BE DISMISSED.

JAMES C. MCREYNOLDS,
*Assistant Attorney-General.*

JOHN M. COIT,
*Of Counsel.*

WASHINGTON, *December, 1903.*

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Office Supreme Court U.S.
FILED
OCT 16 1903
JAMES H. McKENNEY,
Clerk.

# Supreme Court of the United States.

OCTOBER TERM, 1903.

No. 13, ORIGINAL.

EX PARTE HERMAN FYABOH, PETITIONER.

ON PETITION FOR WRIT OF MANDAMUS TO COURT OF APPEALS, DISTRICT OF COLUMBIA.

## RETURN TO RULE.

# Supreme Court of the United States.

OCTOBER TERM, 1903.

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NO. 13, ORIGINAL.

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EX PARTE HERMAN FRASCH, PETITIONER.

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**ON PETITION FOR WRIT OF MANDAMUS TO COURT OF APPEALS, DISTRICT OF COLUMBIA.**

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## RETURN TO RULE.

*To the Honorable the Justices of the Supreme Court of the United States:*

The answer of the Chief Justice and the Associate Justices of the Court of Appeals of the District of Columbia to the rule issued herein upon them to show cause why a writ of mandamus should not issue, commanding them to hear and determine an appeal taken by the petitioner from a decision of the Commissioner of Patents.

The said Chief Justice and Associate Justices of the Court of Appeals of the District of Columbia respectfully answer and certify to the honorable Supreme Court—

(1) That they suppose that the petitioner has correctly set forth the matters appearing of record in the proceedings in his application in the Patent Office, in so far as he undertakes to relate them, but for greater certainty they refer to the copy of the record filed with the petition for accurate information as to the matters and things therein recorded.

(2) That the petitioner took an appeal to the Court of Appeals of the District of Columbia from a ruling by the Commissioner of Patents in the matter of his application for a patent, and the respondents after hearing the cause and upon consideration of a motion to dismiss made by the Commissioner of Patents dismissed the appeal for lack of jurisdiction, since in their opinion the ruling of the Commissioner of Patents was not an appealable decision. The ruling of the Commissioner was a requirement that the applicant divide his application and present his claims to the process and his claims to the apparatus in separate applications, as required in Rule 41 of the Rules of Practice of the Patent Office, instead of joining them in one application. This ruling was made by the Commissioner of Patents upon an interlocutory petition to him under Rule 145 of the Rules of Practice of the Patent Office from the action of the primary examiner requiring the application to be divided and limited to one invention before giving action upon the merits of the application. It was not a final

decision made by him on an appeal, under section 4910 of the Revised Statutes. It was a preliminary ruling upon a question of procedure and was not a rejection of a claim or the refusal of a patent. There had been no consideration of or action upon the merits of the application. Upon consideration of the appeal, the respondents were called upon to decide whether or not the rulings of the Commissioner upon such preliminary questions of procedure were appealable to the Court of Appeals of the District of Columbia, and it was and is their judgment that such rulings are not appealable, and for that reason they dismissed the petitioner's appeal, as will more fully appear from their opinion rendered, a copy of which is attached to the petition herein.

Wherefore these respondents having fully answered, pray to be hence dismissed.

R. H. ALVEY,
*Ch. Justice.*
M. F. MORRIS.
SETH SHEPARD.

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# Supreme Court of the United States.

No. 13, Original.—October Term, 1903.

Ex parte Herman Frasch, Petitioner. } On petition for writ of mandamus to the Court of Appeals for the District of Columbia.

[February 23, 1904.]

Mr. Justice McKenna delivered the opinion of the Court.

This is a petition for a writ of mandamus to compel the Court of Appeals of the District of Columbia to take jurisdiction of an appeal from the Commissioner of Patents.

The petition shows that petitioner was the first inventor of a new and useful improvement in the art of making salt by evaporation of brine, which improvement consisted of new and useful means for removing incrustation of calcium sulphate from brine heating surfaces.

Petitioner applied for a patent for his invention in due form, and expressed his invention in six claims, three of which were for the process of removing incrustation of calcium sulphate from heating surfaces, and three of which were for an apparatus for use in the process.

The primary examiner decided that "two different subjects of invention" were presented in the specification and claims, and required a division of the claims under rule 41 of the Patent Office. A reconsideration of the decision was requested and denied. A petition for an appeal to the board of examiners-in-chief was filed. The primary examiner refused to allow the appeal. A petition was then presented to the Commissioner of Patents praying that he make such order or take such action that petitioner's appeal to the examiners-in-chief might be heard, or, if that prayer be denied, that the Commissioner himself "consider the various matters all and severally raised by the appeal." Both prayers were denied and petioner appealed to the Court of Appeals of the District of Columbia. That court dismissed the appeal for want of jurisdiction. This petition was then filed and a rule to show cause issued. A return to the rule was duly made.

We have just held in *United States* v. *Allen* that rule 41 of the Patent Office, in so far as it requires a division between claims for a process and claims for an apparatus, if they are related and dependent inventions, is invalid. We, however, held that mandamus to the Commissioner, not appeal to the Court of Appeals of the District, was the proper remedy. It follows, therefore, that the rule to show cause should be discharged and the petition be dismissed, and it is

*So ordered.*